

**INTELLECTUAL PROPERTY TERMS & CONDITIONS AGREEMENT**  
**(SIGN AND ATTACH TO RFP RESPONSE)**

The Board of Trustees of the University of Illinois (“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 Open Annotation Collaboration project (“Project”). This Project is being conducted in partnership with a number of other institutions whom collectively are referred to as “Partners”. The Project is moving into Phase 2 and the Partners contemplate the need for continued collaborative efforts and have issued a Request for Proposals (“RFP”). Respondents to the RFP need to have an explicit understanding with the University about the rights of the Foundation in any intellectual property that might result from its investment in the Project.

If Respondent is awarded funds to carry out the proposed Project, the Foundation does not expect to hold the intellectual property ownership rights in any software, source codes, processes, tools, techniques, architecture, prototypes, and/or related documentation, whether patentable or copyrightable, conceived, created or developed by the Respondent, University and/or Partners in connection with or otherwise incorporated in the Project, including but not limited to any modified and/or derivative software products, source codes, processes, tools, techniques, architecture, prototypes, and/or related documentation (collectively, "Software") and all reports, evaluations, analyses and other documents, other than Software documentation, prepared in connection with or otherwise relating to the Project (collectively, "Documents"). Presumably, these would be the property of the Respondent, the property of the Partners collaborating with the Respondent in the implementation of the Project, and/or the property of other owners from whom the Respondent has obtained or will obtain usage rights. However, consistent with the Foundation's mandate to ensure that the products developed with its funds be used for the greatest possible educational benefit, any grant made by the University from a response to this RFP is conditioned upon the agreement of the Respondent to the following terms (University and Partners have already agreed to equivalent terms as a precondition of the Prime Award):

1. Respondent shall agree, and shall obtain the agreement of any Collaborating Institutions, to make available to the nonprofit educational, scholarly, and charitable communities all Software developed under the Proposal on a royalty-free basis, pursuant to an open source license, pursuant to the open source principles set forth on [opensource.org](http://opensource.org). Respondent shall, and shall obtain the agreement of any Collaborating Institutions to make available all Documents to the nonprofit educational, scholarly, and charitable communities on a royalty-free basis, under a Creative Commons Attribution license permitting, at a minimum, non-commercial use and modification; but Respondent and/or any Collaborating Institutions shall not be required to make any distribution or disclosure of any Documents whose significance is limited to the internal administration of the Project.
2. Respondent shall, and shall obtain the agreement of any Collaborating Institutions to, take proactive steps in publications and at conferences to inform the nonprofit educational, scholarly, and charitable communities of the availability of (a) the Software, on a royalty-free, open source basis in an open source depository such as [SourceForge.net](http://SourceForge.net) and/or its project website, or office of technology transfer and (b) the Documents in searchable PDF format, on a no-fee, publicly available, stable Web site for a period ending no less than three years after the end of the grant period. No later than sixty (60) days after the original publication of the Documents, Respondent and/or any Collaborating Institutions shall provide UIUC with one electronic copy of the public Documents in original, editable format.
3. Respondent shall, and shall obtain the agreement of any Collaborating Institutions to, incorporate in the Documents only those materials, and in the Software only those digital products, including but not limited to software, source codes, processes, tools, techniques, and/or related documentation that can be used by the educational, scholarly, and charitable communities without any licensing fee or restriction on use or further distribution. Respondent agrees and represents, and shall obtain the agreement of any Collaborating

Institutions, that all Software and Documents created, conceived, and/or developed will either be conceived, created, and/or developed by: (a) employees of Respondent, a [OAC] Partner, a Collaborating Institution, or a contributor to the Project acting within the course of their employment as a "work made for hire" under 17 U.S.C. § 101 and assigning all patent rights to Respondent, a Partner, or a Collaborating Institution; or (b) partners, contractors, consultants, advisors, students or other collaborators with whom Respondent, a Partner, or a Collaborating Institution has entered into a signed, written contract, executed prior to the creation of the work assigning all rights, titles, and interest in such work to Respondent, a Partner, or a Collaborating Institution.

4. Respondent shall, and Respondent shall obtain the agreement of any Collaborating Institutions to, obtain all necessary licenses such that the Software and Documents developed for Respondent, the Partners, and/or the Collaborating Institutions for their use and use by third parties (in conformance with any terms and conditions of use imposed by Respondent, a Partner, or a Collaborating Institution) will not infringe on the copyright, patent or other rights of any third parties.

5. Respondent agrees, and shall obtain the agreement of any Collaborating Institution that any license or service fees charged by Respondent, the Partners, or a Collaborating Institution for the Software or Documents will be for additional services or functionality beyond the specified Software and Documents and that neither the intent nor the reasonable effect of such fees will be to denigrate Respondent's commitment to provide effective, free-of-charge versions of the Software and Documents.

6. Respondent acknowledges and agrees that, to the best of its knowledge, the Foundation will derive no direct or indirect financial benefit from the Project, Documents, or Software and that the Foundation has no right or ability to supervise or control the implementation and uses of the Project, Documents or Software. In no event shall the Foundation or its officers, trustees, employees or agents be responsible for any representations or warranties made by Respondent, the Partners, or any Collaborating Institutions regarding the Project, Documents, or Software, nor shall the Foundation be liable for any direct, indirect, special, consequential, punitive, incidental, or other damages related to use by Respondent, the Partners, any Collaborating Institutions, or any third party of the Documents or Software. Respondent shall not, and shall obtain the agreement of any Collaborating Institutions not to, 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 6.

7. Respondent agrees and acknowledges, and shall obtain the agreement of any Collaborating Institutions, that any assignment or other transfer of the copyright in or ownership of the Documents or Software shall be subject to the representations, agreements and obligations under this Agreement and any purported assignment or transfer to the contrary shall be null and void.

8. Respondent shall, and shall obtain the agreement of any Collaborating Institutions to, have agreements with all contributors to the Project that will allow Respondent, the Partners, and the Collaborating Institutions to comply with the provisions in this Agreement.

9. This Agreement constitutes the entire agreement and supersedes all prior or contemporaneous communications, understandings, and agreements between the parties, whether written or oral, relating to the subject matter herein.

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

11. This Agreement may be executed in counterparts, each of which shall be deemed an original, but all of which together shall constitute one agreement. In entering into this Agreement, the Foundation's sole interest is to serve scholarly purposes.

The University asks that the Respondent indicate their consent to these terms by having an officer with corporate authority sign below, thus binding the Respondent in the event their proposal is selected for funding, and include signed copy of this agreement as an integral part of their response to this RFP.

(Respondent PI)

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

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

(For the Respondent Institution)

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

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

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

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

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

\_\_\_\_\_

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

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