**Title and Intellectual Property Rights**

[These terms will apply if [Vendor Abbreviation] will be developing or modifying software or will be developing Deliverables that contain other intellectual property. They are subject to negotiation. However, the approval of the General Counsel for MassIT is required for any changes to these terms.]

1. **Definition of Property**

The term Property as used herein includes the following forms of property: (1) confidential, proprietary, and trade secret information; (2) trademarks, trade names, discoveries, inventions processes, methods and improvements, whether or not patentable or subject to copyright protection and whether or not reduced to tangible form or reduced to practice; and (3) works of authorship, wherein such forms of property are required by [Vendor Abbreviation] to complete its work under the SOW and may consist of computer programs (in object and source code form), scripts, data, documentation, the audio, visual and audiovisual content related to layout and graphic presentation, text, photographs, video, pictures, animation, sound recordings, training materials, images, techniques, methods, algorithms, program images, text visible on the Internet, HTML code and images, illustrations, graphics, pages, storyboards, writings, drawings, sketches, models, samples, data, other technical or business information, reports, and other works of authorship fixed in any tangible medium.

1. **Source of Pr****operty**

[Vendor Abbreviation]’s work under this SOW may involve intellectual property derived from four different sources: (1) a third party such as …[this provision may not apply to all contracts, but it could apply if [Vendor Abbreviation] is using third party intellectual property to perform tasks or deliver Deliverables, e.g. configuring another entity’s COTS]; (2) that developed by [Vendor Abbreviation] for the open market (e.g. [Vendor Abbreviation]’s commercial off the shelf software); (3) that developed by [Vendor Abbreviation] for other individual clients, or for internal purposes prior to the Effective Date of this Statement of Work and not delivered to any other client of [Vendor Abbreviation]’s; and (4) developed by [Vendor Abbreviation] specifically for the purposes of fulfilling its obligations to [Agency Abbreviation] under the terms of this Agreement. Ownership of the first and second categories of intellectual property is addressed in separate agreements between [Agency Abbreviation] and the contractors and resellers of work product. This Section 11.3 of the Statement of Work addresses exclusively ownership rights in the third and fourth categories of intellectual property.

1. **[Vendor Abbreviation] Property and License**

[Vendor Abbreviation] will retain all right, title and interest in and to all Property developed by it, i) for clients other than the Commonwealth, and ii) for internal purposes and not yet delivered to any client, including all copyright, patent, trade secret, trademark and other intellectual property rights created by [Vendor Abbreviation] in connection with such work (hereinafter the "[Vendor Abbreviation] Property"). [Agency Abbreviation] acknowledges that its possession, installation or use of [Vendor Abbreviation] Property will not transfer to it any title to such property.

[Agency Abbreviation] acknowledges that [Vendor Abbreviation] Property contains or constitutes commercially valuable and proprietary trade secrets of [Vendor Abbreviation], the development of which involved the expenditure of substantial time and money and the use of skilled development experts. [Agency Abbreviation] acknowledges that [Vendor Abbreviation] Property is being disclosed to [Agency Abbreviation] to be used only as expressly permitted under the terms herein. [Agency Abbreviation] will take no affirmative steps to disclose such information to third parties, and, if required to do so under the Commonwealth’s Public Records Law, M.G.L. c. 66 § 10, or by legal process, will promptly notify [Vendor Abbreviation] of the imminent disclosure so that [Vendor Abbreviation] can take steps to defend itself against such disclosure.

Except as expressly authorized herein, [Agency Abbreviation] will not copy, modify, distribute or transfer by any means, display, sublicense, rent, reverse engineer, decompile or disassemble [Vendor Abbreviation] Property.

[Vendor Abbreviation] grants to [Agency Abbreviation], a fully-paid, royalty-free, non-exclusive, non-transferable, worldwide, irrevocable, perpetual, assignable license to make, have made, use, reproduce, distribute, modify, publicly display, publicly perform, digitally perform, transmit, copy, sublicense to any [Agency Abbreviation] subcontractor for purposes of creating, implementing, maintaining or enhancing a Deliverable, and create derivative works based upon [Vendor Abbreviation] Property, in any media now known or hereafter known, to the extent the same are embodied in the Deliverables, or otherwise required to exploit the Deliverables. During the Term of this Agreement and immediately upon any expiration or termination thereof for any reason, [Vendor Abbreviation] will provide to [Agency Abbreviation] the most current copies of any [Vendor Abbreviation] Property to which [Agency Abbreviation] has rights pursuant to the foregoing, including any related documentation.

Notwithstanding anything contained herein to the contrary, and notwithstanding [Agency Abbreviation]’s use of [Vendor Abbreviation] Property under the license created herein, [Vendor Abbreviation] shall have all the rights and incidents of ownership with respect to [Vendor Abbreviation] Property, including the right to use such property for any purpose whatsoever and to grant licenses in the same to third parties. Vender shall not encumber or otherwise transfer any rights that would preclude a free and clear license grant to the Commonwealth.

1. **Commonwealth Property**

In conformance with the Commonwealth’s Standard Terms and Conditions, all Deliverables created under this Agreement whether made by [Vendor Abbreviation], subcontractor or both are the property of [Agency Abbreviation], except for the [Vendor Abbreviation] Property embodied in the Deliverable. [Vendor Abbreviation] irrevocably and unconditionally sells, transfers and assigns to [Agency Abbreviation] or its designee(s), the entire right, title, and interest in and to all intellectual property rights that it may now or hereafter possess in said Deliverables, except for the [Vendor Abbreviation] Property embodied in the Deliverables, and all derivative works thereof. This sale, transfer and assignment shall be effective immediately upon creation of each Deliverable and shall include all copyright, patent, trade secret, trademark and other intellectual property rights created by [Vendor Abbreviation] or [Vendor Abbreviation]’s subcontractor in connection with such work (hereinafter the "Commonwealth Property").

All copyrightable material contained within a Deliverable and created under this Agreement are works made for hire. [Vendor Abbreviation] bears the burden to prove that a work within a Deliverable was not created under this Agreement. If work is determined to not be made for hire or that designation is not sufficient to secure rights, to the fullest extent allowable and for the full term of protection otherwise accorded to [Vendor Abbreviation] under such law, [Vendor Abbreviation] shall and hereby irrevocably does, assign and transfer to [Agency Abbreviation] free from all liens and other encumbrances or restrictions, all right, title and interest [Vendor Abbreviation] may have or come to have in and to such Deliverable. [Vendor Abbreviation] HEREBY WAIVES IN FAVOR OF [AGENCY ABBREVIATION] (AND SHALL CAUSE ITS PERSONNEL TO WAIVE IN FAVOR OF CLIENT IN WRITING SIGNED BY SUCH PERSONNEL) ANY AND ALL ARTIST’S OR MORAL RIGHTS (INCLUDING, WITHOUT LIMITATION, ALL RIGHTS OF INTEGRITY AND ATTRIBUTION) IT MAY HAVE PURSUANT TO ANY STATE OR FEDERAL LAWS OF THE UNITED STATES IN RESPECT TO ANY DELIVERABLE AND ALL SIMILAR RIGHTS UNDER THE LAWS OF ALL OTHER APPLICABLE JURISDICTIONS.

[Vendor Abbreviation] agrees to execute all documents and take all actions that may be reasonably requested by [Agency Abbreviation] to evidence the transfer of ownership of or license to intellectual property rights described in this Section 11, including providing any code used exclusively to develop such Deliverables for [Agency Abbreviation] and the documentation for such code. [Vendor Abbreviation] acknowledges that there are currently and that there may be future rights that the Commonwealth may otherwise become entitled to with respect to Commonwealth Property that does not yet exist, as well as new uses, media, means and forms of exploitation, current or future technology yet to be developed, and that [Vendor Abbreviation] specifically intends the foregoing ownership or rights by the Commonwealth to include all such now known or unknown uses, media and forms of exploitation.

The Commonwealth retains all right, title and interest in and to all derivative works of Commonwealth Property.

[Agency Abbreviation] hereby grants to [Vendor Abbreviation] a nonexclusive, revocable license to use, copy, modify and prepare derivative works of Commonwealth Property only during the Term and only for the purpose of performing services and developing Deliverables for the [Agency Abbreviation] under this Agreement.

With respect to web site development contracts, [Agency Abbreviation] will bear sole responsibility for registering the software or system domain name or URL, applying for any trademark registration relating to the software or system domain name or URL and applying for any copyright registration related to its copyright ownership with respect to any Commonwealth Property.

1. **Third-party Intellectual Property**

If the Deliverables contain or will contain any third-party intellectual property to which [Vendor Abbreviation] intends to provide a sublicense, [Vendor Abbreviation] must provide copies of all such sublicense agreements as early in the process as possible. The sublicense agreements must be included in [Vendor Abbreviation]’s initial quotation to the [Agency Abbreviation], or, if the requirement to utilize sublicensed intellectual property is not known at the outset of the project, as soon as the requirement becomes known. Sublicenses to third-party intellectual property can ONLY be provided under RFR if they are provided at no charge to the Commonwealth.

**EXHIBIT A**

**Intellectual Property and Work Effort Agreement for Vendor’s Employees, Consultants, and Agents**

**Confidentiality, Assignment of Inventions and Representation of Non-Infringement Agreement; Other Representations**

The undersigned hereby acknowledges that he or she is an employee or consultant to of the following vendor of the Commonwealth of Massachusetts:

|  |  |
| --- | --- |
| Name of Vendor (“Vendor”): |  |

and desires to be assigned by the Vendor to perform services for the Commonwealth, and that the Vendor desires to assign you to perform services on one or more projects for the Commonwealth, but only under the condition that you sign this Agreement and agree to be bound by all of its terms and conditions.

NOW THEREFORE, in consideration of your assignment to work for the Commonwealth, the access you have to the confidential information of the Commonwealth, and for other good and valuable consideration, the parties agree as follows:

1. Confidentiality of the Commonwealth’s Materials. You agree that both during your assignment at the Commonwealth and thereafter you will not use for your own benefit, or divulge or disclose to anyone except to persons within the Commonwealth whose positions require them to know it, any information not already lawfully available to the public concerning the Commonwealth (“Confidential Information”), including but not limited to information regarding any website of the Commonwealth, any e-commerce products or services, any web development strategy, any financial information or any information regarding users of or vendors to the Commonwealth’s websites. Confidential Information also includes, without limitation, any technical data, design, pattern, formula, computer program, source code, object code, algorithm, subroutine, manual, product specification, or plan for a new, revised or existing product or web site; any business, marketing, financial or sales information; and the present or future plans of the Commonwealth with respect to the development of its web sites and web services.
2. All Developments the Property of the Commonwealth. All confidential, proprietary or other trade secret information and all other works of authorship, trademarks, trade names, discoveries, inventions, processes, methods and improvements, conceived, developed, or otherwise made by you, alone or with others, and in any way relating to the Commonwealth or any of its web development projects, whether or not patentable or subject to copyright protection and whether or not reduced to tangible form or reduced to practice during the period of your assignment with the Commonwealth (“Developments”) shall be the sole property of the Vendor’s customer, the Commonwealth. All copyrightable material contained within a Development during the period of your assignment with the Commonwealth are works made for hire. You bear the burden to prove that a work was not made during the period of your assignment with the Commonwealth. If a work is determined to not be made for hire or that designation is not sufficient to secure rights, to the fullest extent allowable and for the full term of protection otherwise accorded to you under such law, you shall and hereby irrevocably do, assign and transfer to the Commonwealth free from all liens and other encumbrances or restrictions, all right, title and interest you may have or come to have in and to such Development. YOU HEREBY WAIVE IN FAVOR OF THE COMMONWEALTH ANY AND ALL ARTIST’S OR MORAL RIGHTS (INCLUDING, WITHOUT LIMITATION, ALL RIGHTS OF INTEGRITY AND ATTRIBUTION) YOU MAY HAVE PURSUANT TO ANY STATE OR FEDERAL LAWS OF THE UNITED STATES IN RESPECT TO ANY DELIVERABLE AND ALL SIMILAR RIGHTS UNDER THE LAWS OF ALL OTHER APPLICABLE JURISDICTIONS. You agree to disclose all Developments promptly, fully and in writing to the Commonwealth promptly after development of the same, and at any time upon request. You agree to, and hereby do assign to the Commonwealth all your right, title and interest throughout the world in and to all Developments without any obligation on the part of the Commonwealth to pay royalties or any other consideration to you in respect of such Developments. You agree to assist the Vendor’s customer the Commonwealth, (without charge, but at no cost to you) to obtain and maintain for itself such rights.
3. Return of the Commonwealth’s Materials. At the time of the termination of your assignment with the Commonwealth, you agree to return to the Commonwealth all Commonwealth materials, documents and property, in your possession or control, including without limitation, all materials relating to work done while assigned by the Vendor to projects for Commonwealth or relating to the processes and materials of the Commonwealth. You also agree to return to the Commonwealth all materials concerning past, present and future or potential products and/or services of the Commonwealth. You also agree to return to the Commonwealth all materials provided by persons doing business with the Commonwealth and all teaching materials provided by the Commonwealth.
4. Representation of Non-Infringement. You hereby represent and warrant that, to your best knowledge, no software, no web content and no other intellectual property that you develop during your assignment to and deliver to the Commonwealth, and no Developments made by you and assigned to the Commonwealth pursuant to Section 2 above, shall infringe a patent, copyright, trade secret or other proprietary or intellectual property right of any third party.
5. No Conflicting Agreements. You represent and warrant that you are not a party to any agreement or arrangement which would constitute a conflict of interest with the obligations undertaken hereunder or would prevent you from carrying out your obligations hereunder.
6. Tax Payments. You hereby represent and warrant that you have paid all due state and federal taxes, or, if your tax status is in dispute or in the process of settlement, that you have responded as directed and within the required timeframes to all communications received from the state or federal government.
7. You acknowledge that you are not an employee of any Massachusetts state or municipal government agency, and are not entitled to any benefits, guarantees or other rights granted to state or municipal government agencies, including but not limited to group insurance, disability insurance, paid vacations, sick leave or other leave, retirements plans, health plans, or premium overtime pay. Should you be deemed to be entitled to receive any such benefits by operation of law or otherwise, you expressly waive any claim or entitlement to receiving such benefits from Massachusetts state or municipal government agencies.
8. Miscellaneous:
   1. The Commonwealth is a third party beneficiary of this Agreement with full rights to enforce its terms directly
   2. This Agreement contains the entire agreement between the parties with respect to the subject matter hereof, superseding any previous oral or written agreements.
   3. Your obligations under this Agreement shall survive the termination of your assignment with the Commonwealth regardless of the manner of or reasons for such termination. Your obligations under this Agreement shall be binding upon and shall inure to the benefits of the heirs, assigns, executors, administrators and representatives of the parties.
   4. You agree that the terms of this Agreement are reasonable and properly required for the adequate protection of our customer the Commonwealth’s legitimate business interests. You agree that in the event that any of the provisions of this Agreement are determined by a court of competent jurisdiction to be contrary to any applicable statute, law, rule, or policy or for any reason unenforceable as written, then such court may modify any of such provisions so as to permit enforcement thereof to the maximum extent permissible as thus modified. Further, you agree that any finding by a court of competent jurisdiction that any provision of this Agreement is contrary to any applicable statute, law, or policy or for any reason unenforceable as written shall have no effect upon any other provisions and all other provisions shall remain in full force and effect.
   5. You agree that any breach of this Agreement will cause immediate and irreparable harm to the Vendor’s customer the Commonwealth not compensable by monetary damages and that the Commonwealth will be entitled to obtain injunctive relief, in addition to all other relief, in any court of competent jurisdiction, to enforce the terms of this Agreement, without having to prove or show any actual damage to the Commonwealth.
   6. No failure to insist upon strict compliance with any of the terms, covenants, or conditions hereof, and no delay or omission in exercising any right under this Agreement, will operate as a waiver of such terms, covenants, conditions or rights. A waiver or consent given on any one occasion is effective only in that instance and will not be construed as a bar to or waiver of any right on any other occasion.
   7. This Agreement shall be governed by and construed in accordance with the laws of the Commonwealth of Massachusetts, without regard to the doctrine of conflicts of law. This Agreement is executed under seal.

The undersigned believes that this Agreement imposes reasonable standards of conduct for all of the employees, consultants, and agents of the vendor on assignment at the Commonwealth, and that this Agreement will serve to best protect the interests of all involved parties. If you agree with the terms set forth herein, please sign and return this Agreement.

**Agreed and Accepted:**

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| --- | --- |
| Name of Employee, Consultant, or Agent: |  |
| Signature: |  |
| Date: |  |
| Name of Vendor: |  |
| Vendor Signature: |  |
| Vendor Signatory Name: |  |
| Vendor Signatory Title: |  |
| Vendor Signature Date: |  |