openASSA Project

# **Working Party 3 – Legal**

# Discussion document: Open-source Contributor License Agreements

## Introduction

The intellectual property (IP) discussion document identified several key IP risks for the openASSA project. The discussion document also identified Contributor License Agreements (‘CLAs’) as a possible way of reducing the risk for openASSA and helping prevent the project from landing in hot water due to the community contributions it accepts. Specifically, CLAs make ownership of (and liability for) the project’s intellectual property explicit.

Although CLA’s are usually aimed at individuals, it may make sense also to have Corporate CLAs where individuals contribute on behalf of their employers.

In general, whenever someone makes a contribution to an opensource project, they license their contribution under the same terms as the project’s license, and they agree that they have the right to license their contribution under those terms. This is the widely accepted norm in the opensource community, and is referred to by the shorthand “inbound=outbound”. If the project has a separate agreement to license contributions under different terms, such as a CLA, that agreement will supersede.

Standard CLAs are readily available, with the choice driven by the level of protection needed and the conditions of the license under which the project distributes software.

## Desired outcomes of CLA implementation

Given the risks identified in the intellectual property discussion document, this Section describes the desired outcomes of implementing CLAs for the openASSA project.

### Awareness of license requirements

As a minimum, the CLA should alert contributors to how the project’s software is being licensed, and require them to acknowledge that their contributions are done under the terms.

### Explicit permission to use the IP contributed by volunteers

One of the key risks the CLA aims to mitigate is the risk that a volunteer, at some point after contributing, tries to put in an IP claim on their contributions to the project. In order to mitigate this risk, the CLA should require volunteers to agree that they will (and are able to) grant a copyright license on the contribution to the project. Wording commonly found in contributor agreements asks the contributor to grant a perpetual, worldwide, non-exclusive, no-charge, royalty-free, irrevocable copyright license to reproduce, prepare derivative works of, publicly perform, publicly display, sublicense, and distribute the contributions and such derivative works.

### Explicit permission to use the IP contributed by employees of companies

Similar to Section 2.2 above, another key risk the CLA should address is the risk that a volunteer’s employer puts in an IP claim on the volunteer’s contributions. As mentioned in the IP discussion document, it is recommended that openASSA implements CLAs for all individual contributors. Furthermore, it is recommended that openASSA seeks to implement corporate CLAs for the employers of volunteers who make significant contributions to the openASSA project.

The individual CLA should contain a clause stating that where the contributor’s employer has rights to the IP they create, they have received permission to make contributions on behalf of that employer, and that either the employer has waived rights for their contributions, or that the employer has executed a separate corporate CLA.

The corporate CLA should ask the employer to agree that:

* The employee has notified the employer of involvement in the project, and that the employer has granted permission (and is comfortable with the employee sharing some IP).
* The IP contributed to the project does not belong to the employer.
* The employee is not getting paid for the work.
* The IP will be licensed or assigned to the project and the licence or assignment is only for purposes of this project.

### Protection from the legal liability arising from other types of IP claims

In addition to the risk of volunteers and their employers putting in IP claims on contributions to openASSA, the CLA should also provide protection against IP claims from other third parties. To achieve this, the CLA should place the legal liability and consequences of contributing inappropriate IP on the individual contributors. The CLA should require the contributor to agree that the content they are providing is their original content, is contributed in good faith, and that they will (and are able to) grant a copyright license on the contribution to the project.

In certain open-source circles, there is a concern that shifting this legal liability on to contributors places an unfair burden on them. This potential legal liability could also deter people from becoming contributors to the project. It is of key importance that the contributor warrants that the Contribution is their original work and that they are able to grant the licence. This is within the Contributor's knowledge and so is not unreasonable to expect this warranty. Also it is virtually impossible for ASSA to verify this. In certain cases these issues can be alleviated through having a separate corporate CLA in place with volunteers’ employers.

### Patent grants

If the project uses an open source license that does not include an express patent grant (such as MIT), the CLA should be used to overcome this.

### Raising Awareness of IP considerations

Requiring contributors to sign a CLA which explicitly deals with IP and contributions should raise awareness of the IP considerations and potentially avoid IP violations.

### Remuneration of contributors

The CLA should explicitly state that contributors will not be remunerated for any contributions that they make to the project.

### Awareness and acceptance of the contributor code of conduct

If a contributor code of conduct is in place (e.g. <https://www.contributor-covenant.org/version/2/0/code_of_conduct/>) the CLA should create awareness and obtain confirmation of compliance with the project’s Contributor Code of Conduct.

## Standard CLAs

With the desired outcomes from Section 2 in mind, this Section introduces a few standard CLAs which openASSA could use.

### Harmony agreements

<http://www.harmonyagreements.org/>

Project Harmony is a community-centred group focused on contributor agreements for free and open source software. Their website allows a project either to use one of their templates or to create a custom CLA (both individual and company).

### Apache

<https://www.apache.org/licenses/contributor-agreements.html>

“The ASF desires that all contributors of ideas, code, or documentation to any Apache projects complete, sign, and submit via email an [Individual Contributor License Agreement](https://www.apache.org/licenses/icla.pdf) (ICLA).

The purpose of this agreement is to clearly define the terms under which intellectual property has been contributed to the ASF and thereby allow us to defend the project should there be a legal dispute regarding the software at some future time. A signed ICLA is required to be on file before an individual is given commit rights to any ASF project.

For a corporation that has assigned employees to work on an Apache project, a [Corporate CLA](https://www.apache.org/licenses/cla-corporate.pdf) (CCLA) is available for contributing intellectual property via the corporation, that may have been assigned as part of an employment agreement.

Note that a Corporate CLA does not remove the need for every developer to sign their own ICLA as an individual, which covers both contributions which are owned and those that are not owned by the corporation signing the CCLA.

The CCLA legally binds the corporation, so it must be signed by a person with authority to enter into legal contracts on behalf of the corporation.”

### Software Freedom Conservancy

The Software Freedom Conservancy provides a very simple CLA in a form that can modified for your particular project. If basically only alerts contributors of the license under which the project is being run:

<https://docs.google.com/forms/d/e/1FAIpQLSd2FsN12NzjCs450ZmJzkJNulmRC8r8l8NYwVW5KWNX7XDiUw/viewform?hl=en_US&formkey=dFFjXzBzM1VwekFlOWFWMjFFRjJMRFE6MQ#gid=0>

### Developer Certificate of Origin

<https://developercertificate.org/>

This is a simple CLA that the individual has the right to submit their contribution to the project.

Developer Certificate of Origin

Version 1.1

Copyright (C) 2004, 2006 The Linux Foundation and its contributors.

1 Letterman Drive

Suite D4700

San Francisco, CA, 94129

Everyone is permitted to copy and distribute verbatim copies of this

license document, but changing it is not allowed.

Developer's Certificate of Origin 1.1

By making a contribution to this project, I certify that:

(a) The contribution was created in whole or in part by me and I

have the right to submit it under the open source license

indicated in the file; or

(b) The contribution is based upon previous work that, to the best

of my knowledge, is covered under an appropriate open source

license and I have the right under that license to submit that

work with modifications, whether created in whole or in part

by me, under the same open source license (unless I am

permitted to submit under a different license), as indicated

in the file; or

(c) The contribution was provided directly to me by some other

person who certified (a), (b) or (c) and I have not modified

it.

(d) I understand and agree that this project and the contribution

are public and that a record of the contribution (including all

personal information I submit with it, including my sign-off) is

maintained indefinitely and may be redistributed consistent with

this project or the open source license(s) involved.

### Opensource Project CLA

<https://www.openproject.org/contributor-license-agreement/>

The Opensource project provides a comprehensive individual contributor agreement that meets most of the key requirements. This agreement was created from Harmony (see above)

### Simple generic CLA

It is possible to use a simple generic CLA that simply requires contributors to assert that all their contributions are either their own work or, if it is their employers work, that they are allowed to contribute them, under the licence of the project. The following example is adapted from the Quantlib CLA (developed and houses at cla-assistant.io, <https://cla-assistant.io/lballabio/QuantLib>):

*I assert that any past, present and future contributions I make to the XXX project are:*

* *my own work, and I have the right to license them;*

***or***

* *owned by my employer, that has the right to license them and allowed me to contribute them.*

*If I own the contributions, I agree to license them under the terms of the XXXX license, available at http://yyyy.*

*If my employer owns the contributions, I assert that my employer agrees to license them under the terms of the XXXX license, available at http://yyyy.*

## Additional reading on CLA’s

<https://opensource.guide/legal/#does-my-project-need-an-additional-contributor-agreement>

<https://en.wikipedia.org/wiki/Contributor_License_Agreement#:~:text=A%20Contributor%20License%20Agreement%20(CLA,under%20an%20open%20source%20license.>

<https://ben.balter.com/2018/01/02/why-you-probably-shouldnt-add-a-cla-to-your-open-source-project/>

## Working Group Recommendation

TBC

Given the desired outcomes expressed in Section 2, and the samples provided in Section 3, this working group recommends that openASSA implements an agreement from Project Harmony (Section 3.1).

In addition, it is recommended that openASSA uses <https://cla-assistant.io/> to house the CLAs if GitHub is used for the project.

SAMPLE CLA TO BE ATTACHED FOR REVIEW