



OPC 20999-x5

OPC UA For [Project Name]

Draft 1.00

YYYY-MM-DD

MULTI-ORGANIZATION COOPERATION AGREEMENT:

OPC UA FOR [Project name]

This Cooperation Agreement (“Agreement”) is by and between the parties that have executed substantially identical copies of this Agreement. The Agreement is effective as to each party on the date the party agrees to these terms.

- 1. Background.** Several non-profit trade associations, standard-setting organizations, and similar technology consortia share an interest in developing specifications that facilitate industrial automation. This Agreement creates a framework for cooperation among these organizations. The constituent members of these organizations, typically for-profit corporate entities, are not direct parties to this Agreement, but the Agreement requires the parties to inform their members about certain elements of the Agreement. The purpose of the Agreement is to create a governance model and intellectual property framework that enables different non-profit organizations, and members of these different organizations, to work together to create industry specifications and related materials.
- 2. Project scope and governance.** The project scope and governance/decision-making processes are described in the initial joint working group charter, attached to this Agreement as Exhibit A. The parties may update the charter, following the decision-making processes described in the charter, in which case the updated charter will be automatically incorporated into and governed by this Agreement. In the event of a conflict between this Agreement and a term in the charter, this Agreement will control.
- 3. Intellectual property.**
 - a. OPCF IPR terms.** The OPC Foundation Intellectual Property Policy version 2.2, found at <https://opcfoundation.org/ipr/> and attached as Exhibit B, will apply to the activities and deliverables of the joint working group. For clarity: version 2.2, and not future amended versions, applies. If the joint working group charter includes confidentiality terms, those terms will control over any conflicting provisions of the OPCF IPR terms.
 - b. Copyright license to project deliverables.** The joint working will create certain final deliverables, approved via the project governance process (the “Deliverables”). In addition to all rights granted under the OPCF IPR Policy, each party to this Agreement is granted a worldwide, irrevocable, non-exclusive, royalty-free, fully-sublicensable license to reproduce, distribute, display, perform, and create derivative works of the Deliverables.
 - c. Attribution; limited trademark licenses.** For purposes of attribution, the name and logo of each party to this Agreement will be included in each Deliverable, except as otherwise agreed by any excluded party. Each party grants a limited, revocable trademark license permitting its marks to be used solely for this purpose. In the event that a party creates a derivative work of a Deliverable per Section 3(b), it must remove all third party marks from its derivative work, unless separately granted permission by the mark owner, and must clearly distinguish its derivative work from the original Deliverable.
 - d. Obligation to inform members of IPR terms.** Each party acknowledges that the other parties cannot obligate their members to agree to particular intellectual property terms. However, each party must use

reasonable efforts to notify its members that the joint working group is governed by the OPCF IPR Policy, as described in Section 3(a). All participants will be asked to acknowledge that these terms apply.

- e. **No patent licenses for derivative works.** The OPCF IPR Policy includes an obligation to license all implementers (including non-members of OPCF) to certain patent claims that are essential for specification implementation, on a royalty free basis. For the avoidance of doubt: this obligation will apply to final specifications of the joint working group approved in accordance with the OPCF IPR Policy but will not apply to any derivative works of specifications created pursuant to Section 3(b). Parties are free to obtain additional patent license commitments from or among their own members in their own discretion.
 - f. **Obligation to notify parties of known patent licensing gaps.** If an individual representative of a party reasonably believes, based on objective facts personally known to that individual, that (a) a patent claim exists that would likely be essential for an implementation of specification planned or produced by the joint working group, and (b) the owner of that patent claim has not manifest agreement to the OPCF IPR Policy, then that party must communicate this belief to the chairperson of the joint working group. The chair will consult with legal counsel and take appropriate action, including notifying other parties of the communication, as directed by counsel. No party has any obligation to perform patent searches or otherwise affirmatively investigate potentially applicable patent claims.
4. **Compliance testing.** Each party is free to independently implement a compliance testing process in connection with any Deliverable. No party may use another party's trademarks in connection with such a process. Each party is encouraged (but not required) to discuss opportunities to coordinate compliance testing efforts in the joint working group.
 5. **Coordination of public communications.** Each party agrees to use reasonable efforts to inform the other parties of any plans to independently publish the Deliverables or any derivative works of the Deliverables. Each party is encouraged (but not required) to coordinate public messaging about the activities addressed in this Agreement in the joint working group. Use of any party's name, logo or other marks in public messaging requires the consent of that party.
 6. **Termination.** The Agreement will continue until terminated by all parties. A party may terminate, as applied to itself, at any time by so notifying the other parties. License rights that accrued prior to termination will survive, but no new rights will vest post-termination. If all, or all but one, of the parties terminate the Agreement, the then-current draft version of the project deliverables will be deemed "Deliverables" subject to the license described in Section 3(b).
 7. **Limited liability; dispute resolution.** No party will be liable to any other party for monetary damages under this Agreement. All materials are provided "AS IS," without warranty or representation of any kind. If unable to resolve a dispute amicably, the parties agree that disputes arising out of or in connection with this Agreement will be finally settled under the Rules of Arbitration of the International Chamber of Commerce, Paris (ICC) by three arbitrators nominated in accordance with ICC rules. This Agreement will be governed and construed in accordance with the substantive law applicable in New York, USA without reference to any other law.

[Signature page follows]

Agreed:

Signature

Printed Name

Title

Organization Name

Date

Signature

Printed Name

Title

Organization Name

Date

Signature

Printed Name

Title

Organization Name

Date

Signature

Printed Name

Title

Organization Name

Date

Note: The Administrative Director of OPC Foundation will provide each executing party with a copy of the Agreement executed by each other party.

EXHIBIT A: JOINT WORKING GROUP CHARTER

OPC UA XXXX Working Group Charter

Here we will integrate the charter agreed between the proposing organization and the OPC Foundation control boards.

OPC FOUNDATION

INTELLECTUAL PROPERTY RIGHTS POLICY

VERSION 2.2 – 25-MAY-2020

This OPC Foundation Intellectual Property Rights (IPR) Policy governs the treatment of intellectual property in the production of deliverables by OPC Foundation (“OPCF”). This Policy applies to all members of OPCF, and to non-members of OPCF that participate in OPCF activities.

1. Copyright license to Contributions.

- a. *Contributors and Contributions.* OPCF coordinates the development of various deliverables, such as technical specifications, software code, marketing collateral, and other related material. Any work of authorship intentionally provided to OPCF for potential inclusion in a draft or final OPCF deliverable is a “Contribution.” The entity or individual making the Contribution is the “Contributor.”
- b. *Copyright license to Contributions.* Each Contributor grants OPCF a worldwide, irrevocable, non-exclusive, royalty-free, fully-sublicensable license to reproduce, distribute, display, perform, and create derivative works of the Contributions.
- c. *OPCF copyrights.* Subject to the Contributor’s continued copyright ownership in their Contributions, OPCF will own the copyright in any collective works, compilations, joint works or derivative works created in connection with OPCF activities, and will own the copyright in any works created by OPCF employees or agents.
- d. *Attribution; moral rights.* Each Contributor, and each individual making a Contribution, waives any moral rights (or similar rights) to the maximum extent permitted by applicable law. OPCF deliverables will be attributed to OPCF.

2. Patent license obligations for Specifications.

- a. *Specifications.* OPCF produces technical specifications that define requirements and related information and data models necessary to facilitate interoperability between third party products or services. Once approved as final via a process defined by the OPCF Board of Directors, these are “Specifications.” Every member of OPCF is obligated to license certain patent claims in connection with Specifications, as described in this Section 2.
- b. *License obligation.* Each member of OPCF agrees that if a patent claim that is owned, controlled or licensable (without additional consideration other than to employees or

EXHIBIT B: IPR POLICY

Affiliates) by that member or an Affiliate of the member becomes a Necessary Claim, then the member will grant, or will cause its Affiliate to grant, a RAND-Z License to any implementer (member or non-member) of the relevant Specification who requests such a license, subject to the definitions and exceptions described below.

- i. An “Affiliate” is any entity that, directly or indirectly, owns, is owned by, or is under common ownership with, the member, as indicated by ownership of more than 50% of the stock or other equity interests entitled to vote for the election of directors or an equivalent governing body of the relevant entity, subject to the exception below.
 1. “Affiliate” will not include an entity that meets all of the following criteria: (a) it has securities issued under applicable law that are traded on a public securities exchange, (b) it is not wholly owned, directly or indirectly, by the member (even if the member owns more than 50% of such securities), (c) it operates fully independently from the member, and (d) it derives the majority of its revenue from activities other than intellectual property licensing. Entities that meet these exception criteria will be called “Excluded Affiliates.” Excluded Affiliates will be treated as non-members of OPCF (including by the related member) unless and until they join separately as members. Members must promptly notify OPCF of the existence of any entity that qualifies as an Excluded Affiliate, and OPCF will maintain a list of such entities that OPCF will make available to OPCF members. Absent such notice, the entity will be an Affiliate but not an Excluded Affiliate.
- ii. A “Necessary Claim” is any claim in a patent in any jurisdiction that would necessarily be infringed by a compliant implementation of the relevant Specification. A claim is necessarily infringed only when it is impossible to avoid infringing it, because there is no commercially reasonable non-infringing alternative for implementing the normative portions of the Specification. All other claims, even if contained in the same patent as Necessary Claims, are not Necessary Claims unless they qualify individually as Necessary Claims. Claims which would be infringed only by portions of an implementation that are not expressly specified in the normative portions of the Specification are not Necessary Claims.
- iii. A “RAND-Z License” is a worldwide, non-exclusive license, limited to Necessary Claims, to make, have made, use, import, offer to sell, lease, sell, promote and otherwise distribute the portions of the implementer’s products and services that comply with the normative portions of the Specification, granted on royalty-free and otherwise reasonable and non-discriminatory terms.

EXHIBIT B: IPR POLICY

- c. *Reciprocity; defensive suspension.* A non-member implementer of an OPCF Specification is eligible to be the beneficiary of the license obligation described in Section 2(b) only if the implementer commits to substantially the same license obligation. Accordingly, no member shall be obligated to license any non-member if that party does not agree to make patent licenses available for all OPCF Specifications as set forth in Section 2(b). Further, except as otherwise expressly agreed between parties, a licensor may suspend any license granted to a particular licensee pursuant to this Policy for an implementation of an OPCF Specification if that licensee or its Affiliate initiates litigation against the licensor or any other party that alleges infringement of a Necessary Claim in connection with that same OPCF Specification. A party will not be deemed to have initiated litigation if that party files a suit which is defensive based on a patent infringement claim or suit by another party.
- d. *Opt out; review period.* In connection with Specifications developed after the date of this Policy, the license obligation described in Section 2(b) and 2(c) will not apply to patent claims that a member opts out. The Board will provide notice and a substantially complete draft version of each Specification to all members for review no less than 90 days prior to formal approval of the Specification. A member may opt out a claim by specifically identifying a particular claim and the applicable portion of the relevant draft specification in writing to the Board prior to the end of the review period. The member must make such opt-out notification promptly upon becoming aware that the claim potentially may be a Necessary Claim and deciding that they are unwilling to license it, even if such awareness arises prior to the review period. Members acknowledge that opt-outs made late in the specification development process are highly disruptive to the process and potentially costly to OPCF and other OPCF members; accordingly, members agree to use the opt-out option only in good faith. Members may not opt out claims that read directly on Contributions made by the member or that are otherwise included in a draft specification as a direct result of the intentional input of that member. For the avoidance of doubt: the opt-out mechanism described in this Section 2(d) is not available for OPCF Specifications approved before the date of this Policy, nor is it available for any new member of OPCF for Specifications approved prior to the date the new member joins OPCF. In the event that a member makes an opt-out notification to the Board, prior to finalizing the relevant draft specification the Board will appoint a committee to evaluate the notification and make a recommendation to the Board, and the Board will decide on appropriate next steps. If the Board approves a Specification after receipt of an applicable opt-out notification, OPCF will include a statement of this fact in the affected Specification.
- e. *Effect of withdrawal from OPCF.* Even after the date a member formally withdraws from OPCF (the "Withdrawal Date"), the former member will be obligated to grant licenses as described in this Section 2 to (a) those claims that became Necessary Claims prior to the Withdrawal Date, (b) claims directly embodied in a Contribution made by the former member that become Necessary Claims if and when a

EXHIBIT B: IPR POLICY

Specification that includes the Contribution is approved after the Withdrawal Date, (c) Necessary Claims that read on future versions of a Specification, limited to those portions of the future version that are substantially the same as in the Specification as it was approved prior to the Withdrawal Date, and (d) Necessary Claims in any patent filed by the former member after the Withdrawal Date if such claims have a priority date that is during the period when the former member was a member. Otherwise, no new obligations attach post Withdrawal Date. For the avoidance of doubt: a party will have no obligation to license claims that it has opted-out under Section 2(d), either prior to or after withdrawal.

- f. *License obligations are binding on successors and assignees.* The obligation to license Necessary Claims in accordance with this Policy is an encumbrance that is binding upon any and all assignees and transferees of any Necessary Claims. Members agree to (a) notify its assignee or transferee of such obligation; and (b) require its assignee or transferee to agree to similarly provide such notice to its assignees or transferees of this obligation. Further, a member should take other reasonable actions, as and if appropriate for the members' legal jurisdiction, to ensure that direct and subsequent assignees and transferees are bound by the license obligations imposed by this Policy. The obligation to license will be binding on all successors-in-interest irrespective of whether notice or other action has occurred, however.
 - g. *Application to non-members.* The obligations and rights described as applicable to members in this Section 2 will apply to non-member Participants in any OPCF Specification-development effort, subject to the limitations described in this Section 2(g). A non-member "Participant" is the legal entity that employs or is otherwise the principal of an individual who participates (e.g. by joining a group mailing list, accessing group online forums, or attending group meetings) in a working group that is developing a deliverable that is intended to become a Specification, or, if no such entity exists, is the participating individual. The obligation to license described in Section 2(b) will apply to Participant and its Affiliates only in connection with any Specification developed by a working group in which a Participant participates. OPCF will make reasonable efforts to notify Participants of the applicable review period, and a Participant may exercise the opt-out rights described in Section 2(d).
- 3. Software.** The Board may adopt a Software Policy. The Software Policy may require that a member license software code Contributions made by that member in accordance with the terms of applicable software licenses identified in the Software Policy.
- 4. Trademarks.** OPCF will be permitted to use the name and corporate logo (or similar mark) of members on the OPCF website and solely in connection with communications about OPCF membership, subject to reasonable use limitations communicated by the member to OPCF. OPCF members may use the OPCF name and membership logo solely to communicate their membership in OPCF, subject to a reasonable trademark use policy to be published by the Board. The OPCF name and trademarks may not be used to communicate

EXHIBIT B: IPR POLICY

compliance or conformance with any OPCF specifications or technology, and may not otherwise be used in connection with any member product or service, except as permitted by an applicable written OPCF license agreement or Board-approved policy which license shall be equally available to all OPCF members. A party granting a trademark license under this Section 4 will be entitled to terminate such license if it reasonably believes that the licensee is misusing the licensor's mark.

- 5. Confidentiality.** Except as otherwise approved in writing by the Board, all non-public draft OPCF deliverables will be deemed the confidential information of OPCF. Members and non-member Participants (as defined in Section 2(g)) may discuss this information among OPCF members and non-member Participants (limited, in the case of non-member Participants, to information directly related to the working group in which they are participating), but will otherwise maintain this information in confidence with at least a reasonable degree of care. Information disclosed in connection with OPCF activities is otherwise non-confidential, except as otherwise expressly agreed by information recipients. The Board will establish processes to determine the timing and nature of any public release of deliverables. Materials released publicly are non-confidential.
- 6. Scope; amendments; authority.**

 - a. *Applies to past and future OPCF activities.* This IPR Policy supersedes and replaces all previous OPCF intellectual property policies, and any previous agreements or understandings between OPCF and any member regarding intellectual property rights related to OPCF Specifications. The obligations of a licensor under this Policy apply to the entire period of their membership, both before and after the effective date of this Policy. A party defending an IP infringement claim, however, does not by agreeing to this Policy waive the right to rely on the terms of the prior policy to the extent activities occurring before the effective date of this Policy are relevant to its defense.
 - b. *Assent to terms.* Participation in OPCF as a member or non-member Participant indicates assent to the terms of the Policy. Any party that desires to not be bound by the terms of this IPR Policy must abstain from joining or participating, or must withdraw from membership if already a member as of the date of this policy, and must not engage in OPC Foundation activities.
 - c. *Amendments.* The OPCF Board of Directors may amend this Policy at any time in its sole discretion. No amendment to this Policy will be effective in less than 90 calendar days from the date that written notice of such amendment is sent to members.
 - d. *Authority.* Individuals acting within the scope of their employment or otherwise as an agent of a legal entity act on behalf of their employer or other legal entity. The individual represents that they have the right and authority to bind their employer or other principal to these terms. The bound entity represents and warrants that it has the right to grant the licenses described in these terms.