

## **Intellectual Property Terms and Conditions Agreement**

*(Sign and attach to RFP response)*

The Board of Trustees of the University of Illinois (hereinafter “University”) has received an appropriation from the Andrew W. Mellon Foundation (“Foundation”) for use by the Graduate School of Library and Information Science in support of the Workset Creation for Scholarly Analysis project (“Project”). This Project is being conducted by the University of Illinois and Indiana University, collectively are referred to as “Partners”.

The Partners have issued an open Request for Proposals (“RFP”). Respondents to the RFP (“Respondents”) must indicate an explicit understanding with the University about the rights of the University and the Foundation in any intellectual property that might result from its investment in the Project. This agreement (“Agreement”) between the Respondent and the University sets forth the terms that will govern the intellectual property to be created or developed in connection with or otherwise incorporated into the Project. While the Foundation will not obtain ownership rights in such intellectual property, it requires the Partners and, in extension the Respondents, to agree to these terms as a condition of funding in furtherance of the Foundation’s mandate to ensure that Foundation funds be used for the greatest possible educational, scholarly, and and/or charitable benefit.

For the purposes of this Agreement, “Software” is defined as any computer programs, source codes, scripts, build files, object codes, machine codes, processes, inventions, methods, tools, techniques, program or system architectures, prototypes, and/or related documentation created or developed in connection with or otherwise incorporated in the Project, including but not limited to any modifications thereto. “Grant Term” is defined as the period set forth in the University’s grant award letter and any subsequent written amendments to the grant period authorized by the University.

In consideration of the University’s support of the Respondent’s proposal, the Respondent agrees as follows:

### **Open Source License**

1. The Respondent shall make the Software available on a royalty-free, open source basis, pursuant to an open source license located at [www.opensource.org](http://www.opensource.org).

### **Content of Software**

2. The Respondent shall incorporate in the Software only those digital products that are distributed and/or made available under an open source license that would allow the Respondent to distribute the Software under the open source license referenced in paragraph 1.

### **Publicity**

3. The Respondent shall take proactive steps in publications and at conferences to inform the public of the availability of the Software on a royalty-free, open source basis in an open source repository such as SourceForge.net and/or the Web site of the project.

### **Right, Title, and Interest**

4. The Respondent represents and warrants that all Software created or developed by or for the Respondent, as applicable, will either be: (a) created by employees acting within the scope of their employment as a “work made for hire” under 17 U.S.C. § 101 and who have entered into a signed, written contract assigning all other present and future right, title, and interest in such work to the Respondent, or (b) created by contractors, consultants, advisors, students, or other collaborators with whom the Respondent has entered into a signed, written contract assigning all present and future right, title, and interest in such work to the Respondent.

### **Infringement**

5. The Respondent represents and warrants that use of the Software (in conformance with any terms and conditions of use imposed by the Respondent) does not and will not infringe on or misappropriate the copyright, patent, trade secret, or other rights of any person or entity.

### **License to Software**

6. The Respondent hereby grants the Foundation, and/or a Foundation-designated nonprofit entity, a worldwide, perpetual, irrevocable, nonexclusive, royalty-free license to exercise all of its intellectual property rights (including sublicense right through multiple tiers of sublicensees) in the Software for noncommercial educational, scholarly, and/or charitable purposes; provided however that the Foundation shall exercise its rights pursuant to the foregoing license only in the event that the Software is not made available under the open source license referenced in paragraph 1 by the end of the Grant Term or at any time thereafter for any reason, including as a result of termination of the grant to the Respondent. In the event that the Foundation exercises its license right pursuant to this paragraph 6, the Respondent (a) acknowledges that the license to the Foundation shall, among other things, permit the Foundation to have the Software further developed and made available by a third party subject to the restrictions set forth in the license grant, and (b) shall cooperate with the Foundation, both during and after the Grant Term, to facilitate the transfer to the Foundation and/or a Foundation-designated nonprofit entity of such information (including without limitation computer programs, source codes, scripts, build files, object codes, machine codes, processes, inventions, methods, tools, techniques, program or system architectures, prototypes, and/or related documentation) as the Foundation may reasonably request in order for the Foundation to enjoy the license granted to it.

### **Maintenance of Software**

7. The University agrees to maintain Software developed by the Respondent during the Grant Term, and for 5 years following the end of the Grant Term sufficient to provide users with a quality of service consistent with then-current infrastructure required to operate the Software and the then-current standards of user service in the software and online information provision industry. The Respondent shall make available any modifications, fixes, clarifications, revisions, or upgrades of the Software prepared in connection with such maintenance activities on a royalty-free basis and pursuant to the open source license established in paragraph 1 during the Grant Term and subsequent five-year period.

## **Fees**

8. To the extent that the Respondent, or any appointed vendor, charges any license or service fees for additional services beyond the specified Software to the nonprofit educational, scholarly, and/or charitable communities, the Respondent agrees to obtain the Foundation's approval for such pricing in advance of the initial for-fee offering (whether during or after the Grant Term) and in advance of any subsequent changes in pricing that occur during the Grant Term. Notwithstanding anything to the contrary in this paragraph 8, with respect to Software, the Foundation acknowledges that small amounts of code generated pursuant to the Project will be hosted in the HTRC software and services, and nothing in this paragraph 8 is intended to restrict HTRC's ability to accept reasonable funding from membership or other paying services necessary to ensure HTRC's sustainability as an ongoing project. Notwithstanding the foregoing, the Respondent agrees that neither the intent nor the reasonable effect of charging fees for services would be inconsistent with the commitment of the Respondent to provide effective, free-of-charge versions of the Software.

## **Transfer and Assignment**

9. The Foundation reserves the right to approve, or withhold approval, in advance of any proposed transfer or assignment of the Project (or any part thereof) or the Software, which approval will not be unreasonably withheld. The Respondent represents and warrants that any permitted assignment or other transfer of the Project (or any part thereof) or the Software shall be subject to its representations, warranties, and obligations under this Agreement, and any purported assignment or transfer to the contrary shall be null and void.

## **Foundation Involvement**

10. The Respondent acknowledges and agrees that, to the best of its knowledge, the Foundation will derive no direct or indirect financial benefit from the Project or the Software, and that the Foundation has no right or ability to supervise or control the implementation and uses of the Project or Software (other than the right to approve pricing, transfer, and assignment as set forth in paragraphs 8 and 9). In no event shall the Foundation or its officers, trustees, employees, or agents be responsible for any representations or warranties made by the Respondent regarding the Project or Software, nor shall the Foundation be liable for any direct, indirect, special, consequential, punitive, incidental, or other damages related to the Project or use of the Software by any person or entity, either during the Grant Term or thereafter. The Respondent shall be responsible for all damages arising out of the acts or omissions of the Respondent or any respective employees, contractors, consultants, advisors, students, or other collaborators; provided, however, that nothing in this paragraph is intended to allocate such responsibility. The Respondent shall not make any statements, representations, or warranties, or accept any liabilities or responsibilities whatsoever, with regard to any person or entity that are inconsistent with any disclaimer or limitation specified in this paragraph 10.

## **Choice of Law and Jurisdiction**

11. This Agreement shall be governed by the copyright laws of the United States.

**Execution**

12. This Agreement may be executed in counterparts, each of which shall be deemed an original, but all of which together shall constitute one agreement. A facsimile or PDF copy of a signature shall have the same effect and validity as an original.

**Headings**

13. The headings in this Agreement are inserted as a matter of convenience only and do not define, limit, or describe the scope of this Agreement or the intent of the provisions hereof.

**Merger**

14. This Agreement, together with the Proposal, constitutes the entire agreement and supersedes all prior communications, understandings, and agreements between the Parties, whether written or oral, relating to the subject matter herein.

We ask that the Respondent indicate consent to these terms by having an officer with corporate authority sign below, thus binding the Respondent , and by returning one original signed copy of this letter to me as soon as possible.

(Respondent PI)

By: \_\_\_\_\_

Name (printed): \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

(For the Respondent Institution)

Name of Institution: \_\_\_\_\_

By: \_\_\_\_\_

Name (printed): \_\_\_\_\_

Title: \_\_\_\_\_

Address: \_\_\_\_\_

\_\_\_\_\_

Phone: \_\_\_\_\_

Email: \_\_\_\_\_

Date: \_\_\_\_\_