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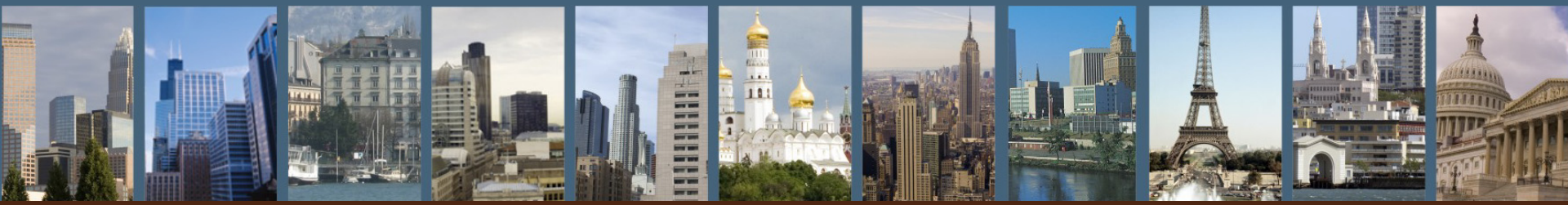

Open Source Licenses After *Jacobsen v. Katzer*

Becky Troutman

btroutman@winston.com

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ENFORCEABILITY OF OPEN SOURCE LICENSES

U.S. Cases Implicating The GPL

Parties to cases implicating the GPL have treated the GPL as being valid and enforceable

- Progress Software Corp. v. MySQL AB, 195 F.Supp. 2d 328 (D. Mass 2002)
- MontaVista Software, Inc. v. Lineo, Inc., NO. 2:02 CV-0309J (D. Utah, filed July 23, 2002, settled in 2003)
- Computer Associates v. Quest Software, 333 F.Supp. 2d 688 (N.D. Ill. 2004)

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ENFORCEABILITY OF OPEN SOURCE LICENSES

Enforcement by the Free Software Foundation ("FSF"), author of the GPL

- The FSF states that it has enforced the GPL for years and seeks compliance with the GPL (comply with license conditions or discontinue distribution), not release of source code or damages
- Cisco/Linksys Settlement (2003) – Linksys released source code
- Settlement terms of the BusyBox lawsuits (2007-2008) against Monsoon Media, Xterasys, High-Gain Antennas and Verizon/Actiontec required defendants to:
  - Appoint an open source compliance officer
  - Publish the BusyBox source code
  - Notify recipients of the software of their rights under the GPL
  - Pay an undisclosed sum to the BusyBox developers

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ENFORCEABILITY OF OPEN SOURCE LICENSES

International Enforcement

Germany –Harold Welte / gpl-violations.org obtained injunctions against:

- Sitecom Germany; GmbH (2004)
- Fortinet UK Ltd (2005)

The Netherlands – Creative Commons Attribution-Noncommercial-Sharealike License (2006)

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COVENANTS AND CONDITIONS

Covenants – Enforced Under State Contract Law

- State contract laws generally require offer, acceptance and consideration for a valid contract
- Consideration may be in the form of mutual promises / exchange of obligations
- A contract must meet applicable state law requirements and is subject to contract defenses, including lack of acceptance, lack of consideration and vagueness
- Breach of contract covenant remedies are typically limited to damages and do not include preliminary injunctive relief

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COVENANTS AND CONDITIONS

Conditions – Enforced Under Federal Copyright Law

- A license is the grant of permission to do something you could not legally do without permission and may be subject to conditions that restrict the scope of the license grant
- Violation of a license condition creates liability for copyright infringement
- Licenses are enforced under federal copyright law and remedies may include injunctive relief, damages (reasonable royalty) and statutory damages
- Certain contract law defenses do not apply (lack of acceptance, lack of consideration, vagueness)

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IMPACT OF THE JACOBSEN DECISION

Remedies

- Injunction
- Damages / Reasonable Royalty
- Statutory Damages
- Release of Source Code?

Enforceability of Licenses

Expanded Scope of Liabilities

Best Practices Going Forward

- Open source policy and approval process and training
- Commercial vendor representations & warranties
- Diligence in transactions

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