

University of California
Office of the President

Senior Vice President—
Business and Finance

Research Administration Office

Memo

Operating Guidance

No. 01-06, Sup. 1
February 15, 2006

CONTRACT AND GRANT OFFICERS (CAMPUS AND LAB)* VICE CHANCELLORS--ADMINISTRATION

Subject: California State Department of Transportation – University of California Interagency
Transportation Research Master Agreement No. 65A0108, Amendment No. A/1

The subject Amendment to the Transportation Research Master Agreement 6A0108 (CalTrans IMA) extends this IMA from June 30, 2005 to December 31, 2006. In addition, this Amendment replaces Article XI, Rights in Data, in its entirety and adds a new Article XXIII, Reasonable Due Diligence.

Article XI, Rights in Data:

This Article has been significantly altered to include in paragraph A. a full description of possible data deliverables under an individual task order. A new paragraph B. now sets forth the terms and conditions that apply to software development. Campus investigators developing software under a task order under this IMA should be made aware of these new requirements.

Article XXIII, Reasonable Due Diligence:

This new Article sets forth the requirements for an infringement search for

..... any patents copyrights, trademarks or other intellectual property rights of third parties on technology identified as likely to be embodied in a deliverable under a given agreement in a scope of work as approved by Caltrans.

Our office, in consultation with the Office of Technology Transfer, will be providing guidance on complying with this clause in a separate supplement to this memo.

*Note: The addressees above represent the standard distribution of Contract and Grant Memos. Additional addressees, if any, may be added based on the subject of the Memo. See cc's.

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Terms of IMA 65A0108:

All other terms and conditions in CalTrans IMA 65A0108 remain unchanged. This IMA and our office's guidance on its implementation is published in *Contract and Grant Operating Guidance Memo 01-06*, dated August 2, 2001. <http://www.ucop.edu/raohome/cgmemos/01-06.html>

Refer: David F. Mears
(510) 987-9849
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Subject: 02, 11
Organization: S-010

David F. Mears
Director

Enclosure

STANDARD AGREEMENT AMENDMENT

STD 213 A (Rev 6/03)

 CHECK HERE IF ADDITIONAL PAGES ARE ATTACHED 5 Pages

AGREEMENT NUMBER

65A0108

AMENDMENT NUMBER

A/1

REGISTRATION NUMBER

1. This Agreement is entered into between the State Agency and Contractor named below:

STATE AGENCY'S NAME

Department of Transportation

CONTRACTOR'S NAME

Regents of the University of California

2. The term of this

Agreement is July 1, 2001 through December 31, 2006

3. The maximum amount of this \$0.00

Agreement after this amendment is:

4. The parties mutually agree to this amendment as follows. All actions noted below are by this reference made a part of the Agreement and incorporated herein:

Article III – Contract Period, is amended to read as follows:

This **Transportation Research Master Agreement 65A0108** shall begin on **July 1, 2001**, contingent upon approval by the State, and terminate on **December 31, 2006**, unless extended by an amendment to this Agreement.

Article XV – Rights to Data, is replaced in entirety with the following language:

A. Ownership of Data:

Upon completion of each task under this Contract, the Contractor shall provide all reports, documents, plans, magnetic tapes of project data, specifications, and estimates produced as part of that task to the Department, and no further Contract, except as covered below, will be necessary to transfer such data to the Department. The

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IN WITNESS WHEREOF, this Agreement has been executed by the parties hereto.

CONTRACTOR

CONTRACTOR'S NAME (If other than an individual, state whether a corporation, partnership, etc.)

Regents of the University of California

BY (Authorized Signature)



DATE SIGNED (Do not type)

6/9/2005

PRINTED NAME AND TITLE OF PERSON SIGNING

DAVID F. MEATZ, DIRECTOR

ADDRESS

Office of the President, 1111 Franklin Street Oakland, CA 94607-5200

STATE OF CALIFORNIA

AGENCY NAME

Department of Transportation

BY (Authorized Signature)



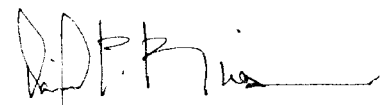
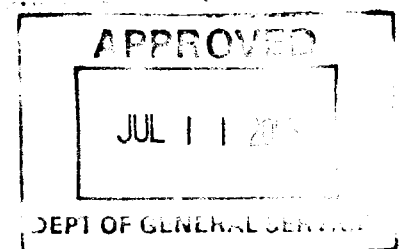
DATE SIGNED (Do not type)

6/17/05

PRINTED NAME AND TITLE OF PERSON SIGNING

Jeffrey Rowe, Contract Officer

ADDRESS

1727 30th Street Sacramento, CA 95816-7006CALIFORNIA
Department of General Services
Use Only Exempt per:

Contractor shall furnish the Department all necessary copies of data to complete the review and approval process. The rights to any such data will be the sole property of the Contractor. However, the Contractor and or subcontractor agrees to and does hereby grant to any and all government agency of the State of California an irrevocable, non-exclusive, non-transferable and royalty-free license to use such data in manufacture, use and disposition, according to law, of any article or material, and in the use of any method that may be developed as part of the work under this Agreement. Such manufacture, use, and disposition, however, shall not be for commercial purposes but only for use by the State of California.

B. Software:

1. Definitions of terms used and applied in this Article:

- a) The terms "SOFTWARE" refers to software products, including programs, routine and databases supplied or developed by the Contractor.
- b) The term "SUPPLIED" refers to products obtained from their owner and used without modifications.
- c) The term "DEVELOPED" refers to (1) products obtained from their owner and modified, or (2) products created by the Contractor.
- d) The term "THIRD PARTY SOFTWARE" refers to software, including but not limited to operating systems, languages, word processors, database, spreadsheet processors, utility programs, standard device drivers, application generators, graphic utilities, and software libraries which are owned by a third-party.
- e) The term "CONTRACTOR SOFTWARE" refers to software owned and copyrighted by the Contractor. This category of software includes, but is not limited to general-purpose network communications and graphic interface utilities, and applications programming and development tools.
- f) The term "APPLICATIONS SOFTWARE" refers to all software (excluding third party software and Contractor software) and associated documentation developed under this Contract.
- g) The term "SOFTWARE DOCUMENTATION" refers to all manuals, handbooks, maintenance and libraries and other documents provided via electronic media and printed matter as part of software for operations, use and maintenance software.
- h) The term "SOURCE CODE DOCUMENTATION" refers to the program level software design documentation, associated data files, data structures, and algorithms necessary for the Department to make program code level modifications to a delivered software product.
- i) The term "SOURCE CODE" refers to complete program source code listings, internal documentation embedded in source code listings, associated data files, and data structures necessary for program code level modifications to software.

2. Ownership and use of Software and Associated Documentation:

a) General:

- i. The Contractor shall not supply or develop software, which requires the use of non-commercially available proprietary software for proper operation, maintenance, support, or debugging without prior written approval from the Task Order Project Manager.

b) Software:

- ii. All software developed as contract deliverables by the Contractor shall be provided to the Department with source code and source code documentation. The Department shall have the royalty-free, unlimited, nonexclusive, and irrevocable license to use, share with any party or modify for use, in any way it chooses, all software, including its associated source code and source code documentation, in any application conducted by the Department. Also, the Department shall have royalty-free, unlimited,

nonexclusive, and irrevocable license to distribute, and disclose all software developed as a contract deliverable by the Contractor under this agreement, including its associated source code and source code documentation, in any application within the State of California conducted by the Department or any public agency, private company or academic institution under Contract with the State.

3. Confidentiality and Non-disclosure:

- a) Unless otherwise authorized in writing by the Contractor the Department shall not loan, give transfer or disseminate all, or any part of, Contractor software to any third-party, firm, Contractor or consultant to copy, reproduce, duplicate, read, or evaluate except as allowed to use, or modify under the terms and conditions of this Contract.
- b) When the Department deems it is necessary for an outside consultant or Contractor of the Department working on behalf of the Department to review, evaluate and install, modify, or otherwise use Contractor software or associated documentation for the expressed purpose of maintaining, upgrading, modifying, or reinstalling of said software products within the Department's jurisdiction, the Department may disseminate certain specific and limited portions of software to said consultants or Contractor on a "need to know" basis, subsequent to signing of a "Contractor Confidentially and Non-disclosure Contract" incorporating the terms of this Contract. The "Contractor Confidentially and Non-disclosure Contract" shall be prepared by the Department, and shall be signed by the Department and the Consultant or Contractor. A fully executed copy of the "Contractor Confidentially and Non-disclosure Contract" shall be forwarded to the Contractor prior to the dissemination or transfer of any software covered by this Contract.
- c) Any Subcontract entered into as a result of this Contract shall contain all provisions of this Article.

Article XXIII – Reasonable Due Diligence, is hereby added to the agreement:

The parties share a mutual interest in the usability of deliverables and avoidance of financial risk from threatened or actual legal claims of patent infringement by third parties regarding those deliverables. The parties stand together and will cooperate to actualize these values in the interest of optimizing the productivity of the institution to institution relationship which began in 1947.

A. Mitigation Procedures

The contractor agrees to conduct, or have conducted as a contract performance requirement, a reasonable infringement search of any patents copyrights, trademarks or other intellectual property rights of third parties on technology identified as likely to be embodied in a deliverable under a given agreement in a scope of work as approved by Caltrans.

The search will be conducted at the outset of a project based on what is expected and known at the time, and again after the results of the research are known and before the final deliverable(s) are provided to Caltrans.

The parties acknowledge that the potential risk of an infringement claim by a third party will vary according to the substance of the scope of work. Caltrans may waive the search requirement by written notice where a search does not appear necessary. If the search identifies an actual or threatened intellectual property infringement, or there is a positive finding that there is intellectual property owned by a third party that will be included in a deliverable, the University shall provide the results of the search to Caltrans and request program direction.

Caltrans may, in accordance with this and other provisions of this contract, direct the contractor to:

1. Modify the technology described in the scope of work as likely to be embodied in a deliverable; or
2. Substitute alternative non-infringing technology, if available; or
3. Investigate the feasibility of a license with the intellectual property holder; or

4. Deliver the technology despite the potential for infringement, for example where no significant infringing use of the technology is contemplated; or
5. Retain the services of outside patent counsel for an opinion about the validity of the actual or threatened claim of infringement regarding such a deliverable. If Caltrans directs the University to retain outside counsel, the contractor will do so in full consultation with Caltrans Chief Counsel.

B. Procedures to manage threatened or actual infringement suits by third parties

1. Suit against Caltrans:

In the event a third party threatens or files an infringement suit against Caltrans regarding technology to be or that was embodied in a deliverable, the University agrees to cooperate and provide pertinent documents regarding such deliverable as requested by counsel designated by Caltrans as its legal representative in such infringement claim, subject to the documents availability to the University and allowable disclosure under applicable law. Caltrans may also contact pertinent University personnel and faculty regarding such infringement suit or allegation. Requests for such documents and contact with personnel in connection with such a potential or actual suit shall be directed to the University's Office of General Counsel for coordination. Caltrans will provide notice of a threatened or actual suit for infringement to the Contractor's Office of General Counsel and provide periodic updates regarding the status of the action. Caltrans shall retain its rights to cross-complain against the University regarding the University's actions and deliverable(s) when deemed necessary by Caltrans counsel for the defense of any action(s) wherein Caltrans is a named party to an infringement suit.

2. Suit against the University:

In the event a third party threatens or files an infringement suit against the University regarding technology to be or that was embodied in a deliverable to Caltrans, Caltrans agrees to cooperate and provide pertinent documents regarding such a deliverable as requested by counsel a designated by the University as its legal representative in such infringement claim, subject to the documents availability to Caltrans and allowable disclosure under applicable law. The University may also contact pertinent Caltrans personnel regarding such deliverable. Requests for such documents and contact with personnel in connection with such a potential or actual suit shall be directed to the Caltrans Chief Counsel or the Legal Office designated by the Chief Counsel for coordination. The University will provide notification of such a potential or actual suit to Caltrans Chief Counsel and provide periodic updates regarding the status of the action. The University shall retain its rights to cross-complain against Caltrans regarding Caltrans' actions and deliverable(s) when deemed necessary by the University counsel for the defense of any action(s) wherein the University is a named party to an infringement suit.

3. Suit against both Caltrans and the University:

In the event a third party threatens or files an infringement suit against Caltrans and the University, the parties:

- a) Agree to cooperate and provide pertinent documents regarding technology to be or as embodied in a deliverable as requested by either party, or the party's designated outside counsel as its legal representative in such patent infringement claim subject to the documents' availability and allowable disclosure under applicable law.
- b) May have contact with pertinent personnel regarding such deliverable.
- c) Requests for documents and contact with personnel in connection with such a potential or actual suit shall be directed to the respective party's Legal Office for coordination or another office designated by the Legal Office.
- d) Will discuss the efficacy of joint representation, and the availability of legal defense.

- e) Will enter a good faith discussion of fee allocation based on facts of the case.
- f) Will enter a good faith discussion regarding the allocation of damages consistent with court findings.

All other terms and conditions of the original agreement and any amendments shall remain in full force and effect.