Introduction

While Open Source Software ("OSS") is widely adopted in IT operations and research, at UC it nevertheless brings with it a range of considerations pertaining largely to copyright and patents. The inadvertent licensing of patent rights via a copyright license can lead to a violation of policy, and potential damages to a licensee of such patent rights. This is the fundamental issue that has led to the creation of three documents: (1) an easy to read chart indicating an assessment of key open source software licenses, (2) a brief companion to the chart, and (3) this guide to managing open source software at UC. While OSS may be appropriate in many cases, it is important that it be considered only in cases where the proposed license is in compliance with all relevant policies, and with explicit recognition, and mitigation, of any risks to the university's patent estate. Because intellectual property is implicated when using and distributing software pursuant to OSS licenses, it is crucial that each campus's local technology licensing professionals be part of the conversation to ensure that these risks have been appropriately contemplated and minimized.

This guide attempts to help both the delegated authority (typically the campus's intellectual property licensing office) and the software creator avoid misunderstandings when dealing with the issue of either future licensing of code, or with past licensing of code that perhaps did not involve the collaboration advocated in this set of guidelines. In fact, in the large majority of cases faculty, researchers, and staff, including technology transfer officers, should be reassured that the steps involved in using or releasing OSS will not present an undue burden on any party. Consulting the chart included in the OSS Chart Companion, should facilitate and expedite the OSS process across all UC campuses.

While the chart may make certain choices easy, the campuses have been empowered by the Regents of the University of California to decide locally about commercialization of copyright rights through the appropriate delegated authority at the campus. This means that the choice of open source license must be done in a way consistent with the processes established by each campus. Such processes may be diverse across the system, as they will likely reflect local staffing of technology transfer offices, local expertise in software development, and the values and culture specific to each campus. At the system level, it is expected that the campuses consider the risks associated with licensing, but also the benefit in creating review processes that encourage streamlined and efficient decision-making focused on finding solutions to the challenges faced by the creators of copyright-protected software, and which includes them as informed participants in the process.

The guide is broken into ten sections:

Review License Options

The OSS Chart Companion contains the details that should assist in reviewing license options. It includes a decision flowchart that is recommended as a way to reaching a sound decision about which open source license to use.

Contact Your Local Campus Delegated Authority (Tech Transfer / Copyright / Patent Office)

There may be times when a creator of software wants to consider the ramifications of an OSS license. Both campus licensing offices and creators should be mindful of efficient and effective use of administrative resources, especially for low risk agreements or low risk modifications (i.e., bug fixes and minor changes). There may be other times when a campus technology transfer office (or the equivalent office holding the appropriate delegation of authority) sees commercial potential (or inordinate risk) in software that is already released via open source. Regardless of the direction of the approach, it is important that the creator of the software and the university's delegated authority for licensing have a meaningful conversation about access and are aligned on the future for a particular piece of code.

Every OSS license listed in the Chart is a commercial license. The authority to grant a commercial license follows a particular line of delegation from the Regents of the University of California to whoever has the authority to sign a license to such rights. This final line of authority is usually found in the campus technology licensing office. An important reason the university is structured this way is that enabling commercial activity means being exposed to commercial-scale liabilities, which is a complex matter to manage, especially within the context of a non-profit university. The university's mission is to teach, to perform research, and to perform public service (http://ucop.edu/uc-mission/index.html). The university does not manage its day-to-day business in anticipation of dealing with commercial-scale liabilities, and when it does, it does so with the sensibilities of a public university with a limited, focused budget. This is at the heart of why OSS licensing needs to be done in a collaborative, transparent manner, with all the impacted departments being a participant in the decision-making process.

First Steps

When a campus licensing office and a creator of software have a discussion about new computer software code, the framework of that discussion should allow for alignment of interests as the final result. Both parties have values they want to preserve, and - due to the university’s long history of producing and licensing software - there are well-trodden paths to solutions that preserve both sets of values. Both parties should be open to reconsidering the relative strengths of those values in light of new information, or new perspectives, in order to avoid unnecessary deadlocking over an issue of perhaps minor importance. When a creator prepares to sit down to discuss OSS licensing of a particular piece of code with a campus licensing official, they should consider the following points

- Do all of the authors agree with the choice of license?
- Is there more than one license that would satisfy the creator's needs?
- Will the creation of new code require external sponsorship? If so, from where?
- Could the software serve as a basis for a new business? And if so, would OSS licensing still be in the best interest of that type of initial commercial path?

- Is there anticipated future personal financial gain from this OSS release?
- Could the project be easily "dual licensed," allowing for multiple types of licensing - OSS, or closed source?
- Have you consulted the OSS Chart published by the University of California?

When a representative of the licensing office prepares to sit down with a creator of computer software code, they should consider the following points

- How likely is there to be a meaningful royalty-bearing license to this type of technology?
- What campus role does the software creator hold? Unlike faculty, work for hire staff do not hold copyright to the software code they develop as UC employees. (See http://copyright.universityofcalifornia.edu/ownership/works-created-at-uc.html)
- If an OSS license does not seem favorable, or perhaps is even impossible, is there still a way for the creator's project to move forward?
- Do any of the discussed OSS licenses grant an express patent rights license?

Points to Consider

Points to consider when deciding whether to use an OSS License.

When starting a software project, the choice of license is sometimes not given a high priority. But the software's availability, especially for software developed at a university, is important. The terms of that availability may become critical to the project's long-term success. Universities are more frequently being asked to justify their decisions based on potential economic impact, and - especially in the case of public universities - local economic development and community engagement. When you choose a license, the creator and the delegated authority might together want to consider the following points, especially if the license amounts to a free commercial license.

- What will be the impact to the local region when the software becomes available? Will it be a jobs creation engine?
- Could the software be the basis for a startup?
- Is the project receiving the OSS contribution allowing for better engagement with your local community? How so? If not, why not?
- Do all impacted parties know about your choice?
- Do all of the authors agree with the choice?
- Has the creators' supervisors, funders or advisors been informed about the choice? What did they think?
- Could the software be made available under multiple licenses?
- Have you consulted the “Open Source Software at UC” Chart?

Points to consider when deciding which OSS License to use.

Different OSS licenses offer differing amounts of protection to the creator of the software, the creator's employer, or the downstream user or modifier. Often the University of California has recommended the first OSS license that should be considered is the BSD license. This license protects the institution and authors appropriately, and keeps the license language simple and direct. But many other licenses exist and have their own advantages and disadvantages. Some points to consider when choosing a license are

- Does the license provide enough protection to the University and the authors?
- Does the license accomplish everything you want, and only what you want? Does the license have clauses that you view as extraneous?
- Does the license have unintended consequences for other employees of the University of California?
- Do all of the initial authors/contributors agree on the license?
- Will the chosen license facilitate third-party contributions or use?
- If the project already has a license attached, will working on the project under the terms of the license be beneficial or detrimental over the long term (because of the license choice)? How willing and able is the project to consider contributions under other licenses?
- Do the funders of the work on the software support your choice of software license?
- Have you consulted the OSS Chart published by the University of California?
- Is everyone who might be impacted by the choice of license, including the licensing office, your supervisor or department, and other authors, in alignment on the choice?
- OSS code is generally hosted on repository platforms like GitHub and Bitbucket, whose terms of use may conflict with university policies. This is an ancillary risk to be aware of, no matter the open source license under consideration.

Examples of Success and Inadvertent Risk

Successful OSS Licensing approaches.

A. Recently, the process developed for UC San Diego to participate in the Hydra and Fedora projects has won praise beyond UC from other university researchers, as they used the campus process as a model palatable to their own university's authorized officials. The process was formulated by UC General Counsel Angus MacDonald and Kat Fibiger of UCLA, and allows for assignment of UC's rights in the interest of the research project to allow for use of the OSS license preferred by the projects, which would have otherwise encumbered the UC patent estate. UC San Diego's participation in this program enabled them to focus more of their developer time to progress on undeveloped or local issues that are particularly unique to UC San Diego and to support an increasing range of services that the University needs from the library, and to contribute back to these OSS projects.
B. UC Davis recently developed a distribution of the Drupal content management system (CMS) which is now the standard web site tool on that campus. This product they built, SiteFarm, has been successful in applying consistent branding, security, accessibility, and usability of websites at UC Davis. Through a collaboration with UCLA and UCSF, SiteFarm is now being adopted by several other UC campuses. SiteFarm was released as Open Source under the same license as the Drupal project, GPLv2, and now universities across the country are evaluating it for their own use.

Inadvertent risk taking through OSS Licensing.

This example is anonymized as it is the subject of an ongoing discussion between a campus and its licensee. Recently a campus was notified by a long-time patent licensee that software had been released by the campus via an OSS license listed as red in the OSS Chart. The licensee perceived that the

released software infringed on the patent that had been exclusively licensed to them for commercial rights. The release was done unilaterally by the researchers nearly a decade ago, without any substantive risk assessment (and without the benefit of this document). This unilateral decision has had negative consequences for the university and its relationship with its patent licensee.

Policy References

Key policy and guidance documents for licensing software

- UC Patent Policy (1997) - http://policy.ucop.edu/doc/2500493
- UC Copyright Ownership Policy (1992) - http://policy.ucop.edu/doc/2100003
- Conflict of Interest Policy (NSF) - http://policy.ucop.edu/doc/2500633
- University Licensing Guidelines - http://researchmemos.ucop.edu/index.php/site/memoDetail/memo_id/RPAC-12-02
- University of California Contracts and Grants Manual - Chapter 11 Intellectual Property - http://www.ucop.edu/research-policy-analysis-coordination/resources-tools/contract-and-grant-manual/chapter11/index.html
- UC Memorandum: Guidance for Faculty and Other Academic Employees on Issues Related to Intellectual Property and Consulting - http://www.ucop.edu/research-policy-analysis-coordination/_files/Consulting-Industry-White-Paper-2003.pdf
- UC website on Copyright and Fair Use - http://copyright.universityofcalifornia.edu
- President Atkinson's Letter on Computer Code Distribution - http://researchmemos.ucop.edu/index.php/site/memoDetail/memo_id/OTT-02-02
- Copyright Law of the United States of America and Related Laws Contained in Title 17 of the United States Code - http://www.copyright.gov/title17/

Campus Licensing Offices

- UCB Intellectual Property & Industry Research Alliances
- UCD InnovationAccess
- UCI Invention Transfer Group
- UCLA Technology Development Group
- UCM Office of Business Development
- UCR Office of Technology Commercialization
- UCSB Technology & Industry Alliances
- UCSC Office for Management of Intellectual Property
- UCSD Office of Innovation and Commercialization
- UCSF Innovation, Technology & Alliances
- LBNL Innovation and Partnerships Office

Source: http://www.ucop.edu/research-innovation-entrepreneurship/technology-commercialization.html

Example Campus Copyright Guidelines

- San Diego campus: http://adminrecords.ucsd.edu/ppm/docs/500-5.html
- Irvine Campus: http://www.oit.uci.edu/policy/copyright/, https://uci.edu/copyright/, http://www.ota.uci.edu/faculty-resources/intellectual-property-at-uci.html
- Los Angeles campus: http://tdg.ucla.edu/copyright-trademarks
- Davis campus: http://research.ucdavis.edu/industry/ia/researchers/copyright/distributing-work/

Frequently Asked Questions (FAQ)

What is the best license to use?

There is no easy answer to this question. Before deciding which license to use, when local campus process requires, the delegated authority must first conclude whether releasing the software via an OSS license can and should be done. If it is concluded that open source licensing can be accommodated, then the decision as to which OSS license is most appropriate resides with the local UC campus, which may ultimately fall to the campus's delegated authority, in communication with all authors. Generally, licenses with lower associated risks (identified in green) are more ideal than those wherein the risk is higher (e.g., identified in yellow or red).

Can I release the software under 2 different licenses?

There may be certain circumstances, assuming all of the software authors and the delegated authority (when required) are in agreement, where the software may be released initially under multiple licenses. This is often referred to as "dual licensing." Your delegated authority may be able to provide some guidance as to whether this is possible for your software.

Can I restrict use by commercial entities under any open source license?

If you desire to restrict use of your software by commercial entities, OSS licensing should not be used. There are mechanisms that can be used to release software to the academic community without enabling commercial entities to exploit the software. Please speak with your delegated authority for additional assistance.

If this is my scholarly work, can I release it under any license I want? How do I determine if it is my scholarly work or if it belongs to The Regents?

Ownership of copyright protected works at UC is determined by the UC Copyright Ownership policy (http://copyright.universityofcalifornia.edu/ownership/works-created-at-uc.html). Please consult with your campus's delegated authority with any questions.

Where do I put the license in my software?

In a prominent place. Often there is a "license.txt" file in the distribution package containing the license. There may be a User's Guide that contains the license. Some even put the license in every source code file.

Where can I find the licenses to review the terms?

Various websites contain specific licenses. A good compendium can be found at opensource.org.

Who controls open source licenses and the various versions?

Various groups maintain open source licenses. A good source to find the originator or maintainer of a license is at the list of licenses at opensource.org.

What if the funding I used to create the software does not allow for OSS licensing?

Contact your delegated authority to determine whether there is another route in which your software can be shared with others.

I am reviewing the funding for a contract or grant and the funder requires a restricted license as part of the agreement. What should I do? Can we accept these terms? What should I consider?

Generally speaking, if software is identified as a deliverable under a funding agreement entered into by The Regents, then it is very likely the software will belong to The Regents under pursuant to its copyright policy. Therefore, the decision as to whether such terms can be accepted resides with your delegated authority.

What if I just want to share my code with a few people and get feedback? Do I have to get a license?
Speak with your delegated authority – it is very likely such sharing can be accommodated with a relatively streamlined agreement.

What do I do if I have already released some code and I want to change the license?
Consult with your local delegated authority on how to do this without violating the terms of the original license. It may require consulting with all of the contributors of the code under the original license.

What do I do if someone has violated the open source license I used for software I have released?
If the software is owned by the Regents of the University of California, consult with your local delegated authority.

How do I know whether there is open source code in the software I want to license commercially?
This can be a challenging endeavor. While various methods may be used, including visual inspection to search for license text, or automated scanning software that has been developed to search large software projects for code controlled by an open source license, such methods may not be perfect.

Can my software be released via an OSS license if The Regents have granted an exclusive license to a patent that covers such software?
While an exclusive license to software could hypothetically coexist with releasing a version of such software via an OSS license, this is a complicated question and will require careful review and analysis by your delegated authority.