

<b>AWARD/CONTRACT</b>		<b>1. THIS CONTRACT IS A RATED ORDER UNDER DPAS (15 CFR 350)</b>		<b>RATING</b>			
<b>2. CONTRACT (Proc. Inst. Ident.) NO.</b> DOC00PAPT0601025		<b>3. EFFECTIVE DATE</b> 10/02/2006		<b>4. REQUESTOR/PURCHASE REQUEST/PROJECT NO.</b> IN 150P0601344			
<b>5. ISSUED BY</b> Office of Procurement US Patent and Trademark Office PO Box 1450-Mail Stop 6 800 Dulany St., 7th Floor ALEXANDRIA, VA 22313-1450		<b>6. ADMINISTERED BY (if other than Item 5)</b>					
<b>7. NAME AND ADDRESS OF CONTRACTOR (No., street, county, State and ZIP Code)</b> LONDON IP INC 1700 DIAGONAL RD STE 450 ALEXANDRIA, VA 22314-2849				<b>8. DELIVERY</b> <input type="checkbox"/> FOB ORIGIN <input checked="" type="checkbox"/> OTHER (See below)			
				<b>9. DISCOUNT FOR PROMPT PAYMENT</b> 0 Days: 0.00 % 0 Days: 0.00 % 0 Days: 0.00 % 0 Days: 0.00 %			
<b>10. SUBMIT INVOICES (4 copies unless otherwise specified) TO THE ADDRESS SHOWN IN</b>				<b>ITEM</b>			
<b>CODE</b>		<b>FACILITY CODE</b>					
<b>11. SHIP TO MARK FOR</b>		<b>12. PAYMENT WILL BE MADE BY</b> OFFICE OF FINANCE Dir. US Patent & Trademark Ofc PO Box 1450 Mail Stop 17 Alexandria, VA 22313					
<b>13. AUTHORITY FOR USING OTHER THAN FULL AND OPEN COMPETITION:</b> <input type="checkbox"/> 10 U.S.C. 2304(c) (1) <input type="checkbox"/> 41 U.S.C. 253(c) (1)		<b>14. ACCOUNTING AND APPROPRIATION DATA</b> 2006 - A - 150997 - 150421 - C25201 - NONCOMP - 2510 - ..... 150421					
<b>15A. ITEM NO.</b>	<b>15B. SUPPLIES/SERVICES</b> See Line Information	<b>15C. QUANTITY</b>	<b>15D. UNIT</b>	<b>15E. UNIT PRICE</b>	<b>15F. AMOUNT</b>		
<b>15G. TOTAL AMOUNT OF CONTRACT</b>							
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X	B	SUPPLIES OR SERVICES AND PRICES/COSTS		PART III - LIST OF DOCUMENTS, EXHIBITS AND OTHER ATTACH			
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X	E	INSPECTION AND ACCEPTANCE			K	REPRESENTATIONS CERTIFICATIONS AND OTHER STATEMENTS OF OFFERORS	
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CONTRACTING OFFICER WILL COMPLETE ITEM 17 OR 18 AS APPLICABLE							
<b>17. <input checked="" type="checkbox"/> CONTRACTORS NEGOTIATED AGREEMENT</b> (Contractor is required to sign this document and return <u>3</u> copies to issuing office) Contractor agrees to furnish and deliver all items or perform all the services set forth or otherwise identified above and on any continuation sheets for the consideration stated herein. The rights and obligations of the parties to this contract shall be subject to and governed by the following documents: (a) this award/contract, (b) the solicitation, if any, and (c) such provisions, representations, certifications, and specifications, as are attached or incorporated by reference herein. (Attachments are listed herein)				<b>18. <input type="checkbox"/> AWARD</b> (Contractor is not required to sign this document.) Your offer on Solicitation Number _____ including the additions or changes made by you which additions or changes are set forth in full above, is hereby accepted as to the items listed above and on any condition sheets. This award consummates the contract which consists of the following documents: (a) the Government's solicitation and your offer, and (b) this award/contract. No further contractual document is necessary.			
<b>19A. NAME AND TITLE OF SIGNER (Type or print)</b> Amy L. Hunt President				<b>20A. NAME OF CONTRACTING OFFICER</b> Jason E. Taylor			
<b>19B. NAME OF CONTRACTOR</b> BY: Amy L. Hunt (Signature of person authorized to sign)		<b>19C. DATE SIGNED</b> 9/7/06		<b>20B. UNITED STATES OF AMERICA</b> BY: Jason E. Taylor (Signature of Contracting Officer)		<b>20C. DATE SIGNED</b> 9/7/06	

## Section B - Supplies or Services and Prices/Costs

ITEM NO.	SUPPLIES OR SERVICES	QUANTITY	UNIT	UNIT PRICE	AMOUNT
1		1.0000	EA		
Period of Performance: - Delivery Schedule:					
<u>Delivery Number</u> <u>Delivery Date</u> <u>Quantity</u>					
Description:					
Requisition Number: 150P0601344					
Base/Option (Period or Quantity): Base					
1, 2006 - A - 150997 - 150421 - C25201 - NONCOMP - 2510 - - - - - 150421					

## Accounting and Appropriations Data:

## Accounting and Funding Total:

**SECTION B - SUPPLIES OR SERVICES AND PRICES/COSTS****B.1 CONTRACT TYPE**

This is an Indefinite Delivery Indefinite Quantity (IDIQ) type contract. The Government's total minimum, maximum, and estimated quantities are provided. Due to the nature of the Sub-line items, the Government cannot provide minimum and maximum quantities, but has provided its best estimate in terms of an estimated percentage of 5.5% of the parent CLIN (of the estimated quantity) based on historical data.

**B.2 BASE PERIOD (Date of award to 1 year thereafter)**

CLIN	DESCRIPTION	Min	Max	Est	Unit	Unit Price	Total Estimated Price
0002	Life Sciences: Surgery and Medical Devices: Medical Instruments, Diagnostic Equipment, Treatment Devices, Surgery, Surgical Supplies, Dentistry, Animal Husbandry, Plant Husbandry, Prosthetics	225	1200	903	EA		
0002A	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	50	EA		
0003	Mechanical: Transportation, Construction and Agriculture; Mechanical Engineering, Manufacturing and Products, Teaching, Amusement Device, Apparatus for Conducting Process, Ordnance, Trapping, Textile Process and Apparatus, Cleaning, Molding, Founding, Shaping	225	1400	1209	EA		
0003A	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	66	EA		
0005	Electrical Communications: Television, Radio, Telemetry, Telephone and Telegraph, Optical Communication, Fax, Electrical Interface Devices, GPS	225	1000	801	EA		
0005A	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	44	EA		
0006	Physical Sciences: Measuring and Testing, Radiation, Optics, Semiconductors, Nanodevices, Music, Nuclear Engineering, High Temperature Superconductors Electrical: Control Systems, Electrical Circuits and Components, Lighting, Power Generation, Conversion, and Distribution, Printers and Recorders	225	1300	1086	EA		
0006A	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	60	EA		
0009 (Firm-Fixed Price)	IT Security Implementation (IAW CAR clause 1352.239-73)	1	N/A	N/A	LOT		

**B.3 OPTION PERIOD I (Date of option exercise through 1 year thereafter)**

CLIN	DESCRIPTION	Min	Max	Est	Unit	Unit Price	Total Estimated Price
0002 (Option)	Life Sciences: Surgery and Medical Devices: Medical Instruments, Diagnostic Equipment, Treatment Devices, Surgery, Surgical Supplies, Dentistry, Animal Husbandry, Plant Husbandry, Prosthetics	225	1900	1600	EA		
0002A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	88	EA		
0003 (Option)	Mechanical: Transportation, Construction and Agriculture; Mechanical Engineering, Manufacturing and Products, Teaching, Amusement Device, Apparatus for Conducting Process, Ordnance, Trapping, Textile Process and Apparatus, Cleaning, Molding, Founding, Shaping	225	3400	1700	EA		
0003A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	94	EA		
0005 (Option)	Electrical Communications: Television, Radio, Telemetry, Telephone and Telegraph, Optical Communication, Fax, Electrical Interface Devices, GPS	225	1900	950	EA		
0005A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	52	EA		
0006 (Option)	Physical Sciences: Measuring and Testing, Radiation, Optics, Semiconductors, Nanodevices, Music, Nuclear Engineering, High Temperature Superconductors Electrical: Control Systems, Electrical Circuits and Components, Lighting, Power Generation, Conversion, and Distribution, Printers and Recorders	225	2400	2100	EA		
0006A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	116	EA		

**B.4 OPTION PERIOD 2 (Date of option exercise through 1 year thereafter)**

CHIN	DESCRIPTION	Min	Max	Est	Unit	Unit Price	Total Estimated Price
0002 (Option)	Life Sciences: Surgery and Medical Devices: Medical Instruments, Diagnostic Equipment, Treatment Devices, Surgery, Surgical Supplies, Dentistry, Animal Husbandry, Plant Husbandry, Prosthetics	225	1900	1600	EA		
0002A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	88	EA		
0003 (Option)	Mechanical: Transportation, Construction and Agriculture; Mechanical Engineering, Manufacturing and Products, Teaching, Amusement Device, Apparatus for Conducting Process, Ordnance, Trapping, Textile Process and Apparatus, Cleaning, Molding, Founding, Shaping	225	3400	1700	EA		
0003A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	94	EA		
0005 (Option)	Electrical Communications: Television, Radio, Telemetry, Telephone and Telegraph, Optical Communication, Fax, Electrical Interface Devices, GPS	225	1900	950	EA		
0005A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	52	EA		
0006 (Option)	Physical Sciences: Measuring and Testing, Radiation, Optics, Semiconductors, Nanodevices, Music, Nuclear Engineering, High Temperature Superconductors Electrical: Control Systems, Electrical Circuits and Components, Lighting, Power Generation, Conversion, and Distribution, Printers and Recorders	225	2400	2100	EA		
0006A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	116	EA		

**B.5 OPTION PERIOD 3 (Date of option exercise through 1 year thereafter)**

GEN	DESCRIPTION	Min	Max	Est	Unit	Unit Price	Total Estimated Price
0002 (Option)	Life Sciences: Surgery and Medical Devices: Medical Instruments, Diagnostic Equipment, Treatment Devices, Surgery, Surgical Supplies, Dentistry, Animal Husbandry, Plant Husbandry, Prosthetics	225	1900	1600	EA		
0002A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	88	EA		
0003 (Option)	Mechanical: Transportation, Construction and Agriculture; Mechanical Engineering, Manufacturing and Products, Teaching, Amusement Device, Apparatus for Conducting Process, Ordnance, Trapping, Textile Process and Apparatus, Cleaning, Molding, Founding, Shaping	225	3400	1700	EA		
0003A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	94	EA		
0005 (Option)	Electrical Communications: Television, Radio, Telemetry, Telephone and Telegraph, Optical Communication, Fax, Electrical Interface Devices, GPS	225	1900	950	EA		
0005A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	52	EA		
0006 (Option)	Physical Sciences: Measuring and Testing, Radiation, Optics, Semiconductors, Nanodevices, Music, Nuclear Engineering, High Temperature Superconductors Electrical: Control Systems, Electrical Circuits and Components, Lighting, Power Generation, Conversion, and Distribution, Printers and Recorders	225	2400	2100	EA		
0006A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	116	EA		

**B.6 OPTION PERIOD 4 (Date of option exercise through 1 year thereafter)**

CLIN	DESCRIPTION	Min	Max	Est	Unit	Unit Price	Total Estimated Price
0002 (Option)	Life Sciences: Surgery and Medical Devices: Medical Instruments, Diagnostic Equipment, Treatment Devices, Surgery, Surgical Supplies, Dentistry, Animal Husbandry, Plant Husbandry, Prosthetics	225	1900	1600	EA		
0002A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	88	EA		
0003 (Option)	Mechanical: Transportation, Construction and Agriculture; Mechanical Engineering, Manufacturing and Products, Teaching, Amusement Device, Apparatus for Conducting Process, Ordnance, Trapping, Textile Process and Apparatus, Cleaning, Molding, Founding, Shaping	225	3400	1700	EA		
0003A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	94	EA		
0005 (Option)	Electrical Communications: Television, Radio, Telemetry, Telephone and Telegraph, Optical Communication, Fax, Electrical Interface Devices, GPS	225	1900	950	EA		
0005A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	52	EA		
0006 (Option)	Physical Sciences: Measuring and Testing, Radiation, Optics, Semiconductors, Nanodevices, Music, Nuclear Engineering, High Temperature Superconductors Electrical: Control Systems, Electrical Circuits and Components, Lighting, Power Generation, Conversion, and Distribution, Printers and Recorders	225	2400	2100	EA		
0006A (Option)	Additional charge if lack of unity exists and the applicant agrees to pay for search of additional inventions	N/A	N/A	116	EA		

**B.7 WORKLOAD ASSIGNMENTS**

For the Base Period or first Period of the issuance of any new work in a new CLIN, the USPTO will employ a "ramp-up" period that will entail a rigorous quality review by the USPTO. The "ramp-up" period will consist of approximately 25 cases per CLIN per month. The "ramp-up" period will last until the contractor has shown that the work products being delivered will meet the USPTO quality standards set forth in Section E. It is envisioned that this period will last approximately 3 months.

After the "ramp-up" period, the USPTO will employ a "phase-in" period, which will also entail a rigorous quality review by the USPTO. The "phase-in" period will have substantially more cases assigned per CLIN per month, up

to double the "ramp-up" caseload. The "phase-in" period will last until the contractor has confirmed that the work products being delivered will continue to meet the USPTO quality standards set forth in Section E. It is envisioned that this period will last approximately 3 months.

The duration and caseload for the "ramp-up" and "phase-in" periods may be altered by mutual agreement of the USPTO and contractor.

After the "phase-in" period, the USPTO will continue to monitor the quality of the work products, but will increase the workloads to meet the needs of the agency.

During all phases, the USPTO will usually assign the cases evenly throughout the month via weekly work orders. While an absolute exact distribution of cases is not always possible on a weekly basis, due to variables outside of the control of the USPTO, i.e. filing rates, etc., the USPTO will attempt to distribute the source documents to the contractor as evenly as possible.

## **B.8 TECHNICAL FIELDS**

Each CLIN represents a technical field. The technical fields are defined by their US classification as detailed in Attachment 7. The current US Classification can be found at <http://www.uspto.gov/go/classification/>. The technical field is defined by the first claimed invention, which for purposes of this contract will be claim 1. All additional inventions will be grouped in the sub-CLIN of the first claimed invention. It is possible that an application may have additional inventions drawn to other technical fields within the same applications. Such applications will be assigned to the contractor based solely on the first claimed invention and the entire application will be required to be completed in accordance with the statement of work set forth below. The contractor must make any classification disputes within 3 business days of when the USPTO makes the assigned application available for download. The USPTO will have final say in the classification assignment of any application.

## **B.9 PERFORMANCE BASED PRICE ADJUSTMENTS**

Price adjustments are designed to assure timely delivery of all final accepted deliverables. As directed by the Government, the contractor will have a specified period of time to provide the necessary final deliverable. The final deliverables are set forth in Section C. All final deliverables will be accepted in accordance with the evaluation criteria set forth in Section E. Timeliness must be recognized as a vital requirement of this contract.

### **B.9.1 Determination of Timeliness**

The Contractor will be provided with source documents, hereafter referred to as PCT applications, and the PCT forms that will be necessary for the completions of the final deliverable. The contractor will have a maximum of 30 calendar days, hereafter referred to as "the 30-day period" to prepare and deliver the final deliverable, that are acceptable in accordance with Section E, to the USPTO for each PCT application. The 30-day period starts on the day that the USPTO first notifies the Contractor that the PCT application is available for download at the secure web site and will include any day (or any portion of a day which will be counted as a whole day) that the USPTO has not received the final deliverable at the website, i.e. the posting of the final deliverable at the secure web site, that are acceptable in accordance with Section E, from the Contractor except where otherwise indicated. After the USPTO receives the final deliverable and determines that the final deliverable is in accordance with Section E, the number of days taken by the Contractor to prepare and deliver the final deliverable will be calculated and compared to the allowed 30-calendar day maximum. The USPTO will perform 100% inspection for compliance with the 30-day period for each PCT Application.

### **B.9.2 Performance Based Price Adjustments Calculation**

Using computer-generated reports, the Government will review the contractor's compliance with the 30-day period for each PCT application. The USPTO will evaluate timeliness each month. The Contractor's invoices for the month will be adjusted in accordance with the chart below for each PCT application in which final accepted deliverables have been accepted by the USPTO during the month and which the contractor failed to deliver the final accepted deliverable within the 30-day period.



Prices listed in the Offeror's proposal and subsequently incorporated via contract award will be subject to the following performance based adjustments:

Timeliness	Disincentive
When the final accepted deliverable for the PCT application are received ___ calendar days in excess of the 30-day period.	The following unit price adjustment will be applied to the per application CLIN price for the PCT application.
1-5 days	10% of the per application CLIN price subtracted from the per application CLIN price for the PCT application
6-10 days	20% of the per application CLIN price subtracted from the per application CLIN price for the PCT application
11-15 days	30% of the per application CLIN price subtracted from the per application CLIN price for the PCT application **
16-20 days	40% of the per application CLIN price subtracted from the per application CLIN price for the PCT application **
More than 21 days	50% of the per application CLIN price subtracted from the per application CLIN price for the PCT application **

\*\*Contractor performance at this level may lead to non-assignment of work, non-exercise of an option period, or termination for default.

## SECTION C – DESCRIPTION/SPECIFICATIONS/STATEMENT OF WORK

### C.1 PURPOSE

The intent of this contract is to obtain comprehensive services to provide an international search report and a written opinion of the International Searching Authority under the provisions of the Patent Cooperation Treaty (PCT) for international applications in which the United States Patent and Trademark Office (USPTO) is the International Searching Authority (ISA). See <http://www.wipo.int/pct/en/texts/index.htm> for the text of the PCT and regulations under the PCT. The Contractor shall furnish the necessary personnel, material, equipment, services, and facilities (except as otherwise provided or specified) to perform the following Statement of Work/Specifications.

### C.2 BACKGROUND

The PCT is a multilateral treaty administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO). As of early-2006, there are 130 countries party to the PCT ("PCT Contracting States"). The PCT provides applicants with a simplified means for effectively filing patent applications in those countries by filing a single international application (a "PCT application").

Upon completion of a formalities review by the receiving Office, a copy of the international application is sent to an International Searching Authority (ISA) for performance of an international-type search and the preparation of an international search report together with a written opinion of the ISA.

### C.3 SCOPE

The Contractor shall furnish the necessary personnel, materials and services, (except as otherwise provided or specified) to perform the following Statement of Work/Requirements. The Contractor will be provided with source documents, hereafter referred to as PCT applications, and the PCT forms that will be necessary for the accomplishment of the many requirements of this contract.

### C.4 REQUIREMENTS

The following is a description of the contractual responsibilities and deliverables required by the USPTO under this contract.

All work performed must be in accordance with the PCT International Search and Preliminary Examination Guidelines (a copy of which is posted at <http://www.wipo.int/pct/en/texts/pdf/ispe.pdf>) and the USPTO PCT guidelines set forth in Chapter 1800 of the MPEP. A graphical representation of the workflow for a typical PCT application is included as Attachment 8. The USPTO will provide fillable Adobe Acrobat PDFs for all of the appropriate forms along with instructions (See Attachments 1-6). All final deliverables should be prepared on these fillable forms unless the USPTO agrees to an equivalent to be provided by the contractor.

The contractor will have a maximum of 30 calendar days, hereafter referred to as "the 30-day period" to prepare and deliver final accepted deliverable to the USPTO for each PCT application. The 30-day period starts on the day that the USPTO first notifies the Contractor that the PCT application is available for downloading at the secure web site and will include any day (any portion of a day will be counted as a whole day) that the USPTO has not received the final deliverable at the website, that are accepted in accordance with Section E, from the Contractor except where otherwise indicated. Once the final deliverable has been accepted by the USPTO, the number of days taken by the Contractor to prepare and deliver the final accepted deliverable will be calculated and compared to the allowed 30-calendar day maximum. All final deliverables will be accepted in accordance with the evaluation criteria set forth in Section E.

Upon receipt of each PCT application by the Contractor, the Contractor must perform a formalities review.

After completion of the formalities review, the Contractor must review the claims to see if there are multiple inventions present, that is, the Contractor must make a Unity of Invention determination of the claims in the PCT application. If the Contractor determines that Unity of Invention is lacking in any given PCT application, the Contractor shall complete and deliver to the USPTO an Invitation to Pay Additional Search Fees, Form PCT/ISA/206

(Form 206). The USPTO will notify the Contractor what inventions need to be considered to complete the remaining deliverable.

In very rare instances, all the claims in an international application may be held to be unsearchable. In such situations, the Contractor shall prepare a Declaration of Non-Establishment of International Search Report (PCT/ISA/203 form, hereafter referred to as "Form 203"), a Notification of Transmittal of the International Search Report or the Declaration (PCT/ISA/220 Form, hereafter referred to as "Form 220") and a Written Opinion of the International Searching Authority (PCT/ISA/237 Form, hereafter referred to as "Form 237").

In all other situations where at least one claim is searchable, the Contractor shall prepare an International Search Report (PCT/ISA/210 Form, hereafter referred to as "Form 210"), a Notification of Transmittal of the International Search Report or the Declaration (Form 220), and a Written Opinion of the International Searching Authority (Form 237). In preparing these forms, the contractor must conduct a search to discover relevant prior art. Such prior art may include US and foreign patent documents and non-patent literature (NPL). The Contractor must also apply the discovered prior art to the claims of the PCT application.

In addition to the PCT forms, the Contractor shall provide the USPTO a Recordation of Search History. The Recordation of Search History will include the field of search, search strategy, details of classification, non-patent literature and database searches.

The "final" deliverable are considered to be a Form 210, Form 220, Form 237, Recordation of Search History, and cited references or a Form 203, and Form 220, and Form 237. The Form 206 is not considered as a "final" deliverable. All final deliverable necessary for submission to the USPTO by the Contractor shall be delivered simultaneously to the USPTO. The final deliverable will include the PCT forms and the Recordation of Search History and a copy of each foreign patent document and non-patent literature cited in the PCT forms.

Acceptance of the deliverable by the Government shall be done in accordance with the 30-day period and the evaluation criteria set forth in Section E.

#### **C.4.1 Performing Formality Review**

The Contractor must perform a formalities review for each PCT application. The formalities review will include: verifying that the PCT application is readable, verifying that the first claimed invention is encompassed in a CLIN for which the Contractor has been awarded the contract, verifying that the PCT application is complete including the presence of at least one claim or a form PCT/ISA/225 (where applicable). The contractor shall notify the USPTO if the PCT application is incomplete, unreadable, or the first claimed invention is not encompassed in a CLIN for which the Contractor has been awarded. If the contractor notifies the USPTO within 3 business days of when the Contractor was notified that the PCT application was available, the 30-day period will be restarted on the day that the USPTO makes a new or complete PCT application available to the Contractor. If the USPTO is notified beyond 3 business days from when the Contractor was notified that the PCT application was available, the 30-day period will be suspended from the day the USPTO receives the notification and will restart the day the USPTO makes a new or complete copy of the PCT application available to the Contractor.

#### **C.4.2 Making a Unity of Invention Determination and Preparing the Invitation to Pay Additional Fees (PCT/ISA/206 form, hereafter "Form 206"), if applicable**

**C.4.2.1** For each PCT application, the Contractor shall determine if there is only one invention claimed or if there are multiple inventions claimed using the Unity of Invention criteria as set forth in Chapter 10 of the PCT International Search and Preliminary Examination Guidelines (a copy of which is posted at <http://www.wipo.int/pct/en/texts/pdf/ispe.pdf>). The first claimed invention and all claims having unity therewith will always be considered by the Contractor when preparing the final deliverable. Where multiple inventions are present, the Contractor shall be required to prepare and deliver a Form 206 to the USPTO, which sets forth the groups of claims present, the supporting rationale for making the lack of Unity of Invention determination, and the fee to search the additional inventions. From the date the Form 206 is received by the USPTO, the 30-day period for that application will be temporarily suspended. Instructions for filling out Form 206 are set forth on Attachment 3.

**C.4.2.2** A USPTO official will review the Contractor submitted Form 206 for acceptance. The USPTO will reject the Contractor submitted Form 206 if the USPTO determines that Unity of Invention is present. As such, the contractor will be notified that all claims of the PCT application must be considered in the preparation of the final deliverable and that an error against the quality requirements will be charged as set forth in Section E. The 30-day period for the PCT application will resume from that date of notification. If correction to the Form 206 is required, the Contractor will be notified of the need to correct the Form 206 or, at the USPTO discretion, the USPTO will correct the Form 206 and the Contractor will be informed of the necessary corrections for future reference. If the Contractor is notified that correction is required, the 30-day period will resume as of the date of notification. The necessity for correction will be noted by the USPTO and an error against the quality requirements may be charged to the Contractor irrespective of who makes the correction. A USPTO official will sign an accepted Form 206 and mail the form to the applicant. The Form 206 must be filled out per the instructions for the deliverable to be considered to have no errors.

**C.4.2.3** The applicant will be given one month to respond to the Form 206. The USPTO will notify the Contractor of applicant's response to the Form 206. The 30-day period for the PCT application will resume from that date of notification. In addition to the first claimed invention and claims having unity therewith, the Contractor shall consider all claims for which additional search fees have been paid by the applicant in the preparation of the final deliverable. If no response to the Form 206 is received from the applicant within the one-month time period, the USPTO will notify the Contractor that no response was filed and that the Contractor shall only consider the first claimed invention and claims having unity therewith when preparing the final deliverable.

**C.4.2.4** Section E provides a list of essential criteria that must be completed correctly on the Form 206 for the deliverable to be considered to have no errors.

**C.4.3 Preparing the Declaration of Non-Establishment of International Search Report (PCT/ISA/203 form, hereafter referred to as "Form 203")**

**C.4.3.1** In very rare instances, all the claims in a PCT application may be held to be unsearchable. Claims are unsearchable if: 1) they are directed to subject matter that the USPTO considers ineligible for patent protection; 2) they are so unclear that no meaningful search can be carried out; or 3) they are directed to specific nucleotide and/or amino acids sequences for which applicant has not supplied a sequence listing in computer readable form, either upon filing or after receiving an invitation to furnish a computer readable form (CRF) of the sequence listing and a meaningful search of the international application is not possible without the CRF.

**C.4.3.2.** In very rare instances, all claims may be directed to subject matter that the USPTO considers ineligible for patent protection. MPEP section 706.03(a) defines such subject matter under the heading "Subject Matter Eligibility." See also MPEP sections 2105 and 2106. If all of the claims are directed to such subject matter, the Contractor shall prepare the Form 203 by entering all the data as specified in Attachment 2.

**C.4.3.3** If, after having read the international application, the description, claims or the drawings are so unclear that no meaningful search can be performed on all of the claims, the Contractor shall prepare the Form 203 by entering all the data as specified in Attachment 2.

**C.4.3.4** Where an international application contains disclosure of one or more specific nucleotide and/or amino acid sequences, the description must contain as a separate part a sequence listing complying with the standard set forth in Annex C of the PCT Administrative Instructions. In addition, for purposes of the international search, a sequence listing in computer readable form (CRF) complying with Annex C is required by the USPTO as an International Searching Authority. A copy of the PCT Administrative Instructions is posted on the Internet <http://www.wipo.int/pct/en/texts/index.htm>. If the applicant has not provided the sequence listing part of the description or the CRF of the sequence listing in compliance with Annex C of the PCT Administrative Instructions, the International Searching Authority will issue an Invitation to Furnish Nucleotide and/or Amino Acid Sequence Listing, Form PCT/ISA/225, (Form 225), to the applicant that sets forth a time period for response. The Form 225 will be issued by the USPTO. After expiration of the time limit for response, the PCT application together with a copy of the applicant's response to the Form

225 (if submitted) will be forwarded to the Contractor. Where all the claims in the international application are directed to specific amino acid and/or nucleotide sequences for which no CRF of the sequence listing complying with Annex C has been provided, and a meaningful search of the international application is not possible without the CRF, the Contractor shall prepare the Form 203 by entering all the data as specified on Attachment 2.

**C.4.3.5** Section E provides a list of essential criteria that must be completed correctly on the Form 203 for the deliverable to be considered to have no errors. The 30-day period will be suspended as of the date that the USPTO receives the Form 203. If the Form 203 is rejected or requires correction to conform with Section E, the Contractor may be charged with an error as set forth in Section E. The USPTO may notify the Contractor that correction is required and the 30-day period will resume from the date that the USPTO notifies the Contractor. At the discretion of the USPTO, the USPTO may correct the Form 203 in lieu of requiring the Contractor to make the corrections. The error may be charged irrespective of who makes the corrections.

**C.4.4 Preparing the International Search Report (PCT/ISA/210 Form, hereafter referred to as "Form 210")**  
The Contractor shall prepare the Form 210 by entering all the data as specified in Attachment 4

**C.4.4.1 Classification.**

The Contractor must assign both a current and valid U.S. classification and an IPC Classification to the claimed subject matter using the current required format. The USPTO classification tools can be accessed via the Internet. The tools will provide assistance in determining the US classification for a given technology. The current IPC Concordance may provide some general assistance to determine the corresponding IPC classification for a given US class/subclass. However, the IPC Concordance only provides an approximation of the correspondence between IPC classification and US classification. The actual IPC schedules (A through H) for a given IPC classification indicated in the Concordance should be further consulted to determine if a more detailed or precise corresponding IPC classification can be determined than that listed in the Concordance for a given US class/subclass.

**C.4.4.2 Search Functions**

The purpose of the search is to discover relevant art by searching US and foreign patent documents and non-patent literature (NPL). For each PCT application assigned (except PCT applications where a Form 203 has been accepted by the USPTO), the Contractor is responsible for performing a search in accordance with MPEP Chapter 900 and the search guidelines. General guidelines on searching are found in MPEP 719.05 and 900. More detailed technology-specific information on where to conduct searches can be found in USPTO search guidelines (available at the USPTO's web site located at <http://www.uspto.gov/web/patents/searchtemplates/class.htm>). The USPTO search guidelines list relevant databases by technology and/or US classification (arranged by class/subclass), which are routinely searched by examiners in a given technology. Depending on the precise nature of the subject matter being searched, databases other than those listed in the search guidelines might be relevant. Conversely, not all databases listed in a particular technology search guidelines may be pertinent to the particular subject matter being searched. The search guidelines may be changed or updated on a recurring basis.

At a minimum, the Contractor must consult the minimum documentation specified in PCT Rule 34.

The Contractor must determine whether a sequence search is required. If such a search is required, the Contractor shall notify the USPTO (via e-mail or the secure website). The notification must include: (1) the application number, (2) sequence id number(s) to be searched, and (3) databases to be searched. A list of available databases will be provided after contract award. Currently the following databases are available, but are subject to change prior to start-up:

**Protein Databases**

- Pending\_Patents\_AA\_New and Pending\_Patents\_AA\_Main – Created by USPTO for internal use. Information in this database is confidential. Contains sequences from all pending applications that have valid CRFs.

- Published\_Applications\_AA\_New and Published\_Applications\_AA\_Main – Created by USPTO for internal use. Sequences from US published applications.
- Issued\_Patents\_AA – Created by USPTO for internal use. Sequences from US patent grants.
- PIR (Protein Information Resource) – Created by the National Biomedical Research Foundation at Georgetown University in collaboration with Martinsried Institute for Protein Sequences, Max Planck Institute for Biochemistry, Martinsried, Germany and the Japan International Protein Information Database, Science University of Tokyo.
- UniProt (Universal Protein Resource) – Created by merging the information contained in Swiss-Prot, TrEMBL, and PIR as a central repository of protein sequence and function. Self-described as “the world’s most comprehensive catalog of information on proteins.”
- A\_Geneseq – Created by Derwent from sequences of patents in the Derwent World Patents Index, including sequences not publicly provided in electronic format.

#### Nucleic Acid Databases

- Pending\_Patents\_NA\_New and Pending\_Patents\_NA\_Main – Created by USPTO for internal use. Information in this database is confidential. Contains sequences from all pending applications that have valid CRFs.
- Published\_Applications\_NA\_New and Published\_Applications\_NA\_Main – Created by USPTO for internal use. Sequences from US published applications.
- Issued\_Patents\_NA – Created by USPTO for internal use. Sequences from US patent grants.
- EST (Expressed Sequence Tags) – Created by National Center for Biotechnology Information as part of the GenBank database. Contains sequence data and other information on “single-pass” cDNA sequences, or Expressed Sequence Tags, from a number of organisms.
- GenEmbl – Combines GenBank, EMBL, and DDBJ information into one database for comprehensive nucleic acid searching.

N\_Geneseq – Created by Derwent from sequences of patents in the Derwent World Patents Index, including sequences not publicly provided in electronic format.

Upon receipt of the notification, the 30-day period for that application will be temporarily suspended. Upon completion of the sequence search by the USPTO, the USPTO will make available the results of the search via the secure website or another alternative electronic format. The 30-day period for the PCT application will resume from that date of the results are posted to the secure website or the alternate electronic format is received by the contractor. The Contractor is responsible for obtaining copies of the documents cited in the search results.

#### C.4.4.3 References.

The Contractor shall list relevant prior art references on the international search report. These references will also be applied against the claims in the written opinion of the ISA.

Relevant prior art is defined as everything which is made available to the public anywhere in the world by means of written disclosure (which may include drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not novel and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the "relevant date." For the purposes of the international search report, the relevant date is the international filing date. However, the definition of "relevant date" changes for the purposes of the written opinion established by the ISA. Specifically the "relevant date" for the purposes of that written opinion is either the international filing date, or where the international application validly claims priority of an earlier application, the filing date of such earlier application. Where a reference has been published between the international filing date and the claimed priority date, it is necessary to look at the priority application (if available) in order to determine if the claimed invention was adequately described in the earlier application. The USPTO may provide the Contractor with copies of US priority applications so that the Contractor can determine whether the claimed invention was adequately described and enabled in the priority application. Because the time limit for adding and/or correcting a priority claim and for furnishing a certified copy of priority applications may not yet have expired at the time that the written opinion is prepared, if a copy of the priority application is not provided, the written opinion is to be prepared as though the claimed priority date is valid.

Any published patent applications or patents that would constitute relevant prior art, except that the publication date is the same or later than international filing date, will be cited on the international search report, where the filing date or claimed priority date is earlier than the international filing date. However, these published applications or patents are not considered prior art for the written opinion. The written opinion of the ISA must draw attention to such documents since they may be relevant to the determination of novelty and inventive step by designated or elected Offices.

The Contractor must categorize each reference cited. A reference may have multiple categories. The Contractor must determine the relevant claims for each category of a reference. Category "X" is applicable where a reference is such that when the reference is taken alone, the relevant claims cannot be considered novel or cannot be considered to include an inventive step. Category "Y" is applicable where a reference is such that when the reference is taken in combination with one or more other such cited references, the relevant claims cannot be considered to include an inventive step, such combination of references being obvious to a person skilled in the art. Category "A" used as a reference defines the general state-of-the-art.

In selecting the references to be cited and categorized, the contractor should carefully compare the references with one another and with the disclosure of the PCT application to avoid the citation of an unnecessary number of references. The contractor is not called upon to cite all references that may be available, but only the "best." The number of "state-of-the-art" references (category A), which are cited, should be limited. In some PCT applications, only one state-of-the-art reference may need to be cited per claimed invention. Only in rare instances should there be more than five state-of-the-art references cited per claimed invention. Citing multiple references where any one reference is as good as, but no better than, the others should be avoided. The most relevant prior art reference should always be applied against the claims in the written opinion of the ISA.

C.4.4.4 Section E provides a list of essential criteria that must be completed correctly on the Form 210 for the deliverable to be considered to have no errors. The 30-day period will be suspended as of the date that the USPTO receives the final deliverable. If the USPTO determines that the Form 210 requires correction to conform with Section E, the Contractor may be charged with an error as set forth in Section E. The USPTO may notify the Contractor that corrections are required and the 30-day period will resume from the date of notification. At the discretion of the USPTO, the USPTO may correct the Form 210 in lieu of requiring the Contractor to make the corrections. The error may be charged irrespective of who makes the corrections.

**C.4.5 Preparing the Notification of Transmittal of the International Search Report or the Declaration (PCT/ISA/220 Form, hereafter "Form 220")**

The Contractor shall prepare the Form 220 for all PCT applications by entering all the data as specified on Attachment 5. Section E provides a list of essential criteria that must be completed correctly on the Form 220 for the deliverable to be considered to have no errors. The 30-day period will be suspended as of the date that the USPTO receives the final deliverable. If the USPTO determines that the Form 220 requires correction to conform with Section E, the Contractor may be charged with an error as set forth in Section E. The USPTO may notify the Contractor that corrections are required and the 30-day period will resume from the date of notification. At the discretion of the USPTO, the USPTO may correct the Form 220 in lieu of requiring the Contractor to make the corrections. The error may be charged irrespective of who makes the corrections.

**C.4.6 Preparing the Written Opinion of the International Searching Authority (PCT/ISA/237 Form, hereafter "Form 237")**

**C.4.6.1** The Contractor shall prepare the Form 237 for all PCT applications by entering all the data as specified on Attachment 6.

**C.4.6.2** Form 237 is used to apply the prior art found during the search against the claimed invention by providing detailed explanations as to novelty, inventive step and industrial applicability of the claimed invention. Form 237 sets forth: the basis of the opinion with respect to the language of the international application and where applicable, the use of any sequence listings and/or tables related to sequence listings if used in the search; the non-validity of the priority claim(s), where applicable; the non-establishment of the opinion with regard to novelty, inventive step and industrial applicability, where applicable to one or more claims, and the reasons therefor; lack of Unity of Invention, where applicable and the grouping of claims and explanation supporting the lack of Unity of Invention; a statement with regard to novelty, inventive step or industrial applicability for the claims searched and detailed explanations supporting such statement; an indication of certain documents cited that cannot be used in the reasoned statements because of the date of publication; certain defects in the international application, where applicable; and certain observations on the international application, where applicable.

**C.4.6.3** Section E provides a list of essential criteria that must be completed correctly on the Form 237 for the deliverable to be considered to have no errors. The 30-day period will be suspended as of the date that the USPTO receives the final deliverable. If the USPTO determines that the Form 237 requires correction to conform with Section E, the Contractor may be charged with an error as set forth in Section E. The USPTO may notify the Contractor that corrections are required and the 30-day period will resume from the date of notification. At the discretion of the USPTO, the USPTO may correct the Form 237 in lieu of requiring the Contractor to make the corrections. The error may be charged irrespective of who makes the corrections.

**C.4.7 Recordation of the search history.**

Supplemental to the PCT Forms, the contractor is required to document the search history in such detail that the complete extent of the search (e.g. field of search, search strategy, details of classification, non-patent literature and database searches, etc.) accomplished by the Contractor can be immediately envisaged and recreated by the USPTO. The recordation of the search history is intended to provide the USPTO with the necessary information to assess Contractor quality with respect to the search. The items listed in Attachment Recordation of Search History are required items for the recordation of the search, and must be provided.



## Recordation of the Search History

### Background

The procedures listed below provide the contractor with the necessary guidelines for recording the details of the search history for each PCT application. The search history provides a complete, accurate, and uniform record of what has been searched and considered by the contractor. The search history is important in evaluating the prior art determinations made by the contractor in the search report and/or written opinion.

### Field of Search

The contractor shall provide the United States Patent Classification (USPC) or International Patent Classification (IPC) classifications of domestic and foreign patents, abstract collections, and publications in which a classification search for prior art was made and the database used for the classification search. The contractor must also identify other information collections and sources in which the search for prior art was made. The contractor shall indicate the date(s) on which the search was conducted.

In order to provide a complete, accurate, and uniform record of what has been searched and considered by the contractor for each application, the USPTO has established procedures for recording search data supplemental to the International Search Report/Written Opinion. Such a record is of importance to anyone evaluating the quality of the search, the prior art made of record, and the determinations regarding novelty, inventive step or other requirements and which are based upon the prior art.

### "SEARCH HISTORY" Information

The following searches are required to be recorded in Adobe Acrobat PDF or Microsoft WORD® and provided to the USPTO in a document entitled "PCTYY#####\_SEARCH HISTORY" (hereinafter referred to as "SEARCH HISTORY") by the contractor along with the date the search was conducted and the searcher's full name, according to the following guidelines listed below.

#### I. Classification Information

The classification information portion should correspond with the "Field of Search" indicated in the International Search Report:

**(A) A complete search of a classification**, including all USPC and foreign patent documents, whether categorized by USPC or IPC classification, and other publications placed therein. A classified search is a complete search of all the documents in a particular subclass, whether filed by U.S. or IPC classification and it is not limited by any text query or other means. If a classified search was performed, the class and subclass must be recorded in the "SEARCH HISTORY" document along with the date that the search was performed (or updated) and the searcher's initials.

#### Examples

424/270, 272, 273  
224/42.1 F  
414/DIG. 4  
D3/32 R  
A61K 9/22  
A61K 31/56 - A61K 31/585

Unless a classified search as defined was performed, it would be improper to merely record the class and subclass in the "SEARCH HISTORY" document without any indication that a limited classified search was performed.

(B) **A limited search of a classification**, for example, a search that is restricted to an identifiable portion of the patent documents placed therein. A limited classified search is defined as a search of a classified patent document database limited by a text query or a set of text queries or other means. If, however, only the publications in a classification are searched, see item numbered II(C) below. If a limited classified search was performed, the class and subclass followed by an appropriate annotation must be recorded in the "SEARCH HISTORY" document along with the date that the search was performed (or updated) and the searcher's initials. The complete classification, followed by the information defining the portion of the classification searched, in parentheses, should be recorded.

**Examples**

414/1 (US only)  
238/6 (1954 to date)  
A61K 9/22 (1990 to date)  
705/14 (text search only — see search history printout)  
4C083 AC10 (F-term, abstract only)  
A61B 5/00N4P (ECLA, text search of full doc — see search history printout)  
G06F1/2 (text search only — see search history printout)

(C) **Text search only performed in a particular database (no classified or limited classification search was performed)**. If a text search was performed in a particular database and no classified or limited classified search was performed, the following entry must be recorded on the "SEARCH HISTORY" document: "See search history printout(s)" along with the date that the search was performed (or updated) and the searcher's initials.

**II. Other "SEARCH HISTORY" Information**

Other "SEARCH HISTORY" information is intended to complete the application file record of areas and/or documents considered by the contractor in their search. The contractor should record the following searches in the manner indicated, with each search dated:

(A) **A cursory search, or scanning**, of a USPC or IPC classification, i.e., a search usually made to determine if the documents classified there are relevant. Record the classification, followed by "(cursory)."

**Examples**

250/13 (cursory)  
A61K 9/44 (cursory)

(B) **A search of a publication not located within the classified patent file**, e.g., a library search, a textbook search, a Chemical Abstracts search, etc. Record according to the following for each type of literature search:

(1) **Abstracting publications**, such as Chemical Abstracts: Record name of publications, list terms consulted in index, and indicate period covered.

**Examples**

Chem. Abs, Palladium hydride Jan.-June 1975  
Eng. Index, Data Conversion Analog to Digital 1975

(2) **Periodicals** — list by title and period or volumes covered, as appropriate.

**Examples**

Popular Mechanics, June-Dec. 1974  
Lubrication Engineering, vols. 20-24

(3) **Books** — list by title and author, edition or date, as appropriate.

**Examples**

Introduction to Hydraulic Fluids, Roger E. Hatton, 1962

- (4) **Other types of literature** not specifically mentioned herein (i.e., catalogs, manufacturer's literature, private collections, etc.).

Record data as necessary to provide unique identification of material searched.

**Example**

Sears Roebuck catalog, Spring-Summer, 1973.

A cursory or browsing search through a number of materials that are not found to be of significant relevance may be indicated in a collective manner, e.g., "Browsed Scientific and Technical Information Center (STIC) shelves under QA 76.5" or "Browsed text books in STIC relating to [Insert relevant technology]." More detailed reviews or searches through books and periodicals or any search of terms in abstracting publications should be specifically recorded.

- (C) **The search of only the publications in a subclass.**

Record class and subclass followed by "(publications only)."

**Examples**

43/56 (publications only)

99/DIG. 15 (publications only)

- (D) **In each application involving a search of a computer accessed text or chemical structure, the contractor shall provide, the name of the database service, the date when the search was made, the computer databases searched, and the search queries, including text or chemical structure. The queries shall be documented by providing the following minimum information:**

- (1) The search logic containing the key words and/or query logic including any database-specific identifiers, prefixes, suffixes, truncation symbols, chemical registry numbers, etc., or chemical structure used as a query.
- (2) The name of the file or files searched and the database service.
- (3) Date of the search.
- (4) For chemical structure searches, the precise chemical structure searched must be identified. Any partial chemical structure searched must be specified by identifying the partial chemical structure and the parent chemical structure from which the partial chemical structure was taken from and the precise location where the partial chemical structure resides within the parent chemical structure.

**Examples**

- a) Chemical structure search via STN of formulae II in claim 1 in CAS registry file database.
- b) R1 of the Chemical structure of formulae II in claim 1 searched via STN in CAS registry file database.
- (5) The details of searches using combinations of any of the foregoing searches, including those combined with classified searches must be provided, and consistent such that all the information as listed above for any of the foregoing searches is included and how the combined search was accomplished.

**Example**

435/6 classified search results in WEST further refined by text search query: probe and insulin gene.

- (6) A printout of the chemical structure edited and uploaded for search within commercial databases must be provided as part of the search history.

Two ways in which this minimum documentation can be provided are:

- (1) providing as part of the search history, and as necessary annotating, the computer search printout resulting from a computer assisted search; or,
- (2) recording the required information in the "SEARCH HISTORY" document.

For the methods above, the name of the database service and the expressions "(see form)" or "(see printout)" should be recorded as appropriate with the date.

- (7) Searcher's initials.

- (E) For any sequence search accomplished by the USPTO, the contractor must provide the sequence id number(s) searched and the databases to be searched

**Examples**

- a) Nucleic acid sequence SEQ ID NO: 5 searched for complements using PGPubs.
- b) Nucleotides 10-50 of nucleic acid sequence SEQ ID NO: 5 searched for complements using commercial databases.

**(F) Other Databases**

For other types of publicly accessible computer accessed databases (e.g., CD-ROM databases, specialized databases, etc.), record data as necessary to provide unique identification of material searched and sufficient information as to the search query or request so that the search can be updated. If any other database search was performed, the specific database search must be recorded in the "SEARCH HISTORY" document along with the date that the search was performed (or updated) and the searcher's initials. The record should also document the location of the database and its form (CD-ROM, etc.).

**Example: Citing a biotech CD-ROM database**

Entrez: Sequences, National Center for Biotechnology Information, Version 7.19.91b (CD-ROM, TC 1600) Searched HIV and vaccine; neighbored Galloway article dated 6/5/91 on April 1, 1990.

**Example: Citing a non-biotech CD-ROM database**

Computer Select, (November, 1991), Ziff Davis Communications Co., (CD-ROM, STIC), Searched Unix and emulation on December 1, 1991.

**Electronic Copy of the Search Recordation**

Most of the database services accessed in application searches provide a command to display or print the search history that includes most, if not all, of the minimum required information for documenting database searches. An electronic copy of the search recordation must be provided to the USPTO which includes the following minimum information: (a) all the search logic or chemical structure or sequence used as a database query; (b) all the name(s) of the file(s) searched and the database services; (c) the date the search was made or updated; and (d) the searcher's full name. For further information and examples relating to search recordation that is provided by database services, see MPEP 719.05. If there are several search statements in the history, the statement(s) for which the results were reviewed should be identified by indicating, "results reviewed" for that search statement.

## **SECTION D - PACKAGING AND MARKING**

### **D.1 PACKAGING AND PACKING REQUIREMENTS**

The Contractor shall package all products delivered under this contract to ensure safe delivery at their destination(s) in accordance with normal commercial practice for USPS domestic shipment. Deliverables, reports and manuals may also be required to be submitted electronically at no additional cost to the Government.

### **D.2 MARKING REQUIREMENTS**

The Contractor shall mark and/or label all shipping containers holding products/deliverables being returned or delivered to the USPTO to show the contract number, a brief description of the contents, Contractor's name, and the name of the Contracting Officer's Technical Representative.

## SECTION E - INSPECTION AND ACCEPTANCE

### E.1 52.252-01 CLAUSES INCORPORATED BY REFERENCE

This contract incorporates one or more clauses by reference, with the same force and effect as if they were given in full text. Upon request, the Contracting Officer will make their full text available. Also, the full text of a clause may be accessed electronically at this/these address(es):

<http://www.arnet.gov/far/>

52.246-04	Inspection of Services – Fixed Price	AUG 1996
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### E.2 EVALUATION CRITERIA

The USPTO has determined a set of evaluation criteria that will be applied to the Contractor supplied deliverables. The evaluation criteria correspond to the content of the deliverable which must be correct for the USPTO to accept the deliverable. The USPTO will use the evaluation criteria to determine if the deliverable contain errors that require correction. The evaluation criteria are divided into three levels.

#### E.2.1 LEVEL ONE EVALUATION CRITERIA

The evaluation criteria included in level one are the evaluation criteria that the USPTO deems to be the most important. The contractor will be assessed a single level one error if the USPTO holds that any deliverable for a given PCT application is deficient in any one of the level one evaluation criteria. If the USPTO holds that a PCT application contains a level one error, the PCT application will be returned to the Contractor for correction or, at the option of the USPTO, the USPTO will correct the error(s) and notify the contractor of the errors for future reference. The level one evaluation criteria are:

- (1) Is there prior art that is not cited in the International Search Report (ISR) and Written Opinion which supports the holding of lack of novelty or inventive step of any claim that is shown in the ISR/Written Opinion to have both novelty and inventive step or has an improper opinion under novelty or inventive step? This prior art includes any non-discovered prior art that the Contractor would have reasonably been expected to find but does not include prior art that the Contractor cited in the ISR/Written Opinion.
- (2) Were any opinions regarding a lack of industrial applicability of any claim missed where the claim is shown in the ISR/Written Opinion to have both novelty and inventive?
- (3) Was any claim searched that should have been held as unsearchable because the claim relates to subject matter not required to be searched by the USPTO or because the claim relates to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out?

#### E.2.2 LEVEL TWO EVALUATION CRITERIA

The level two evaluation criteria included the evaluation criteria that the USPTO deems to be of a substantive nature. The contractor will be assessed a single level two error if the USPTO holds that any deliverable for a given PCT application is deficient in any one of the level two evaluation criteria. If the USPTO holds that a PCT application contains a level two error, the PCT application will be returned to the Contractor for correction or, at the option of the USPTO, the USPTO will correct the error(s) and notify the contractor of the errors for future reference. The level two evaluation criteria are:

- (1) Is there prior art cited in the ISR/Written Opinion that supports the holding of lack of novelty or inventive step of any claim that is shown in the ISR/Written Opinion to have both novelty and inventive step?

- (2) Were any improper opinions regarding lack of novelty or inventive step of any claim raised?
- (3) Were any improper opinions regarding lack of industrial applicability of any claim raised?
- (4) Were any opinions regarding lack of industrial applicability of any claim missed where the ISR/Written Opinion holds a lack of novelty or inventive step for the claim?
- (5) Were any searchable claims held to be unsearchable?
- (6) Were all holdings of lack of unity proper including the grouping of claims and supporting rationale?

### **E.2.3 LEVEL THREE EVALUATION CRITERIA**

The level three evaluation criteria included the evaluation criteria that the USPTO deems to be of a formalities review nature. If the USPTO holds that a PCT application contains a level three error, the PCT application will be returned to the Contractor for correction or, at the option of the USPTO, the USPTO will correct the error(s) and notify the contractor of the errors for future reference. The level three evaluation criteria are:

- (1) Was any claim searched that should have been held as unsearchable because the claim is a dependent claim and is not drafted in accordance with the second and third sentences of PCT Rule 6.4(a)?
- (2) Was the application properly classified using the latest version of the IPC and USPC?
- (3) Were the relevant documents on the Form 210 properly identified and designated as to how they apply to each claim that is subject to search (e.g., designated as X, Y or A in accordance with the use of the references on the Form 237)?
- (4) Was the search recordation complete and in proper form?
- (5) Were all U.S. priority claims treated properly?
- (6) Were appropriate observations raised relating to the clarity of the claims, the description, the drawings, and whether the claims are fully supported by the description?
- (7) Were opinions and observations clearly explained using language appropriate to examination under the Patent Cooperation Treaty?
- (8) Was clearly better prior art found that was not cited in the ISR/Written Opinion?
- (9) Were all PCT forms filled out properly?
- (10) Bibliographic data errors including:
  - Mailing address
  - International filing date
  - International application number
  - Applicant's name
  - Priority date
- (11) Other formality errors, such as:
  - Improper IPC codes
  - Figure to be published with abstract
  - Abstract missing

### E.3 REQUIRED QUALITY STANDARDS

The Contractor will be held to specific error rates for level one and level two. Acceptable performance is defined as an error rate less than or equal to 5.49%. Contractor performance at or above an error rate of 5.50% for level one may lead to non-assignment of work, non-exercise of an option period or termination for default. The error rate for level one will be calculated by dividing the number of level one errors held by the USPTO by the total number of PCT applications completed and accepted by the USPTO and then multiplying by 100. Contractor performance at or above an error rate of 5.50% for level two may lead to non-assignment of work, non-exercise of an option period or termination for default. The error rate for level two will be calculated by dividing the number of level two errors held by the USPTO by the total number of PCT applications completed and accepted by the USPTO and then multiplying by 100. Level three errors must be corrected in order for the deliverables to be accepted by the USPTO but no specific error rate will be applied.



**SECTION F – DELIVERIES OR PERFORMANCE****F.1 52.252-01 CLAUSES INCORPORATED BY REFERENCE**

This contract incorporates one or more clauses by reference, with the same force and effect as if they were given in full text. Upon request, the Contracting Officer will make their full text available. Also, the full text of a clause may be accessed electronically at this/these address(es):

<http://www.arnet.gov/far/>

52.242-15	Stop Work Order	AUG 1989
52.242-17	Government Delay of Work	APR 1984
52.247-34	F.o.b. Destination	NOV 1991

**F.2 EFFECTIVE PERIOD OF THE CONTRACT**

The effective period of this contract is as follows:

Base Period	10/02/06 through 10/01/07
Option Period 1	10/02/07 through 10/01/08
Option Period 2	10/02/08 through 10/01/09
Option Period 3	10/02/09 through 10/01/10
Option Period 4	10/02/10 through 10/01/11

Any order issued during the effective period of this contract and not completed within that period, shall be completed by the Contractor within the time specified in the order. The contract shall govern the Contractor's and the Government's rights and obligations with respect to the order to the same extent as if the order were completed during the contract's effective period. Work orders will not be issued prior to the availability of appropriated funds from which expenditures there under may be made.

## SECTION G - CONTRACT ADMINISTRATION DATA

### G.1 CONTRACT ADMINISTRATION

Notwithstanding the Contractor's responsibility for total management during the performance of the contract, the administration of the contract will require maximum coordination between the USPTO and the Contractor. The following individuals will be the USPTO points of contact during the performance of the contract.

#### (a) Contracting Officer's Technical Representative

A Contracting Officer's Technical Representative (COTR) will be designated on authority of the Contracting Officer to monitor all technical aspects and assist in administering the contract. The types of actions within the purview of the COTR's authority are to assure that the Contractor performs the technical requirements of the contract; to perform or cause to be performed inspections necessary in connection with performance of the contract; to maintain both written and oral communications with the Contractor concerning the aspects of the contract within his/her purview; to issue written interpretations of technical requirements of Government drawings, designs and specifications; to monitor the Contractor's performance under the contract and notify the Contractor and Contracting Officer of any deficiencies observed; and to coordinate Government-Furnished Property or Data availability and provide for site entry of Contractor personnel if required. A letter of designation will be issued to the COTR with a copy supplied to the Contractor, stating the responsibilities and limitations of the COTR. This letter will clarify to all parties to the contract the responsibilities of the COTR. At no time may the scope of work, price, delivery dates, or other mutually agreed upon terms or provisions of the contract be changed without being executed in writing by the Contracting Officer authorizing such changes.

#### (b) Contracting Officer

All contract administration will be effected by the Contracting Officer, address as shown on the face page of the contract. Communications pertaining to contract administration matters will be addressed to the Contracting Officer. No changes in or deviation from the scope of work shall be effected without a Supplemental Agreement executed by the Contracting Officer authorizing such changes.

### G.2 CONTRACTING OFFICER'S AUTHORITY

The Contracting Officer is the only person authorized to make or approve any changes in any of the requirements of the contract and notwithstanding any provisions contained elsewhere in the contract, the said authority remains solely in the Contracting Officer. In the event the Contractor makes any changes at the direction of any person other than the Contracting Officer, the change will be considered to have been made without authority and no adjustment will be made in the contract price to cover any increase in costs incurred as a result thereof.

### G.3 CONTRACTING OFFICER'S TECHNICAL REPRESENTATIVE (COTR) -- TECHNICAL DIRECTION

(a) The Contracting Officer hereby designates the individual named below as the Contracting Officer's Technical Representative.

NAME:	Blaine Copenheaver
ADDRESS:	U.S. Patent and Trademark Office 500 Dulany Street (JEFFERSON 8D61) Alexandria, VA 22314
PHONE NO:	571-272-1156

The COTR may be changed at any time by the Government without prior notice to the Contractor but notification of the change, including the name and address of the successor COTR, will be promptly provided to the Contractor by the Contracting Officer in writing.

(b) The responsibilities and limitations of the COTR are as follows:

- (1) The COTR is responsible for the technical aspects of the project and technical liaison with the Contractor. The COTR is also responsible for the final inspection and acceptance of all reports, and such other responsibilities as may be specified in the contract.
- (2) The COTR is not authorized to make any commitments or otherwise obligate the Government or authorize any changes, which affect the contract price, terms or conditions. Any Contractor request for changes shall be referred to the Contracting Officer directly or through the COTR. No such changes shall be made without the expressed prior authorization of the Contracting Officer. The COTR may designate assistant COTR(s) to act for him by naming such assistant in writing and transmitting a copy of such designation through the Contracting Officer to the Contractor.

#### **G.4 INVOICING AND PAYMENT INSTRUCTIONS**

(a) Invoices shall be submitted in an original and two (2) copies to the following address:

**U.S. Patent and Trademark Office  
Office of Finance, Mail Stop 17  
P.O. Box 1450  
Alexandria, VA 22313-1450**

(b) A separate invoice shall be provided for each executed and accepted work order. To constitute a proper invoice, the invoice must include the following information or attached documentation:

- (1) Name of Contractor, invoice number and invoice date;
- (2) Contract number and work order number (one per invoice);
- (3) Description (application number, work order line number and CLIN number), price, and quantity of each CLIN ordered under that specific work order;
- (4) Payment terms;
- (5) Name, title, phone number, and complete mailing address of responsible official to whom payment is to be sent.
- (6) Production or other reports as required by the Government to show Government acceptance of the deliverables.

(c) If items are rejected for failure to conform to the contract requirements, the provisions in the Prompt Payment clause (FAR 52.232-25--see Section I) will apply to the new acceptance of replacement items.

#### **G.5 INVOICING/PAYMENT FREQUENCY**

The Contractor shall submit invoices on a monthly basis for work completed and accepted by the Government during the previous month.

#### **G.6 ACCESS TO GOVERNMENT SEARCH TOOLS**

The USPTO will provide access to public WEST (a public version of the USPTO's Web-based Examiner Search Tool) for use in searching applications in this program only, i.e. use is limited to searching cases for the program. Public WEST is capable of performing automated searching of patents issued from 1790 to the current week of issue. Full document text may be searched on U.S. patents issued since 1971 and OCR text from 1920 to 1970. U.S. patent images from 1790 to the present may be retrieved for viewing or printing. Some limited foreign patent documents are available as well. In order to access public WEST, the contractor will be required to purchase Prizm 7.1 without PDF image software, which is commercially available software available for purchase at <http://www.pegasusimaging.com/prizmviewer.htm>. The USPTO will provide a reasonable number of secure fobs, which must be returned to the USPTO as the conclusion of the project. Recommended minimum computer specifications are provided as Attachment 9. Additional, the USPTO will perform required sequence searches and provide the Contractor with the search results. The Contractor is responsible for obtaining copies of the documents cited in the sequence search results.

## SECTION H - SPECIAL CONTRACT REQUIREMENTS

### H.1 TYPE OF CONTRACT

The Government contemplates awarding multiple Indefinite Delivery Indefinite Quantity (IDIQ) contracts with a base period of 1 year and four 1-year option periods. The Government reserves the right to make a single award if it is in the best interest of the Government to do so.

### H.2 ADVERTISING OF AWARD

The Contractor agrees not to refer to awards in commercial advertising in such a manner as to state or imply that the product or service provided is endorsed or preferred by the Federal Government, or is considered by the Government to be superior to other products or services. Advertisements, press releases and publicity of a contract by a supplier shall not be made without the prior express written permission of the Contracting Officer.

### H.3 OPTION TO EXTEND THE TERM OF THE CONTRACT (52.217-9)

(a) The USPTO may extend the term of the contract by unilateral modification to the contract provided that the USPTO shall give the Contractor a preliminary written notice of its intent at least 30 days before the contract expires. The preliminary notice does not commit the Government to an extension.

(b) If the USPTO exercises this option, the extended contract shall be considered to include this option provision.

(c) The total duration of the contract, including the exercise of any options under this clause, shall not exceed 60 months from the effective date of this contract.

### H.4 NO WAIVER OF DELIVERY SCHEDULE

(a) None of the following shall be regarded as an extension, waiver, or abandonment of the delivery schedule or a waiver of the USPTO's right to terminate for default: (i) Delay by the USPTO in terminating for default; (ii) Acceptance of delinquent deliveries; and (iii) Acceptance or approval of OCD submissions either after default in delivery or in sufficient time for the contractor to meet the delivery schedule.

(b) Any assistance rendered to the Contractor on the contract or acceptance by the USPTO of delinquent goods or services hereunder will be solely for the purpose of mitigating damages and is not to be construed as an intention on the part of the USPTO to condone any delinquency, or as a waiver of any rights the USPTO may have under subject contract.

### H.5 CONFLICTS OF INTEREST AND PROTECTION OF CONFIDENTIAL INFORMATION

#### (a) Scope

This document relates to the restrictions to be placed on the Patent Cooperation Treaty (PCT) search authority contractor, and all subcontractors, consultants, and individuals performing work under the contract for the purpose of avoiding improper conflicts of interest with respect to PCT searches and of protecting confidential information provided to PCT search authority contracting staff.

#### (b) Background

The role of the PCT search authority Contractor is to provide the skilled staff, tools, and other resources necessary to conduct PCT search functions and related services. Therefore, it is imperative that the Contractor be free of potential or actual conflicts of interest that could bias or appear to bias a Contractor's judgment. In order to prevent and mitigate such conflicts, the USPTO intends to impose the following restrictions and contract requirements set forth below.

#### (c) Representations and Disclosures

- (1) The Offeror agrees that its employees, subcontractors (of any tier) and their employees, and consultants, their spouses and minor child(ren) who will perform PCT examination functions or review such functions under any resulting contract, must have no financial interest in any owner or assignee of the PCT application upon which they are conducting an examination or reviewing such examination under the contract. For example, a conflict of interest would exist when a contractor employee is assigned to perform examination functions on an application that is assigned to company X and the contractor employee owns stock in company X or owns stock in a direct competitor of company X, and (2) a contractor employee is assigned to perform a review of examination functions on an application that is assigned to company X and the contractor employee's spouse works for company X or a direct competitor of company X.
- (2) The Offeror warrants and represents that, to the best of its knowledge and belief, there are no other relevant facts or circumstances which could give rise to a conflict of interest or that it has disclosed all relevant information concerning any potential conflict.

(d) Obligations

- (i) The Contractor agrees that during the period of performance of this contract, neither its employees nor subcontractors will perform PCT search functions for a PCT application upon which it, its employees, or its subcontractors, has previously performed a search on behalf of the applicants, inventors, assignees, or their representatives with respect to the same invention.

(e) Access to and Use of Patent Application and Government-Furnished Information

- (i) The Contractor acquires no right or privilege to use or disclose any information contained in any patent application file (in any form whatsoever) except to perform the work under this contract. The Contractor, in the performance of this contract, will have access to confidential information contained in patent applications or government-furnished information, which has not been released or otherwise made available to the public. The Contractor agrees that without prior written approval of the Contracting Officer it shall not:
  - (ii) Use such information for any private purpose.
  - (iii) Submit a patent application to the USPTO or any other entity that is based on such information.
  - (iv) Release such information unless such information has previously been released or otherwise made available to the public by the USPTO or the World Intellectual Property Organization.
- (2) The Contractor agrees that, to the extent it receives or is given access to patent applications, PCT applications, proprietary data, trade secrets, or other confidential or privileged technical, business, or financial information (hereafter referred to as "confidential information") under this contract, it shall treat such confidential information in accordance with any restrictions imposed on such information. Patent application documents and information contained therein, when furnished to the Contractor by the USPTO, shall be handled, at a minimum, in accordance with the provisions regarding confidential information of:

35 U.S.C. § 122

37 CFR § 1.11 and 1.14

35 U.S.C. §§ 181-188

37 CFR part 5

- (3) The Contractor shall obtain from each employee who has access to confidential information under this contract, a written agreement which shall in substance provide that such employee shall not, disclose to others or use for their benefit, confidential information received in connection with the work under this contract. The agreement must also expressly prohibit such employee from voluntarily appearing and giving expert or opinion testimony in any legal proceeding regarding USPTO information, subjects, or activities and provide that the employee shall immediately notify the USPTO if any attempt is made to compel him or her to disclose, or to provide testimony in any form concerning, such information, subjects, or activities. In addition, the agreement shall prohibit employee from making any communication with any Federal agency with respect to any patent application for which he or she

performed a search under the contract or any related matter, except as authorized in writing by the USPTO. The agreement shall expressly state that it is entered for the benefit of the USPTO and of the patent applicants whose information is disclosed to the employee, and that it will survive both the termination of the employee's work under this contract and the termination or expiration of the contract itself. Furthermore, the Contractor will provide its employees with specific initial and refresher training concerning this conflict of interest clause so as to ensure that they will not use or disclose confidential information generated or acquired in performance of this contract except as provided herein.

- (4) The Offeror shall submit with its proposal a plan for maintaining the confidential information within patent applications. The plan must provide for adequate protection of confidential information during all phases of contract performance and during the period following such performance.

(f) Subcontracts

The Contractor shall include this clause, including this paragraph, but excluding paragraph (d)(4), in consulting agreements and subcontracts of any tier. Consequently, these conflict of interest provisions apply to subcontractors and consultants. The terms "contract", "Contractor", and "Contracting Officer" will be appropriately modified to preserve the Government's rights.

(g) Remedies and Waiver

- (1) Remedies: The Contracting Officer may terminate this contract for convenience, in whole or in part, whenever it deems such termination necessary to avoid a conflict of interest. If the Contractor was aware of a potential conflict of interest prior to award or discovered an actual or potential conflict after award and did not disclose or misrepresented relevant information to the Contracting Officer, the Government may terminate the contract for default, debar the Contractor from Government contracting, or pursue such other remedies as may be permitted by law or this contract.

- (2) Waiver: Requests for waiver under this clause shall be directed in writing to the Contracting Officer and shall include a full description of the requested waiver and the reasons in support thereof. If it is determined to be in the best interests of the Government, the Contracting Officer shall grant such a waiver in writing.

(h) Government Indemnity

The Contractor shall hold the Government harmless and indemnify the Government as to any cost or loss resulting from the unauthorized use or disclosure of patent application information by the Contractor, its employees, subcontractors, agents, or consultants.

## H.6 KEY PERSONNEL

- a. The Contractor shall assign to this contract the following key personnel:

<u>Labor Category</u>	<u>Name</u>
Project Manager	Matthew Rodgers
Search Approval Official(s)	Geoff Thomas, Long Nguyen,

The Project Manager is defined as the person who is responsible for the management of performance of the contract. The Search Approval Official(s) is the person or persons who approves the submission of the final deliverable to the USPTO.

- b. During the first ninety (90) days of performance, the Contractor shall make no substitutions of key personnel unless the substitution is necessitated by illness, death, or termination of employment. The Contractor shall notify the Contracting Officer within fifteen (15) calendar days after the occurrence of any of these events and provide the information required by paragraph (c) below. After the initial 90-day period, the Contractor shall submit the

information required by paragraph (c) to the Contracting Officer at least fifteen (15) days prior to making any permanent substitutions.

c. The Contractor shall provide a detailed explanation of the circumstances necessitating the proposed substitutions, complete resumes for the proposed substitutes, and any additional information requested by the Contracting Officer. Proposed substitutes should have comparable qualifications to those of the persons being replaced. The Contracting Officer will notify the Contractor within fifteen (15) calendar days after receipt of all required information of the decision on substitutions. The contract will be modified to reflect any approved changes of key personnel.

#### **H.7 NONDISCLOSURE OF PATENT INFORMATION**

All patent data furnished by the Government to the Contractor for the necessary performance of the contract shall be and remain the sole property of the Government. The Contractor agrees not to assert any rights, or to establish any claim under the design, patent, trademark, or copyright laws, or to publish or reproduce such matter in whole or in part in any manner or form except as provided under this agreement.

#### **H.8 SECRECY AND USAGE OF PATENT INFORMATION**

Work under this contract does not affect the national security. However, patent applications are required by law (35 U.S.C. 122) to be kept in confidence. Information contained in any patent application file(s) is restricted to authorized Contractor personnel on a need-to-access basis.

The Contractor acquires no right or privilege to use or disclose any information contained in any patent application file (in any form whatsoever) except to perform the work under the contract. Further, the Contractor shall not copyright or make any use or disclosure whatsoever of any patent information contained in any application or related copy or data furnished the Contractor by the Government or obtained therefrom except performing the requirements of this contract.

Security requirements of patent application file data maintained in a computer-accessible medium are an extension of the security requirements for the hard copy or the patent application folders. All processing, storage or transmission of patent application file data by means of electronic communications systems is prohibited unless use of such systems is approved by the USPTO.

All personnel having access to patent application files or data or information concerning the same, must take the following at or affirmation, signed in writing:

"I do swear or affirm that I will preserve the applications for patents in secrecy, that I will not divulge any information concerning the same to unauthorized persons while employed in work under this contract or at any time thereafter; and that I take this obligation freely, and without mental reservation or purpose of evasion."

Each employee's signed oath, or affirmation, shall be retained in the Contractor's file, subject to inspection by authorized Government representatives.

Without advance notice, the Government shall have the right to inspect the Contractor's premises, records, and work in process pertaining to the secrecy of patent information.

#### **H.9 HOLD AND SAVE THE GOVERNMENT HARMLESS FROM LIABILITY**

The Contractor shall hold and save the Government, its officers, agents, and employees, harmless from liability of any nature or kind, including costs and expenses, for, or on account of infringement of any patent or copyright or any other unauthorized disclosure or use of any confidential secret, or proprietary data, process, product or invention, whether or not patentable, in the performance of this contract, including their disclosure or use by the Government consistent with rights in, or intent of, the contract. Where applicable, this shall include full indemnification of all costs and expenses.

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**H.10 COMPLIANCE WITH LAWS**

The Contractor shall comply with all applicable laws, rules and regulations having the force of law which deal with or relate to performance hereunder or the employment by the Contractor of the employees necessary for such performance. The Contractor shall procure such permits, licenses, and other required authorizations from the United States and from state and local authorities, as may be necessary in connection with beginning or carrying on to completion of the contract work, and shall at all times comply with all United States, State and Local Laws in any way affecting the contract work.

**H.11 SUPERVISION OF CONTRACTOR'S EMPLOYEES**

(a) Personnel assigned to render services under this contract shall at all times be employees of the Contractor or its subcontractor(s) and under the direction and control of the Contractor. Notwithstanding any other provisions of this contract, the Contractor shall at all times be responsible for the supervision of its employees in the performance of the services required hereunder.

(b) Contractor personnel shall not at any time during the contract period be employees of the U.S. Government.

**H.12 WORKLOAD DISTRIBUTION (MULTIPLE AWARDS)**

If multiple awards are made within a Technology Field CLIN, work will be equitably distributed among Contractors. The following factors will influence work assignment: Price, Quality and Capacity to handle additional work.

**H.13 DUPLICATION AND DISCLOSURE OF CONFIDENTIAL DATA**

Duplication or disclosure of confidential data provided by the USPTO or to which the Contractor will have access as a result of this contract is prohibited. It is understood that throughout performance of the contract the Contractor may have access to confidential data, which is the sole property of the USPTO, as well as access to proprietary data, which is the sole property of other than the contracting parties. The Contractor hereby agrees to maintain the confidentiality of all such data to which access may be obtained throughout contract performance whether title thereto vests in the USPTO or otherwise. The Contractor hereby agrees not to disclose said data, any interpretations thereof or data derivative therefrom, to unauthorized parties in contravention of these provisions without prior written approval of the CO or the party in which title thereto is wholly vested. Additionally, all application material printed out must be shredded to the point where it is not easily recognized or can be reconstructed. This clause also applies to any subcontractors and/or consultants used by the Contractor.

**H.14 NOTICE TO THE GOVERNMENT OF DELAYS**

In the event the Contractor encounters difficulty in meeting performance requirements, or when it anticipates difficulty in complying with the contract delivery schedule or date, or whenever the Contractor has knowledge that any actual or potential situation is delaying or threatens to delay the timely performance of this contract, the Contractor shall immediately notify the Contracting Officer and the COTR, in writing, giving pertinent details, provided, however, that this data shall be informational only in character and that this provision shall not be construed as a waiver by the Government of any delivery schedule or date or of any rights or remedies provided by law or under this contract.

**H.15 GOVERNMENT FURNISHED DATA**

The Government shall deliver to the Contractor, as may be requested, Government-Furnished Data (GFD) during the performance of this contract. GFD will be delivered to the Contractor as specified in each task order.

Title to GFD shall remain in the Government, and the Contractor shall use the GFD only in connection with this contract.

Upon completion or termination of this contract, the Contractor shall return to the Government all GFD.



# **H.16 CAR 1352.239-73 SECURITY REQUIREMENTS FOR INFORMATION TECHNOLOGY RESOURCES (OCTOBER 2003) (Modified)**

(a) This clause is applicable to all contracts that include information technology resources or services in which the Contractor must have physical or electronic access to USPTO's sensitive or classified information, which is contained in systems that directly support the mission of the Agency. For purposes of this clause, the term "Sensitive" is defined by the guidance set forth in:

(1) The DOC IT Security Program Policy and Minimum Implementation Standards

<http://www.osc.doc.gov/cio/ITSIT/DOC-IT-Security-Program-Policy.htm>;

(2) The Office of Management and Budget (OMB) Circular A-130, Appendix III, Security of Federal Automated Information Resources ([http://csrc.nist.gov/policies/appendix\\_iii.pdf](http://csrc.nist.gov/policies/appendix_iii.pdf)), which states that there is a "presumption that all [general support systems] contain some sensitive information."; and

(3) The Computer Security Act of 1987 (P.L. 100-235) (<http://www.epic.org/crypto/csa/csa.html>), including the following definition of the term sensitive information "...any information the loss, misuse, or unauthorized access, to or modification of which could adversely affect the national interest or the conduct of federal programs, or the privacy to which individuals are entitled under section 552 of title 5, United States Code (The Privacy Act), but which has not been specifically authorized under criteria established by an Executive Order or an Act of Congress to be kept secret in the interest of national defense or foreign policy.

For purposes of this clause, the term "Classified" is defined by the guidance set forth in:

(1) The DOC IT Security Program Policy and Minimum Implementation Standards, Section 3.3.1.4

(<http://csrc.nist.gov/publications/fips/fips199/FIPS-PUB-199-final.pdf>).

(2) The DOC Security Manual, Chapter 18

([http://www.easc.noaa.gov/Security/webfile/erso.doc.gov/5\\_2003%20Security%20Manual/DOC%20Manual%20of%20Security%20Policies%20and%20Procedures.htm](http://www.easc.noaa.gov/Security/webfile/erso.doc.gov/5_2003%20Security%20Manual/DOC%20Manual%20of%20Security%20Policies%20and%20Procedures.htm)).

(3) Executive Order 12958, as amended, Classified National Security Information. Classified or national security information is information that has been specifically authorized to be protected from unauthorized disclosure in the interest of national defense or foreign policy under an Executive Order or Act of Congress.

Information technology resources include, but are not limited to, hardware, application software, system software, and information (data). Information technology services include, but are not limited to, the management, operation (including input, processing, transmission, and output), maintenance, programming, and system administration of computer systems, networks, and telecommunications systems. The Contractor shall be responsible for implementing sufficient Information Technology security, to reasonably prevent the compromise of USPTO IT resources for all of the contractor's systems that are interconnected with a USPTO network or USPTO systems that are operated by the Contractor.

(b) All Contractor personnel performing under this contract and Contractor equipment used to process or store USPTO data, or to connect to USPTO networks, must comply with the requirements contained in the USPTO IT Security Handbook.

(c) For all Contractor-owned systems for which performance of the contract requires interconnection with a USPTO network or that USPTO data be stored or processed on them, the Contractor shall:

(1) Provide, implement, and maintain an IT Security Plan. This plan shall describe the processes and procedures that will be followed to ensure appropriate security of IT resources that are developed, processed, or used under this contract. The plan shall describe those parts of the contract to which this clause applies. The Contractor's IT Security Plan shall comply with federal laws that include, but are not limited to, the Computer Security Act of 1987 (40 U.S.C. 1441 et seq.) and the Federal Information Security Management Act of 2002, Pub. L. No. 107-347 Stat. 2899, 2946-2961 (2002); Pub. L. No. 107-296 Stat. 2135, 2259-2273 (2002). 38 WEEKLY COMP. PRES. DOC. 51,2174 (Dec. 23, 2002) (providing statement by President George W. Bush regarding Federal Information Security Management Act of 2002). The plan shall meet IT security requirements in accordance with Federal and USPTO policies and procedures that include, but are not limited to:

(a) OMB Circular A-130, Management of Federal Information Resources, Appendix III, Security of Federal Automated Information Resources ([http://csrc.nist.gov/policies/appendix\\_iii.pdf](http://csrc.nist.gov/policies/appendix_iii.pdf));

(b) National Institute of Standards and Technology Special Publication 800-18, Guide for Developing Security Plans for Information Technology Systems (<http://csrc.nist.gov/publications/nistpubs/800-18/PlanGuide.PDF>); and

- (c) DOC Procedures and Guidelines in the Information Technology Management Handbook (<http://nsi.org/Library/Govt/docinfo.txt>).
- (d) National Industrial Security Program Operating Manual (NISPOM) for classified systems (<http://www.dss.mil/isec/nispom.htm>); and

(2) Upon award, the contractor shall register with the USPTO Certification and Accreditation Group (CACG), with copy to the Contracting Officer, to initiate the certification and accreditation process described in paragraph 3 below.

(3) Within 14 days after receipt of direction from the CACG, the contractor shall submit for USPTO approval a System Certification and Accreditation package, including the IT Security Plan and a system certification test plan, as outlined in USPTO Certification and Accreditation Technical Standard and Guideline. The Certification and Accreditation Package must be consistent with and provide further detail for the security approach contained in the offeror's proposal or sealed bid that resulting in the award of this contract and in compliance with the requirements stated in this clause. The Certification and Accreditation Package, as approved by the Contracting Officer, in consultation with the USPTO Security Officer, shall be incorporated as part of the contract. USPTO will use the incorporated IT Security Plan as the basis for certification and accreditation of the contractor system that will process USPTO data or connect to USPTO networks. Failure to submit and receive approval of the Certification and Accreditation Package, as outlined above may result in termination of the contract.

(d) The Contractor shall incorporate this clause in all subcontracts that meet the conditions in paragraph (a) of this clause.

#### **H.17 CAR 1352.239-74 SECURITY PROCESSING REQUIREMENTS FOR CONTACTOR/SUBCONTRACTOR PERSONNEL FOR ACCESSING USPTO AUTOMATED INFORMATION SYSTEMS (OCTOBER 2003)**

(a) Contractor personnel requiring any access to AIS's operated by the Contractor for USPTO or interconnected to a USPTO network to perform contract services shall be screened at an appropriate level in accordance with Commerce Acquisition Manual 1337.70, Security Processing Requirements for Service Contracts. USPTO shall provide screening using standard personnel screening forms, which the Contractor shall submit to the USPTO Contracting Officer's Technical Representative (COTR) based on the following guidance:

- 1) Contract personnel performing work designated Contract High Risk and personnel performing work designated Contract Moderate Risk in the information technology (IT) occupations and those with "global access" to an automated information AIS require a favorable pre-employment check before the start of work on the contract, regardless of the expected duration of the contract. After a favorable pre-employment check has been obtained, the Background Investigation (BI) for Contract High Risk and the Minimum Background Investigation (MBI) for Contract IT Moderate Risk positions must be initiated within three working days of the start of work.
- 2) Contract personnel performing work designated Contract Moderate Risk who are not performing IT-related contract work to not require a favorable pre-employment check prior to their employment; however, the Minimum Background Investigation (MBI) must be initiated within three working days of the subjects start of on the contract, regardless of the expected duration of the contract.
- 3) Contract personnel performing work designated as Contract Low Risk will require as National Agency Check and Inquiries (NACI) upon the subjects start of work on the contract if the expected duration of the contract exceeds 365 calendar days. The NACI must be initiated within three working days of the subjects start of work on the contract.
- 4) Contract personnel performing work designated Contract Low Risk will require a Special Agreement Check (SAC) upon the subject's start of work on the contract if the expected duration of the contract (including options) exceeds 180 calendar days, but is less than 365 calendar days. The SAC must be initiated within three working days of the subject's start of work on the contract.
- 5) Contract personnel performing work on contracts requiring access to classified information must undergo investigative processing according to the Department of Defense National Industrial Security Program Manual (NISPOM), (<http://www.dss.mil/isec/nispom.htm>) and be granted eligibility for access to classified information prior to beginning work on the contract.

The security forms may be obtained from USPTO Office of Security. At the option of the government, interim access to USPTO AISs may be granted pending favorable completion of a pre-employment check. Final access may be granted only on a completion of an appropriate investigation based upon the risk level assigned to the contract.

(b) Within 5 days of contract award, the Contractor shall certify in writing to the COTR that its employees, in performance of the contract, have completed annual IT security awareness training in USPTO IT Security policies, procedures, computer ethics, and best practices, in accordance with the USPTO Training Policy. The COTR will inform the Contractor of any other available USPTO training resources.

(c) Within 5 days of contract award, the Contractor shall provide the CORs with signed Nondisclosure Agreements as specified in Commerce Acquisition Regulations (CAR), 1352.209-72, Restrictions Against Disclosures.

(d) The Contractor shall afford USPTO, including the Office of Inspector General, access to the Contractor's and subcontractors facilities, installations, operations, documentation, databases, and personnel used in performance of the contract. Access shall be provided to the extent required to carry out a program of IT inspection, investigation, and audit to safeguard against threats and hazards to the integrity, availability, and confidentiality of USPTO data or to the function of computer AISs operated on behalf of USPTO, and to preserve evidence of computer crime.

(e) The Contractor shall incorporate this clause in all subcontracts that meet the conditions in paragraph (a) of this clause.

(NOTE: Low Risk contracts whose duration is less than 180 days do not ordinarily require security processing. However, even though the contract is short in duration, based on any unusual circumstances that may exist, Special Agreement Checks (SACs) may be requested, at the discretion of the Contracting Officer's Technical Representative (COTR) and/or the USPTO Security Office.)

## SECTION I – CONTRACT CLAUSES

### I.1 52.252-01 CLAUSES INCORPORATED BY REFERENCE (JUN 1998)

This contract incorporates one or more clauses by reference, with the same force and effect as if they were given in full text. Upon request, the Contracting Officer will make their full text available. Also, the full text of a solicitation provision may be accessed electronically at this address: <http://www.arnet.gov/far/>.

Clause	Title	Date
52.202-01	Definitions	July 2004
52.203-03	Gratuities	April 1984
52.203-05	Covenant Against Contingent Fees	April 1984
52.203-6	Restrictions on Subcontractor Sales to the Government	July 1995
52.203-07	Anti-Kickback Procedures	July 1995
52.203-08	Cancellation, Rescission, and Recovery of Funds for Illegal or Improper Activity	January 1997
52.203-10	Price Or Fee Adjustment For Illegal Or Improper Activity	January 1997
52.203-11	Certification and Disclosure Regarding Payments to Influence Certain Federal Transactions	April 1991
52.203-12	Limitation On Payments To Influence Certain Federal Transactions	June 2003
52.204-07	Central Contractor Registration	October 2003
52.204-04	Printed or Copied Double-Sided on Recycled Paper.	August 2000
52.209-06	Protecting the Government's Interest When Subcontracting With Contractors Debarred, Suspended, or Proposed for Debarment	July 1995
52.215-02	Audit and Records--Negotiation	June 1999
52.215-08	Order of Precedence--Uniform Contract Format	October 1997
52.215-14	Integrity of Unit Prices.	October 1997
52.216-22	Indefinite Quantity	October 1995
52.217-08	Option to Extend Services	November 1999
52.219-08	Utilization of Small Business Concerns	May 2004
52.219-09	Small Business Subcontracting Plan	January 2002
52.222-3	Convict Labor	August 1996
52.222-21	Prohibition of Segregated Facilities	February 1999
52.222-26	Equal Opportunity	April 2002
52.222-35	Equal Opportunity for Special Disabled Veterans, Veterans of the Vietnam Era, and Other Eligible Veterans	December 2001
52.222-36	Affirmative Action For Workers with Disabilities	June 1998
52.222-37	Employment Reports on Special Disabled Veterans, Veterans of the Vietnam Era, and Other Eligible Veterans	December 2001
52.223-06	Drug Free Workplace	May 2001
52.223-14	Toxic Chemical Release Reporting	August 2003
52.225-13	Restrictions on Certain Foreign Purchases	December 2003
52.227-1	Authorization and Consent	July 1995
52.227-02	Notice and Assistance Regarding Patent and Copyright Infringement.	August 1996
52.227-03	Patent Indemnity	April 1984
52.229-3	Federal, State and Local Taxes	January 1990
52.232-1	Payments	April 1984
52.232-17	Interest	June 1996
52.232-18	Availability of Funds	April 1984
52.232-19	Availability of Funds For The Next Fiscal Year	April 1984
52.232-23	Assignment Of Claims	January 1986
52.232-25	Prompt Payment	October 2003
52.232-33	Payment by Electronic Funds Transfer--Central Contractor Registration	October 2003
52.233-01	Disputes	July 2002
52.233-03	Protest After Award	August 1996
52.233-04	Applicable Law for Breach of Contract Claim	October 2004

52.237-03	Continuity of Services	January 1991
52.239-1	Privacy or Security Safeguards	August 1996
52.242-13	Bankruptcy	July 1995
52.243-01	Changes—Fixed price (Alternate 1)	August 1987
52.244-02	Subcontracts	October 2004
52.244-6	Subcontracts for Commercial Items	February 2006
52.245-1	Property Records	April 1984
52.245-04	Government Furnished Property	June 2003
52.246-25	Limitation of Liability—Services	February 1997
52.249-02	Termination For Convenience Of The Government (Fixed-Price)	May 2004
52.249-08	Termination For Default (Fixed Price Supply or Service)	April 1984
52.249-14	Excusable Delays	April 1984
52.253-01	Computer Generated Forms	January 1991

## **I.2 52.216-18 ORDERING OCTOBER 1995**

- A. Services to be furnished under this contract shall be ordered by the issuance of a signed work order (Sent to the Contractor via electronic mail/fax from the Contracting Officer (CO) or his designee).
- B. All orders issued hereunder are subject to the terms and conditions of this contract. The Contract shall govern in the event of conflict with any work order.
- C. An order shall be "issued" for purposes of the contract, when it is either deposited in the U.S. Postal Service mail or otherwise furnished to the contractor in conformance with the schedule.
- D. Orders issued will be at the fixed unit prices awarded for CLIN 0001 through CLIN 0008 and within the delivery times specified.

## **I.3 52.216-19 ORDER LIMITATIONS OCTOBER 1995**

(a) Minimum order. When the Government requires supplies or services covered by this contract in an amount less than the minimum stated per CLIN (See Section B) then the Government is not obligated to purchase, nor is the Contractor obligated to furnish, those supplies or services under the contract.

(b) Maximum order. The Contractor is not obligated to honor:

- (1) Any order for a single item in excess of the maximum stated per CLIN (See Section B);
- (2) Any order for a combination of items in excess of total award value; or
- (3) A series of orders from the same ordering office within 1 day that together call for quantities exceeding the limitation in subparagraph (1) or (2) above.

## **I.4 52.216-22 INDEFINITE QUANTITY OCTOBER 1995**

(a) This is an indefinite-quantity contract for the supplies or services specified, and effective for the period stated, in the Schedule. The quantities of supplies and services specified in the Schedule are estimates only and are not purchased by this contract.

(b) Delivery or performance shall be made only as authorized by orders issued in accordance with the Ordering clause. The Contractor shall furnish to the Government, when and if ordered, the supplies or services specified in the Schedule up to and including the quantity designated in the Schedule as the "maximum." The Government shall order at least the quantity of supplies or services designated in the Schedule as the "minimum."

(c) Except for any limitations on quantities in the Order Limitations clause or in the Schedule, there is no limit on the number of orders that may be issued. The Government may issue orders requiring delivery to multiple destinations or performance at multiple locations.

(d) Any order issued during the effective period of this contract and not completed within that period shall be completed by the Contractor within the time specified in the order. The contract shall govern the Contractor's and Government's rights and obligations with respect to that order to the same extent as if the order were completed during the contract's effective period; provided, that the Contractor shall not be required to make any deliveries under this contract beyond 90 days after contract expiration.

## SECTION J - LIST OF ATTACHMENTS

### J.1 List of Attachments

- Attachment 1: PCT Request (PCT/RO/101 form)
- Attachment 2: Declaration of Non-Establishment of International Search Report (PCT/ISA/203 form, hereafter "Form 203" and instructions for preparing Form 203
- Attachment 3: Invitation to Pay Additional Fees (PCT/ISA/206 form, hereafter "Form 206") and instructions for preparing Form 206
- Attachment 4: International Search Report (PCT/ISA/210 form, hereafter "Form 210") and instructions for preparing form 210
- Attachment 5: Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration (PCT/ISA/220 form, hereafter "Form 220") and instructions for preparing Form 220
- Attachment 6: Written Opinion of the International Searching Authority (PCT/ISA/237 form, hereafter "Form 237") and instructions for preparing Form 237
- Attachment 7: Technical Field Breakdown
- Attachment 8: Workflow Diagram
- Attachment 9: Recommended Computer Specifications