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Open Source Licenses After *Jacobsen v. Katzer*

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What starts in fun . . .

- **Robert Jacobsen**, plaintiff, professor of physics and model train enthusiast.
- **Matthew Katzer** and **Kamind Associates, Inc.**, defendants, CEO and his software company that develops software for model railroad enthusiasts.
- **DecoderPro**, open source software of the Java Model Railroad Interface Project, an open source software group.
- **Artistic License 1.0**, open source license under which DecoderPro was distributed and the license at issue in *Jacobsen.*

. . . ends in tragedy.

- Plaintiff moved for preliminary injunction before the United States District Court for the Northern District of California.
- No dispute that defendants copied and distributed the DecoderPro files without following the terms of the Artistic License.
- Plaintiff's motion for preliminary injunction was denied because . . . .
- Plaintiff's claim for copyright infringement sounds in contract, not copyright.

Reasonable minds . . . .

- The District Court findings:
  - Artistic License granted a nonexclusive license to use, distribute and copy the files subject to various "conditions".
  - Implicit in a nonexclusive license is the promise not to sue for copyright infringement (this promise will not protect use that exceeds the scope of the license).
  - The conditions of the Artistic License do not limit the scope of the license.
  - Defendants' distribution "may have constituted a breach of the nonexclusive license, but does not create liability for copyright infringement . . . ."

. . . . can differ.

- The United States Court of Appeals for the Federal Circuit vacated and remanded the District Court's judgment.
- Issue on appeal - - "whether the terms of the Artistic License are conditions of, or merely covenants, to the copyright license."
- Covenants are promises governed by contract law.
- Conditions are things that must be satisfied in order for a license to exist.
- Unfulfilled conditions = no license. No license = copyright infringement.

The little train that could.

- Skirting *Gilliam v. ABC (*copyright law protects economic incentives not moral rights), the Federal Circuit found the following:
  - Requiring references to the original source provides a benefit to the copyright holder because downstream users might be interested in participating in the open source project.
  - The Artistic License contains explicit restrictions governing the potential licensee's right to modify and distribute the open source software.
  - The Artistic License exacts consideration "in the form of compliance with the open source requirements of disclosure and explanation of changes," as opposed to fees.

On the wrong track?

- Given the history of the open source movement, and the emphasis on “free” in the Open Source Principles – e.g., free to use, free to make copies, etc. – it is a bit ironic that the Federal Circuit found the following:
- “The clear language of the Artistic License creates conditions to protect the economic rights at issue in the granting of a public license.”

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