

**QUESTIONS AND ANSWERS ON REQUEST FOR PROPOSALS
FOR
NYS DEPARTMENT OF ECONOMIC DEVELOPMENT (DED)
INTELLECTUAL PROPERTY/TRADEMARK OUTSIDE COUNSEL
RFP NUMBER 19-6139**

Question: How are these services provided currently?

Answer: The Department currently contracts with an IP law firm to provides these services.

Question: How many marks does NYSDDED hold?

Answer: The Department currently holds approximately 30 trademarks registered with the USPTO and several other marks registered internationally.

Question: Can you provide a complete list of NYSDDED’s trademark applications/registrations (domestic and International), or provide a list of the countries in which NYSDDED own trademark applications/registrations?

Answer: The Department has trademark rights in various countries throughout the world, including, but not limited to, Japan, Australia, Canada, Argentina and the European Union. A complete list will be provided to the winning bidder.

Question: How many trademark applications does NYSDDED file each year?

Answer: Approximately 2-5 trademark applications per year. This number varies from year to year.

Question: What other entities’ marks in the NYS ESD jurisdiction are included in this solicitation?

Answer: This solicitation is for a law firm to work primarily on ILNY related IP legal matters. On occasion the winning bidder may be asked to assist with counsel on other trademarks owned by the State.

Question: How many active litigations are underway? Who are the parties? We will need this information for a conflict check? [RFP Section 2.1(iii)]

Answer: None.

Question: To what degree does “the identification of infringing activity” include efforts by the Contractor to discover new infringers? [RFP Section 2.1(ii)]

Answer: The winning bidder may be asked to monitor infringers of the ILNY mark.

Question: Any pending or critical deadlines in the next 30, 60, or 90 days following award?

Answer: The Department maintains and renews its portfolio of trademarks and carefully tracks them on an ongoing basis. Deadlines will be discussed with the winning bidder.

Question: Is there a licensing agent or brand manager working on the program? If so, what is the scope of services provided?

Answer: Yes, the Department contracts with a licensing agent to promote the ILNY Mark. Our licensing agent identifies and facilitates royalty-based licensing agreements with partners all over the world.

Question: Licensing is only mentioned in the context of social media. To what extent does the scope of services cover licensing for other media? To what degree will the Contractor take an active role in license negotiation? [Section 2.1(iv)]

Answer: The legal work envisioned under this RFP extends to licensing services generally. The winning bidder may be asked to be involved in license negotiations, though those are primarily handled by our licensing agency.

Question: How many licenses does NYSDDED manage? (RFP Section 2.0 & 2.1)

Answer: The Department manages approximately 40 revenue generating licenses as well as many royalty free licenses.

Question: How many legal actions relating to any aspect of the program have been filed by third parties in the last 5 years?

Answer: One third party has filed a legal action against the Department in the last five years.

Question: How many enforcement actions have been filed against infringers of the marks in the last year? Last 5 years?

Answer: The Department's enforcement actions are a matter of public record. The Department vigorously defends its trademark portfolio.

Question: How much copyrighted material does NYSDDED manage? Is this material licensed out to third parties? [RFP Section 2.1(v)]

Answer: Copyright issues occasionally arise within the context of I Love NY but the majority of the work centers around trademark issues.

Question: Do you currently have an enforcement program? If so, what third-party vendors currently provide technology or services used to execute the program?

Answer: The Department has an enforcement strategy which includes the use of a hologram program to prevent counterfeiting of goods.

Question: What have been the key challenges or policy constraints faced by the program?

Answer: The major challenge the Department faces is protecting against the rampant infringement of the portfolio of I Love NY Marks given its finite resources.

Question: What is the process by which licenses to the marks are given?

Answer: As this RFP is focused on legal work associated with licensing, this question is not pertinent to the RFP.

Question: What steps are taken currently to authenticate products identified by the marks?

Answer: The specifics of Department strategy regarding its trademark portfolio will be shared with the winning bidder.

Question: Who currently manufactures for NYS ESD products identified by the marks? What is the process for authorizing such manufacturers?

Answer: As this RFP is focused on legal work associated with licensing, this question is not pertinent to the RFP.

Question: What kind of showing of the firm's "economic resources" is expected? (RFP section 2.3.3)

Answer: The purpose of section 2.3.3 is to notify potential applicants that the resulting contract will be on a cost reimbursement basis. The Contractor must be able to pay expenses in advance of being reimbursed by NYSDED.

Question: Is it possible to obtain a copy of any previous winning proposals for this contract or a similar contract?

Answer: Records of the Department are subject to Freedom of Information Law.

Question: Is the \$500,000 budget inclusive of disbursements and direct expenses?

Answer: Yes, it is.

Question: Can you describe the nature of any ongoing vendor relationships currently in place related to trademark registration, maintenance, and enforcement? Would you provide an estimate or range of fees currently paid for these services? Specifically:

1. Does NYSDED currently use a global renewal service for trademarks? If so, who?

2. Does NYSDDED currently use a global watch service? If so, who?
3. What is NYSDDED's current trademark docketing platform?

Answer: The Department does not use a global renewal service. It does, however, utilize various domestic and global watch services.

Question: Could you share the amounts of NYSDDED's legal spend over the last five years in the following areas:

1. Trademark prosecution in the United States?
2. Trademark enforcement in the United States?
3. Trademark litigation in the United States?
4. Amounts paid to foreign counsel, inclusive of fees and government costs?

Answer: The history of the Department's legal spending will not be disclosed at this time.

Question: Which countries and/or jurisdictions outside the United States are NYSDDED's top ten markets for: (1) merchandising, promotional activity, and commercial sales; and (2) trademarks?

Answer: Japan and the United Kingdom are the main markets for merchandising currently.

Question: Does NYSDDED have preferred counsel in any regions outside the United States and if so, what firms are they?

Answer: The Department does not have preferred counsel outside the US.

Question: How many foreign filings has NYSDDED submitted in the past three years?

Answer: The Department has submitted several foreign filings over the past three years.

Question: Is NYSDDED open to solutions related to blockchain technology? Would NYSDDED use a blockchain firm as outside counsel given that there is a senior-level attorney with the desired qualifications?

Answer: To date, the Department has not utilized blockchain technology. The Department will consider technology that helps achieve the stated goals of the RFP.

Question: Please confirm that the proposal narrative should be a total of 12-15 pages, encompassing answers to sections 3.1.1 through 3.1.6, but excluding the budget form and other executed forms under section 3.1.8.

Answer: The full proposal should not exceed 15 pages. That limit would not include the required forms, budget, title page and staff resumes.