

THE LICENSE/CONTRACT DICHOTOMY IN OPEN LICENSES: A COMPARATIVE ANALYSIS

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ABSTRACT

The paper looks at the legal nature of so-called open licenses – agreements designed to provide permissions to users and publishers through “some rights reserved” clauses. The article starts with the assertion that copyright licenses are contracts in Civil Law jurisdictions, and looks at the opposing views and practice in Common Law jurisdictions. The article particularly looks at recent case law in the United States which deals specifically with the issue, and concludes that there is now a clear jurisdictional split between both traditions on whether these licenses are contracts.

I. INTRODUCTION

The term “open license” is an umbrella denomination used to refer to all sorts of “some rights reserved”¹ copyright agreements which provide users, publishers, distributors, programmers and creators rights that would otherwise not be available to them under the default “all rights reserved” copyright regime.² These rights include permission to use, modify, distribute, and publish the work.³ The use of the word “open” in the copyright licensing arena originates from the term “open

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1. See Creative Commons, What is CC?, <http://creativecommons.org/about/what-is-cc> (last visited March 06, 2009) (explaining that, the expression “some rights reserved” has been popularized by the Creative Commons organization).

2. See Christian H. Nandan, *Open Source Licensing: Virus or Virtue?*, 10 TEX. INTELL. PROP. L.J. 349, 352 (Spring 2002).

3. *Id.*

source” (FOSS)⁴ which is used to describe software released through one of the various licenses that meet the Open Source Definition.⁵ Nowadays, the term encompasses licensing solutions that extend to fields as diverse as software development and blogging.⁶ There are a rising number of areas that are using FOSS licensing schemes to distribute creative works and scientific research through novel publishing licensing models exemplified by the Creative Commons (CC) project and the Open Access (OA) movement.⁷ Many participants in diverse fields of study are looking at the open licenses used in software development and exporting them to accommodate the needs of the area where the licenses are being applied to – be it a sound recording, a literary work, or an academic journal article.⁸

Open licenses, and in particular open source licenses, have been the subject of considerable scholarly legal discussion.⁹ However, one area that has generated some controversy, yet surprising little coverage, is that of the legal nature of the licenses. I personally came face to face with the debate during a paper presented at the 2007 iSummit in Dubrovnik, Croatia. The iSummit is an annual event that brings together people related to the Creative Commons, iCommons and Creative Commons International organizations, and the aforementioned meeting had the purpose of showcasing legal experts from around the world who are interested in the specific legal issues related to Creative Commons licenses – which are to be grouped in the wider definition of open

4. See GLYN MOODY, *REBEL CODE: LINUX AND THE OPEN SOURCE REVOLUTION* 37-39 (2002) (resulting acronym from the two main philosophies in open non-proprietary software development: Free Software and Open Source Software).

5. Ken Coar, *The Open Source Definition* (Jul.7, 2006), <http://www.opensource.org/docs/osd>.

6. See Cassandra Klotz-Ingram & Kelly Day-Rubenstein, *The Changing Agricultural Research Environment: What Does It Mean For Public-Private Innovation?* 2 J. AGROBIOTECHNOLOGY MGMT. & ECON. 24 (1999) (identifying the earliest reference to the denomination “open licenses,” to indicate the licensing of works in fields other than software).

7. See Andrés Guadamuz González, *Open Science: Open Source Licenses in Scientific Research*, 7 N.C. J.L. & TECH. 321, 330-340 (Spring 2006).

8. See Joseph P. Kendrick, *Does Sound Travel in Cyberspace?*, 8 J. SMALL & EMERGING BUS. L. 39, 65 (Spring 2004); Klaus M. Schmidt & Monika Schnitzer, *Public Subsidies for Open Source? Some Economic Policy Issues of the Software Market*, 16 HARV. J.L. & TECH. 473, 474 (Spring 2003); Lawrence B. Solum, *Blogging and the Transformation of Legal Scholarship*, 84 WASH. U. L. REV. 1071, 1078 (2006).

9. See e.g., Robert Gomulkiewicz, *General Public License 3.0: Hacking the Free Software Movement’s Constitution*, 42 HOUS. L. REV. 1015 (2005); Dan Ravicher, *Facilitating Collaborative Software Development: The Enforceability of Mass Market Public Software Licenses*, 5 VA. J. L. & TECH. 11 (2000); Yochai Benkler, *Coase’s Penguin, or, Linux and the Nature of the Firm*, 112 YALE L.J. 369 (2002).

licenses. During that presentation, one of my slides contained one small bullet point that simply read “license or contract?” I was peripherally aware that this question was being asked about open source licenses, but I was not prepared for the heated discussion that ensued. The main issue that arose during the question and answer session was whether Creative Commons licenses are contracts or not. The question resulted in a stark division between legal traditions, lawyers from Civil Law countries opined that it was a contract, while lawyers from Common Law countries thought that it was not. During Q&A, Professor Lawrence Lessig made a clear presentation of the “licenses are not contracts” argument, while most Civil Law lawyers in the room begged to disagree, although finding the arguments persuasive. As a lawyer with a Civil Law background lecturing in a mixed legal system, I decidedly came in favor of the contractual solution.

The present note is a relatively short attempt to delineate the arguments for and against the classification of open licenses as contracts. While my personal take on the subject favors the Continental tradition, and therefore favoring the contractual approach, I have attempted to look at the current situation in Common Law jurisdictions, which decidedly supports the separate classification. There is in my opinion need for a comparative analysis of this topic because of the international nature of many of these licenses, which demands the broadest possible interpretation. It will be assumed that the reader is familiar with some of the licenses, and therefore they will not be dealt with in detail.¹⁰ Because the piece talks about a wide range of copyright licenses, there is always the danger of unwarranted generalization. Nevertheless, one of the starting points of the present study is that there are considerable similarities in the various licenses, which allow a broad legal study of the contractual issues surrounding them.

II. CONTRACT OR LICENSE?

Before understanding the controversy, it is vital that we understand what a license is. A license is a legal figure that grants the licensee permission to perform acts that they would otherwise not be able to do

10. See also RISHAB A. GHOSH, CODE: COLLABORATIVE OWNERSHIP AND THE DIGITAL ECONOMY (2005); LUCIE M.C.R. GUIBAULT & OT VAN DAALLEN, UNRAVELING THE MYTH AROUND OPEN SOURCE LICENSES: AN ANALYSIS FROM A DUTCH AND EUROPEAN LAW PERSPECTIVE (2006); Andres Guadamuz-Gonzalez, *Open Science: Open Source Licenses for Scientific Research*, 7 N.C. J.L. & TECH. 321 (2006); Severine Dusollier, *The Master's Tools v. The Master's House: Creative Commons v. Copyright*, 29 COLUM. J.L. & ARTS 271 (2007); Niva Elkin-Koren, *What Contracts Can't Do: The Limits of Private Ordering in Facilitating a Creative Commons*, 74 FORDHAM L. REV. 375 (2005).

legally.¹¹ When one buys commercial software, the license allows one to install a copy of the program on a computer, an act that would otherwise infringe copyright.¹² As will be discussed in detail later on, in some jurisdictions licenses are contracts, and are classified as a specific type of contractual obligation.¹³ However, in some other countries, there is an uneasy relationship between licenses and contracts. An analogy can illustrate this dichotomy better. Imagine that you invite a friend to your house; this could be taken as a license to enter premises where they would otherwise not be entitled to do so. Suppose that you give your friend a document with several terms and conditions, and they will be given permission to remain in your house as long as they comply with those conditions. Is this document a contract, a quasi-contract, or a unilateral act? This may seem like an innocuous question, but one that has proved to be controversial in legal circles associated to the open source software movement. Some Free Software proponents are adamant that FOSS licenses are not contracts, but copyright licenses.¹⁴ FOSS advocate Pamela Jones explains the issue like this:

A lot of the confusion about the GPL stems from this central issue: Is the GPL a license or a contract? The reason this issue matters is that contracts are enforced under contract law, which is done state by state, and there are certain necessary elements to qualify as a valid contract. Licenses, instead, are enforced under copyright law at the federal level. The penalties available are not the same.¹⁵

As Jones rightly points out, this is not a mere arcane legal distinction, but it presents some important questions about enforcement, jurisdiction, applicable law, and even about license validity. There may also be different legal effects in some jurisdictions whether a contract is a contract for sale of goods, or a contract for services.¹⁶

On the other side of the debate, open source lawyer Lawrence Rosen believes that open licenses are unilateral contracts because they express a promise by the copyright owner not to interfere with actions

11. ANDREW M. ST. LAURENT, *UNDERSTANDING OPEN SOURCE AND FREE SOFTWARE LICENSING* 4 (O'Reilly 2004).

12. Michael J. Madison, *Reconstructing the Software License*, 35 *LOY. U. CHI. L.J.* 275, 279 (Fall 2003).

13. *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1449 (7th Cir. 1996).

14. *E.g.*, Pamela Jones, *The GPL is a License, Not a Contract*, *LINUX WEEKLY NEWS* (Dec. 3, 2003), <http://www.lwn.net/Articles/61292>.

15. *Id.*

16. See Hector L. MacQueen, *Software Transactions and Contract Law*, in *LAW AND THE INTERNET: REGULATING CYBERSPACE*, (Lilian Edwards & Charlotte Waelde eds., 1997) (distinguishing between software as sale of goods and sale of services).

permitted by the license.¹⁷ Furthermore, Rosen makes the strong argument that open contracts are better-off relying on contract law, as licensees would not have to rely on obscure and poorly-drafted terms and conditions, and instead could fall back on the richness of contract law.¹⁸ He states that:

Contract law, unlike copyright and patent law, provides procedures and rules for license interpretation and enforcement. Contract law, in the published court decisions and in the statutes adopted by legislatures around the world, addresses almost every possible term or condition a lawyer could dream up for a contract. Contract law specifies how contracts are to be formed, how they are to be interpreted, how they are to be enforced, and the remedies for breach. In many situations, where a license is silent about a particular term or condition, contract law even provides default “fill-in” provisions.¹⁹

The dichotomy between licenses and contracts exposed in the above paragraphs can be better understood in context of an ongoing debate about the uneasy balance that exists between contract and copyright law. Copyright law does not only protect the exclusive rights of authors, but it also protects users by explicitly allowing several acts that can be undertaken by members of the public without infringing copyright.²⁰ These exceptions to copyright law are created by legislation and case law²¹, and one could argue that they are in certain ways similar to licenses, with the difference that the permission to perform an act that would otherwise infringe copyright is awarded by the State, and not by the owner. However, one problem discussed at length by copyright and licensing experts is that some licenses can be drafted to circumvent such exceptions.²² This therefore opens up a question about which law should prevail when there is such a conflict, contract or copyright law? This is known as the preemption problem, and has been the subject of considerable discussion by legal scholars²³ and the courts.²⁴ While it is

17. LAWRENCE E. ROSEN, *OPEN SOURCE LICENSING: SOFTWARE FREEDOM AND INTELLECTUAL PROPERTY LAW* 53-57 (2004).

18. *See id.* at 58.

19. *Id.* at 57-58.

20. *See* Giuseppina D’Agostino, *Healing Fair Dealing? A Comparative Copyright Analysis of Canadian Fair Dealing to UK Fair Dealing and US Fair Use*, 53 MCGILL L.J. 309 (2008).

21. *See* Elizabeth M.N. Morris, *Will Shrinkwrap Suffocate Fair Use?*, 23 SANTA CLARA COMPUTER & HIGH TECH. L.J. 237, 258-261 (Jan. 2007).

22. Christina Bohannon, *Copyright Preemptions of Contracts*, 67 MD. L. REV. 616, 668 (2008).

23. *See* Pamela Samuelson & Kurt Opsahl, *Licensing Information in the Global Information Market: Freedom of Contract Meets Public Policy*, 21 EUR. INTELL. PROP. REV.

not the role of this article to expand on this issue, it is important to stress its relevance to the contract/license dichotomy. If open licenses are contracts, then it would be possible for them to preempt copyright exceptions under certain circumstances. However, most open license proponents are usually opposed to the idea that contract law preempts copyright law, which generates some practical and ideological problems to those involved, and may explain some of the aversion at considering these types of licenses as contracts.

III. CONSIDERING CONSIDERATION

The other question at the heart of this dichotomy between contracts and licenses rests on the issue of reciprocity, known in Common Law jurisdictions as consideration.²⁵ In English Contract Law, contracts are perfected when there are three elements present: offer, acceptance and consideration.²⁶ In a typical commercial software license, the contract would be perfected by the offer, which is represented by the terms and conditions attached to the software either in the package (known as shrink-wrap license), or by a message window that requires a positive action from the user (click-wrap license).²⁷ The acceptance happens when the user opens the package (in shrink-wrap licenses), or clicks on the “I Agree” button (in click-wrap licenses).²⁸ The consideration takes place because the software has been paid for, hence establishing some form of reciprocity.²⁹

However, open licenses present a problem to this traditional view of contract formation because products released under an open source license are often offered for free, which would mean that there is no consideration.³⁰ This lack of reciprocity is vital for thinking of open licenses as mere grants of rights, and not as contractual obligation. Professor Eben Moglen comments:

386 (1999); David A. Rice, *Copyright and Contract: Preemption after Bowers v. Baystate*, 9 ROGER WILLIAMS U. L. REV. 595 (2003-04); T. Vinje, *Copyright Imperilled?* 21 EUR. INTELL. PROP. REV. 192 (1999); and Niva Elkin-Koren, *Copyright Policy and the Limits of Freedom of Contract*, 12 BERKELEY TECH. L.J. (1997).

24. *ProCD v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996).

25. *Currie v. Misa*, (1875) 10 L.R. Exch. 153 (Q.B.) (defining consideration as “some right, interest, profit or benefit accruing to one party, or some forbearance, detriment, loss or responsibility given, suffered or undertaken by the others.”).

26. Rosen, *supra* note 17, at 59.

27. *Id.* at 60.

28. *Id.*

29. *See id.* at 62.

30. *See id.*

A contract [. . .] is an exchange of obligations, either of promises for promises or of promises of future performance for present performance or payment. The idea that ‘licenses’ to use patents or copyrights must be contracts is an artifact of twentieth-century practice, in which licensors offered an exchange of promises with users: ‘We will give you a copy of our copyrighted work,’ in essence, ‘if you pay us and promise to enter into certain obligations concerning the work.’ With respect to software, those obligations by users include promises not to decompile or reverse-engineer the software, and not to transfer the software. The GPL, however, is a true copyright license: a unilateral permission, in which no obligations are reciprocally required by the licensor. Copyright holders of computer programs are given, by the Copyright Act, exclusive right to copy, modify and redistribute their programs. The GPL, reduced to its essence, says: ‘You may copy, modify and redistribute this software, whether modified or unmodified, freely. But if you redistribute it, in modified or unmodified form, your permission extends only to distribution under the terms of this license. If you violate the terms of this license, all permission is withdrawn.’³¹

This seems like a valid explanation for Common Law systems, but in Civil Law systems contracts are perfected when the requirements of offer and acceptance have been met,³² which means that non-commercial or gratuitous acts can constitute contracts under the appropriate conditions.³³

However, one could argue that there is consideration in some FOSS licenses, particularly in copyleft licenses. In short, copyleft clauses impose an obligation to release modifications with the same license with which it was received, and are present in a large number of open licenses, from the General Public License (GPL), to several CC licenses.³⁴ Risking the over-simplification of the rich case law dealing with consideration and contract formation in Common Law, one could boil down the concept to one of reciprocity, as has been expressed earlier. If one defines consideration as such, then it would be possible to see how copyleft clauses would fulfill the requirement of consideration

31. Jones, *supra* note 14.

32. HECTOR L. MACQUEEN & JOE M. THOMSON, *CONTRACT LAW IN SCOTLAND* 54-56 (2d ed. 2007).

33. *Id.* at 56-59.

34. See Andres Guadamuz-Gonzalez, *Viral Contracts Or Unenforceable Documents? Contractual Validity of Copyleft Licenses*, 26 *EUR. INTELL. PROP. REV.* 331 (2004) (discussing in detail copyleft licenses).

in jurisdictions where it is required. The contract then would be formed like this: making the software available under an open license would be the offer, using the work would be the acceptance, while consideration would be met by the obligation imposed in the copyleft clause. However, some scholars disagree that copyleft clauses meet the requirement of consideration.³⁵ Giles for example, argues strongly that copyleft is, at best, illusory consideration, and he has found several cases that support his opinion.³⁶ Particularly, he cites *British Empire Films Party Ltd. v Oxford Theatres Party Ltd.*,³⁷ where the courts found unilateral promises that depended entirely on the will of one of the parties as illusory consideration. In that ruling, Judge O'Brian stated that:

It is common ground that the plaintiff is obliged to supply nothing, and a supposed consideration which is entirely dependent upon the will of the plaintiff whether it will ever become operative is illusory.³⁸

However, this does not seem to be a useful analogy, as the promises dealt with in illusory consideration case law are very specific, and do not seem to translate well into the realm of open licenses. For example, participants in the software development community may have their options seriously curtailed if they use copyleft software, as they will be under a very real obligation to release modifications under the same license with which they received it. True, they may choose not to use the software, but is that not the case in all contracts? In other words, once they have accepted the terms and conditions of the license by using the software and modifying it, the obligation imposed on them seems very real and not illusory at all.³⁹

Furthermore, Giles seems to ignore some of the rich and deep criticisms to the strict application of consideration to all contracts. In an often quoted article, Lord Wright argues that there are several legal contracts that are traditionally not encumbered with the burden of consideration, such as firm options to be offered at a certain time.⁴⁰

35. Dr. José González de Alaiza Cardona, *Open Source, Free Software, and Contractual Issues*, 15 TEX. INTELL. PROP. L.J. 157, 193 (Winter 2007).

36. Ben Giles, 'Consideration' and the Open Source Agreement, 49 N.S.W. SOC'Y FOR COMPUTERS & L.J. (2002), available at <http://www.nswscl.org.au/journal/49/Giles.html>.

37. *British Empire Films Party Ltd. v. Oxford Theatres Party. Ltd.* (1943) V.L.R. 163 (Austl.).

38. *Id.* at 168.

39. See Gomulkiewicz, *supra* note 9.

40. Lord Wright, *Ought the Doctrine of Consideration to Be Abolished from the Common Law?* 49 HARV. L. REV. 1225, 1232 (1936).

Similarly, Professor Posner proposed a utilitarian test for whether unilateral or gratuitous promises should be enforced.⁴¹ He argued that some unilateral promises are not to be considered gratuitous if there is a condition to be met by the recipient, even if this is not pecuniary.⁴² For example, he noted that “*A might promise B \$100 if B would stop smoking. The promise here is in exchange for something (perhaps mysteriously) of value to A, namely B’s forbearance to smoke.*”⁴³

Finally, Rosen seemingly solves the problem of consideration by suggesting that the term “copyleft” could be easily replaced by the word “reciprocity.”⁴⁴ Talking specifically about the GPL, he believes that a change in terminology is warranted because both parties express a reciprocal set of obligations when signing up to the license.⁴⁵ The licensor promises to allow the licensee to make use of the work, while the latter acquires the obligation not to release the work under another license, or to add new restrictions to derivative works, or to not distribute the work for commercial gain – as is the case with some Creative Commons licenses.⁴⁶ These are tangible and onerous obligations that meet the reciprocal aspect required by Common Law tradition of contract formation.

IV. CIVIL JURISDICTIONS

As already mentioned in previous sections, licenses in general, and open licenses specifically, are generally classed as contracts in Civil Law jurisdictions, even if we accept the theory that they lack consideration.⁴⁷ This is because Civil Law does not have consideration as a formal requirement for contract formation.⁴⁸ In Civil Law traditions, contracts are perfected only with the presence of offer and acceptance, so pecuniary remuneration, reciprocity and the intention to enter into a commercial transaction do not play the important role in contractual doctrine and practice.⁴⁹ Licenses in general are treated as contracts, albeit a sub-species of obligations.⁵⁰ In Spanish-speaking

41. Richard A. Posner, *Gratuitous Promises in Economics and Law*, 6 J. LEGAL STUD. 411 (1977).

42. *Id.* at 416.

43. *Id.*

44. Rosen, *supra* note 17, at 105.

45. *Id.* at 106.

46. *Id.* at 103-04.

47. MacQueen, *supra* note 32, at 56-59.

48. Christian Larroumet, *Detrimental Reliance and Promissory Estoppel as the Cause of Contracts in Louisiana and Comparative Law*, 60 TUL. L. REV. 1209, 1212 (1986).

49. *See id.*

50. *ProCD v. Zeidenberg*, 86 F.3d 1447, 1450 (7th Cir. 1996).

countries for example, licenses are actually known formally as “contratos de licencia,” or “licencias contractuales,” literally, “license contracts.”⁵¹

Even if there appears to be little debate about the legal nature of open licenses in Continental traditions, there are still some interesting questions that require further examination. For example, Argentinean lawyer Martín Carranza classifies open licenses, particularly the GPL, as a standard form contract,⁵² which presents some questions about the legal nature of the contract.⁵³ According to Carranza, open licenses are typical boilerplate contracts because one of the parties drafts all the terms and conditions, and then the counterpart will either accept the contents of the document or reject them. While this seems clear with licenses, an interesting effect of open licenses being considered as form contracts is that they would be eventually subject to unfair contract terms legislation, which can be considerably powerful in some legislation.⁵⁴ This would be relevant as the potentially abusive terms present in open licenses could be declared invalid.⁵⁵

Another point of note in civil jurisdictions relevant to open licenses is that of the distinction between unilateral and bilateral acts. As it has been mentioned earlier, there is a line of thought that classes licenses as unilateral acts.⁵⁶ If one was to take this view, then this type of legal act would fall under the regulation of unilateral obligations, which are generally classed as “quasi-contracts.”⁵⁷ These are “purely voluntary acts of the party from which results any engagement whatsoever towards a third person, and sometimes a reciprocal

51. See e.g., Art. 115 of the Ley de Propiedad Intelectual [Law of Intellectual Property] (B.O.E. 1996, 97), available at <http://civil.udg.es/normacivil/estatal/reals/Lpi.html> (specifying that rights in phonograms can be granted through “licencias contractuales” [contractual licenses]).

52. Contrato de adhesión.

53. MARTIN CARRANZA-TORRES, PROBLEMÁTICA JURÍDICA DEL SOFTWARE LIBRE 173-75 (LexisNexis 2004).

54. See e.g., Council Directive 93/13, 1993 O.J. (L 95) 29 (dealing with unfair terms in consumer contracts).

55. See generally Guadamuz-Gonzalez, *supra* note 34, at 21.

56. Jones, *supra* note 14.

57. Examples of laws which regulate quasi-contracts are found in most Civil Codes in Continental traditions. See e.g., Code Civil [C. CIV.] [Civil Code] art. 1371 et seq. (Fr.), available as translated at <http://195.83.177.9/code/liste.phtml?lang=uk&c=22&r=493>; Código Civil [Civil Code] art. 1887 et seq. (Spain), available at http://noticias.juridicas.com/base_datos/Privado/cc.l4t16.html; Bürgerliches Gesetzbuch [Civil Code] Aug. 18, 1896, Bundesgesetzblatt, Teil I [BGBl. I] 42, § 812, available as translated at http://www.gesetze-im-internet.de/englisch_bgb/german_civil_code.pdf; see also H. G. BEALE, & DENIS TALLON, CONTRACT LAW 77-79 (Hart Pub. 2002).

engagement of two parties.”⁵⁸ Similarly, the recent Principles of European Private Law,⁵⁹ which contain a series of model rules for harmonizing European contract law, also provide contractual enforceability to unilateral acts, which are classified as “juridical acts.”⁶⁰ § I:101(2) defines juridical acts thus:

A juridical act is any statement or agreement, whether express or implied from conduct, which is intended to have legal effect as such. It may be unilateral, bilateral or multilateral.⁶¹

The importance of the inclusion of open licenses as either quasi-contracts or juridical acts is that these tend to have the same effects as contracts. For example, § I:103(2) of the Principles of European Private Law considers that a unilateral act is “binding on the person giving it if it is intended to be legally binding without acceptance.”⁶² While there is a good argument to be made against the idea that open licenses are bilateral in nature, the argument is moot in Civil Law systems because licenses would be covered under general norms of contract law even if they are unilateral obligations.

V. RECENT CASE LAW

Regardless of these seemingly theoretical discussions, the contract/license dichotomy has been discussed at length in a recent case *Jacobsen v. Katzer*,⁶³ which dealt precisely with this question.

The case involved Robert Jacobsen, an open source developer participating in an open source⁶⁴ project called Java Model Railroad Interface (JMRI), which is a model train software released under the Artistic License.⁶⁵ Jacobsen received a letter demanding license fee payments from a company named Kamind Associates, owned by Matthew Katzer, which had previously obtained software patents⁶⁶ over

58. C. CIV. art. 1371 (Fr.).

59. CHRISTIAN VON BAR, PRINCIPLES, DEFINITIONS AND MODEL RULES OF EUROPEAN PRIVATE LAW 183 (Sellier 2008).

60. *Id.* at 105.

61. *Id.*

62. *Id.* at 183.

63. *Jacobsen v. Katzer*, 535 F.3d 1373 (Fed. Cir. 2008), *vacated*, *Jacobson v. Katzer*, No. C 06-01905 JSW, 2007 U.S. Dist. LEXIS 63568 (N.D. Cal. Aug. 17, 2007).

64. See Open Source Initiative (OSI), The Artistic License, <http://www.opensource.org/licenses/artistic-license-1.0.php> (last visited Mar. 5, 2009).

65. *Jacobsen*, 535 F.3d at 1376.

66. Model Train Control System, U.S. Patent No. 7,216,836 (filed Oct. 26, 2004) (issued May 15, 2007).

model rail road software.⁶⁷ Jacobsen decided to pre-empt legal action and sued Katzer first, alleging that the patent was invalid on the grounds of obviousness, and for failure to meet disclosure requirements.⁶⁸ He later amended the complaint to include copyright infringement, as he claimed that his software pre-dated Katzer's.⁶⁹

The U.S. District Court for the District of Northern California ruled on a motion to dismiss by the defendants and on a motion for preliminary injunction from the plaintiff.⁷⁰ The District Court granted some of the motions to dismiss, denied others, and denied the claim for preliminary injunction.⁷¹ The important part of the decision for the current discussion is the analysis of the copyright infringement claims. The District Court declared that because the software was released to the public online through an open source license, there was clear permission to use the software.⁷² The Artistic License is not a copyleft license, it allows modification and the creation of derivatives, provided that those doing it insert prominent notices on each file, and perform one of the following:

- a) place your modifications in the Public Domain or otherwise make them Freely Available, such as by posting said modifications to Usenet or an equivalent medium, or placing the modifications on a major archive site such as ftp.uu.net, or by allowing the Copyright Holder to include your modifications in the Standard Version of the Package.
- b) use the modified Package only within your corporation or organization.
- c) rename any non-standard executables so the names do not conflict with standard executables, which must also be provided, and provide a separate manual page for each non-standard executable that clearly documents how it differs from the Standard Version.
- d) make other distribution arrangements with the Copyright Holder.⁷³

The District Court astutely understood that such restrictions are not copyright restrictions, they are contractual obligations.⁷⁴ They claimed:

67. *Jacobsen v. Katzer*, No. C 06-01905, JSW 2007 U.S. Dist. LEXIS 63568, at *2 (N.D. Cal. Aug. 17, 2007).

68. *Id.* at *2-*3.

69. *Jacobsen*, 535 F.3d at 1376.

70. *Jacobsen*, 2007 U.S. Dist. LEXIS 63568, at *1.

71. *Id.* at *2.

72. *Id.* at *17-*18.

73. Open Source Initiative, *supra* note 64, at § 3.

74. *Jacobsen*, 2007 U.S. Dist. LEXIS 63568, at *18.

Based on the [sic] both the allegations in the amended complaint and the explicit language of the JMRI Project's artistic license, the Court finds that Plaintiff has chosen to distribute his decoder definition files by granting the public a nonexclusive license to use, distribute and copy the files. The nonexclusive license is subject to various conditions, including the licensee's proper attribution of the source of the subject files. However, implicit in a nonexclusive license is the promise not to sue for copyright infringement. . . . Therefore, under this reasoning, **Plaintiff may have a claim against Defendants for breach[ing] the nonexclusive license agreement, but perhaps not a claim sounding in copyright.** . . . However, merely finding that there was a license to use does not automatically preclude a claim for copyright infringement. . . . The condition that the user insert a prominent notice of attribution does not limit the scope of the license. Rather, Defendants' alleged violation of the conditions of the license may have constituted a breach of the nonexclusive license, but does not create liability for copyright infringement where it would not otherwise exist. (*emphasis added*).⁷⁵

The District Court alleged that there should be no presumption of a copyright infringement claim, and that such claim should be proven before the plaintiff can make its case.⁷⁶ If the plaintiff cannot provide evidence that such a claim may be successful in court, then Jacobson could only rely on the contractual elements of the license in order to seek redress; namely, the failure to place attribution notices is not enough to make a copyright claim, but a contractual one.⁷⁷ Interestingly, the District Court understood perfectly the trade-off in open source licenses that rests at the very heart of the contract/license dichotomy: if the user complies with the license, there is permission to use the software, and therefore there is no copyright infringement. But, if there is no claim for copyright over the work, then the only claim possible is through breach of contract.

Katzer appealed the District Court ruling, and it made its way to the Court of Appeals for the Federal Circuit (CAFC), which repealed the decision by holding that open source licenses set out permissions to use the work, and if the license disappears, then the user would be infringing copyright.⁷⁸ The ruling makes for some interesting reading, and the CAFC says that:

75. *Id.* at *19-*20.

76. *Id.* at *20.

77. *Id.*

78. *Jacobsen*, 535 F.3d at 1381.

In this case, a user who downloads the JMRI copyrighted materials is authorized to make modifications and to distribute the materials provided that the user follows the restrictive terms of the Artistic License. A copyright holder can grant the right to make certain modifications, yet retain his right to prevent other modifications. Indeed, such a goal is exactly the purpose of adding conditions to a license grant. The Artistic License, like many other common copyright licenses, requires that any copies that are distributed contain the copyright notices and the COPYING file.⁷⁹

The CAFC has to be congratulated for understanding the basic concepts behind open source licensing. In various passages, they clearly “get” the basis of the movement and the underlying rights. The CAFC has delivered the highest instance recognition to open licenses, which is another encouraging sign for FOSS development. The appeal has also pleased many in the FOSS community. For example, the ruling closely follows the arguments presented in an amicus curiae against the District Court interpretation. In it, the Open Source Initiative, the Linux Foundation, and others, argued that “*it would be enormously beneficial to public licensing for this Court to state clearly a rule regarding the importance of interpreting public licenses in a manner consistent with their unique nature and federal copyright policy.*”⁸⁰

VI. CONCLUSION

Despite the final decision in *Katzer*, I still think that it is preferable to classify FOSS licenses as contracts. If this is the case, one has to wonder about why the FSF is so adamant in their insistence that their licenses, in particular the GPL, are not contracts. There are few practical reasons why some FOSS proponents insist on licenses not having contractual strength. Moglen is on record stating that the GPL primarily rests on copyright and the international protection awarded by the Berne Convention.⁸¹ He is also uneasy with the global variability of contract law, and is afraid that a judge in one jurisdiction may impose local contract law interpretations which may affect the project globally.⁸² By

79. *Id.* at 1382.

80. Brief of Amici Curiae Creative Commons Corp. et al. In Support of Plaintiff-Appellant, *Jacobson v. Katzer*, 535 F.3d 1373 (Fed. Cir. 2008) (No. 2008-1001), 2007 WL 4968765.

81. Jones, *supra* note 14.

82. The Auskadi Blog Place, Interview Eben Moglen, Legal Counsel, Free Software Foundation, Mar. 3, 2004, http://auskadi.civiblog.org/blog/_archives/2005/6/25/972325.ht

using copyright instead of contract, it is in the licensee's best interest to make sure that the license is valid, as they would otherwise be infringing copyright without the document that permits them to make use of the work. He says:

So all that I do is bring an infringement action. It is the defendant's responsibility to prove license and the only credible license for the defendant to plead is my license, because code is not otherwise available except under that license.⁸³

This seems to be a rather negative view of copyright licensing, as it seems like all use of the licensed work should be considered *a priori* infringement until proven otherwise. Using the earlier analogy about licensing, this would be the same as if I were to invite a friend to my house, and the moment they enter I would call the police claiming trespass. It is more logical to think of the invitation itself as a license that allows my friend to perform an action which they would not otherwise have a right to do, namely enter my house without permission. Were they to behave in a manner contrary to the terms of the invitation, I would be justified in asking them to leave, and call the police if they refuse to do so. Moglen seems to think of copyright licenses as expressing the first scenario and not the second, which seems detrimental to licensees worldwide. Furthermore, as discussed above in *Jacobsen v. Katzer*, there is a real possibility that the user will not have a claim in copyright, and therefore all of the obligations contained in the license can only be enforced through contract.

The above analysis makes an important point if one considers the practicalities in software development in particular. Code is created, copied, transferred and modified by people all over the world. It is possible to imagine a situation where code has reached a developer in such a modified state that the original owner will no longer be able to claim copyright over it. English courts have considered the minimal amount of code that would be infringing by following the general qualitative test in cases of copying from another work. In both *Richardson Computers v. Flanders*⁸⁴ and *Ibcos v. Barclays*,⁸⁵ the courts found that if there had been any copying from a protected original work, that there had to be an analysis of whether such copying had been

ml (last visited March 6, 2009) (transcribing an interview of Eben Moglen by Kathy Bowrey).

83. *Id.*

84. *John Richardson Computers, Ltd. v. Flanders*, (1993) F.S.R. 497 (Ch.) (U.K.).

85. *IBCOS Computers Ltd. v. Barclays Mercantile Highland Finance Ltd.*, (1994) F.S.R. 275 (Ch.) (U.K.).

substantial. There will be some consideration about the quantity of the work copied, but even if this is minimal it may result that the copying may be deemed to be substantial. This is evident in the case of *Cantor v. Tradition*,⁸⁶ where copying of original source code took place from former employees of a financial services company. In this case, expert witnesses found that only 2% of the original source code had been copied, accounting for only 2,952 lines of code out 77,000.⁸⁷ The lines of code were deemed to be of importance for some modules in the resulting software, but the copying was not considered substantial to grant the infringement case, but was enough for the copier to agree to take financial responsibility for the infringed code and offer to pay for it.⁸⁸ One could therefore imagine a situation where such a change has taken place, and enough changes have occurred so that the code would no longer be subject to copyright.

To conclude, the question of the legal nature of open licenses is more certain in Civil Law jurisdictions than it is in Common Law. While there is no problem of there being a jurisdictional split in this area, those people who use works released with an open license should be mindful of some of the jurisdictional pitfalls highlighted above. Authors and creators who wish to release their works under one of these licenses, and are thinking about enforcement of their rights, may have to consider that their best claims may lie in contract and not copyright law. Copyright owners in Civil Law jurisdictions should also be prepared to face the fact that enforcement of their works in Common Law systems may not be contractual, but it may be subject to copyright. Given the reputation of draconian copyright enforcement in the United States, this may give those same authors cause for concern.

86. *Cantor Fitzgerald International v. Tradition (U.K.) Ltd.*, (2000) R.P.C. 95 (Ch.) (U.K.).

87. *Id.*

88. *Id.*