

Serbia Accelerating Innovation and Growth Entrepreneurship Project

Terms of Reference

Intellectual Property (IP) Legal Consultant (Part-time)

1. Background

Serbia has received a loan from the World Bank Group for the **Serbia Accelerating Innovation and Growth Entrepreneurship (SAIGE) Project**¹ (Project) to support the strengthening of the Serbian Innovation and Entrepreneurship ecosystem. The main objective of the Project is to improve (i) the relevance and excellence of scientific research; and (ii) innovative entrepreneurship and access to finance for enterprise growth, as a way of contributing to Serbia's growth and competitiveness. The European Union Instrument for Pre-accession Assistance (IPA-II) is also providing complimentary financing support for the SAIGE Project. The Project includes the following three components:

Component 1: Research Sector Reforms

Component 2: Enterprise Acceleration

Component 3: Project Implementation, Monitoring, Capacity Building

The Ministry of Education, Science and Technological Development (MoESTD) is responsible for the overall Project coordination and implementation, as well as execution of Component 1.2 RDI Reforms. Implementation of the Project is carried out by the Project Implementation Unit (PIU) team at the MoESTD comprising of PIU Project Manager, and technical and administrative staff.

2. Objectives of Engagement

The MoESTD is in the process of improving the Serbian public research and development (R&D) sector including a revised policy and legal framework, reform of public R&D Institutions (RDIs), R&D financing model, capacity building of the relevant organizations (Science Fund, Innovation Fund) and relevant institutions, etc.

In this context, in October 2020 the MoESTD engaged a consultancy firm for conducting independent external assessments of a number of RDIs including preparing transformation plans. In December 2021 MoESTD has signed the Memorandum of Understanding with the 6 RDIs defining the roadmap for process of transformation for each RDI; more RDIs are going undergoing a similar process. Important part of the transformation process is capacity building of the RDIs to support knowledge and technology transfer and commercialization of IP arising out of RDIs. This support is expected to help RDIs to clearly understand and interpret Intellectual Property legal framework as it underpins IP ownership and exploitation.

¹ <https://projects.worldbank.org/en/projects-operations/project-detail/P170185>

The RDIs need to develop a comprehensive overview and understanding of national IP regulations, including laws, bylaws, as well as IP related policies and procedures, and to develop internal skills for governing IP ownership. Review of relevant laws and institutional will contribute to better understanding of IP legal potential for IP commercialization and assist RDIs in identifying roadmaps to commercialization of IP.

Therefore, the MoESTD now plans to engage an individual Intellectual Property (IP) legal consultant to assist RDIs to increase their competences in commercialization of IP rights. The consultant will provide advisory services and legal support in preparing for protection and commercialization of research outcomes and therefore help RDI to improve readiness on exploitation of concrete intellectual property. The consultant will support the RDIs objectives in terms of IP and will assist with various aspects of law, by acting in accordance with the local regulations and best international practices.

3. Scope of Work

Following are the specific tasks and responsibilities of the IP consultant:

1. Prepare introductory overview for RDIs on (1) Serbian IP related regulations, including but not limited to: Law on Innovation Activity, Law on Science and Research, Patent Law, Law on Copyright and Related Rights, Law on Protection of Trade Secret, and any other relevant laws, etc., and (2) IP-related internal policies and regulations relevant for the selected RDIs (IP ownership, revenue sharing, etc.);
2. Analyze internal documents and bylaws of the selected RDIs related to IP protection and commercialization;
3. Provide legal support to capacity building of the selected RDIs in the field of IP, and advising on options to improve or create IP policies, procedures and related documents, where necessary:
 - Propose options that lead to clear, unambiguous and uniform policy on ownership of intellectual assets arising out of research from RDIs. These options may include recommendation for changes in existing policies, if necessary, of the selected RDIs;
 - Develop template legal documents in Serbian language, and in English as required, aligned with current Serbian and other relevant legislations, and RDI's internal policies, formalizing: ownership between RDI and researchers and/or between two or more RDIs and researchers, revenue sharing between RDI and inventor(s) including inventors split in case of a team, assignment of rights, including 'options' to transfer rights to an individual or a new company;
 - Provide technical assistance and expert legal advice to RDIs to implement and adopt the template legal documents, through regular communication and meetings with relevant teams and individuals;

4. Advise and support RDIs in communication processes and other relationships on IP issues with legal entities and individuals (natural persons), including but not limited to technology transfer offices, academic and non-academic R&D institutions, private sector companies, public entities and other subjects;
5. Assist and, when necessary, provide recommendation in IP legal aspects of RDIs current and future operations;
6. In close collaboration with SAIGE PIU, the consultant will contribute to the design of the ToR for IP firm service provider under SAIGE to support RDIs on specific IP cases in line with the Transformation Plans.

4. Experience and Qualifications

The candidate suitable for this position should have the following qualifications:

1. University degree in Law obtained from a University in Serbia;
2. Additional education, training and/or experience in the field of intellectual property rights;
3. Qualified at the Serbian Bar (exam passed);
4. Minimum of five years of professional experience in advising clients on legal issues and intellectual property matters, with strong knowledge of the applicable Serbian legal framework;
5. Previous experience of producing and customizing legal documents and agreements related to IP for clients according to Serbian laws, including but not limited to agreements on IP ownership, revenue sharing and assignment of rights;
6. Proven track record in working with Serbian RDIs;
7. Previous experience in advising RDI beneficiaries of a national innovation fund or similar grant scheme will be considered a strong advantage;
8. At least three and preferably five assignments advising RDIs on IP issues, including IP ownership, revenue sharing, etc., in the last three years;
9. Excellent spoken and written Serbian and English language skills.

Selection of consultant

The candidates will be evaluated applying the following evaluation criteria:

- General experience (40 Points)
- Specific Experience relevant to the Assignment (60 Points)

5. Timeframe and Duration

The IP consultant will be engaged on a part-time basis for one year with a probation period of 3 months. The engagement could be subject to appropriate extension and increase of the time effort depending on the Project need and performance. The expected time effort for the assignment is approximately 50 working days.

6. Reporting Obligations

The Consultant will be primarily required to report, at least once per month (monthly) or as necessary according to Project activities and timeline, to the Project Manager for approval.

The Consultant should provide/submit monthly Time Sheets to the Project Manager, summarizing key issues and emerging and day-to-day tasks undertaken, as well as working days/hours spent on each issue and task, within 5 (five) days after the end of month for which the report is due.

The Consultant shall proactively prepare ad-hoc reports on any major IP issues arising during Projects implementation, at the PIU/MoESTD request.

The Consultant will provide hard and/or electronic copies of any documents and technical materials developed during the Project in their original electronic format. The reports will be provided in the English/Serbian language.

7. Terms of Payment

The contract, in the form of the Standard World Bank Time-Based Contract for Small Assignments covering all fees costs and expenses, will be entered into between the Consultant and the MoESTD. Each monthly timesheet must be firstly approved by the Project Manager.