Open Source and the Age of Enforcement

by HEATHER J. MEEKER*

I. Introduction

It is fitting that we are moving into the teens of the twenty-first century, because open source software licensing has hit its heady and unpredictable adolescence. The last five years have seen the first serious enforcement efforts by licensors of open source software, so we are truly at the dawning of the age of enforcement. But open source claims are not like other claims. Understanding the distinctions between open source software claims and other intellectual property claims is key to reacting to open source claims gracefully, effectively, and with a minimum of embarrassment and cost.

A survey of where we stand today demonstrates how this area has developed. We will be soon nearing the point where catalogs of open source claims in articles like this one will no longer be sensible or useful, but for now, seeing where we have been neatly explains where we are. The first years of the twenty-first century saw the first written opinion handed down in the United States on open source

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1. For additional information of open source software and licenses, see HEATHER J. MEEKER, Common Open Source Licenses and Their Structure, in THE OPEN SOURCE ALTERNATIVE: UNDERSTANDING RISKS AND LEVERAGING OPPORTUNITIES 27 (2008).
licensing law. That decision, Jacobson v. Katzer, was generally seen as a victory for open source licensing. It underscored that open source licenses were not *prima facie* unenforceable, nor would they be vulnerable to contract formation claims. Leading up to *Jacobson* were a variety of claims—mostly settled long before they threatened to create case law—that set the groundwork for enforcement. Below is a list of most of the cases relating to open source licensing.

II. The Early Years: Pre-*Jacobson*


NuSphere and MySQL had a business relationship in which NuSphere marketed several products that included both MySQL software and other proprietary software. Proprietary code (called Gemini) was statically linked to MySQL code in the NuSphere MySQL Advantage product. Although MySQL alleged a breach of its GPL license, the case was decided on trademark grounds, with the court sidestepping the GPL issues.


This was one of the earliest open source cases, filed in November 2003 and settled in early 2005. Drew Tech released certain software under the GNU General Public License (GPL), and that software was posted by an employee of Drew Tech on a message board run by the Society of Auto Engineers. Drew Tech sued to compel the removal of the posting, and the case was settled and the posting removed. No reported opinion resulted, but the result suggested the GPL was enforceable.

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Although this case received little press and fanfare, it involved a familiar fact pattern, but in mirror image. Drew’s employee posted the software without its GPL notices. The more common situation is the opposite. Today’s technology companies often employ software engineers who are very enthusiastic about open source software. Those employees may, upon leaving the company or even before, make unauthorized code releases under open source terms that conflict with the proprietary terms offered by their company. This situation sometimes is a result of a misunderstanding regarding who owns the code, but occasionally results from the actual malfeasance of disgruntled employees. In any case, unauthorized code releases are often resolved via a takedown of the code—as quietly as possible.


Jin v. IChessU was a case that briefly whetted the appetite of open source lawyers, because it squarely concerned the scope and interpretation of GPL—one of the big unresolved questions of open source law. In this case, International Chess University allegedly distributed the plaintiff’s GPL software, a chess client called “Jin,” and added an audiovisual library to it, taking the position the GPL did not require publication of the source code for the library. The author of Jin claimed it did. The case, which was brought in the courts of Israel, was settled in 2008.

D. Planetary Motion, Inc. v. Techplosion, Inc.

This trademark case pointed to the use of GPL licensing notices as evidence of the trademark’s owner intent to control the use of its mark. The court said, “Because a GNU General Public License requires licensees who wish to copy, distribute, or modify the

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6. Employees often do not fully understand the work for hire doctrine under copyright law, and believe they own rights to open source software created during their employment “on their own time.” The misunderstanding usually centers on the complexity of what constitutes the employee’s own time, and the breadth of assignments of rights in Employee Invention Assignment Agreements.


8. For details, see Jin vs. IchessU: The Copyright Infringement Case (Settled) (Oct. 6, 2008), http://www.jinchess.com/ichessu/.

software to include a copyright notice, the license itself is evidence of [the licensor’s] efforts to control the use of the ‘CoolMail’ mark in connection with the Software.” Since 2001 when this case was decided, understanding of the relationship between open source licensing and trademark husbandry has developed significantly. Companies like Red Hat have pioneered the husbandry of trademark rights parallel to open source licenses, rather than through them. Most commentators today would therefore consider GPL notices not to function as trademark notices. However, the court in this case was looking to the totality of the circumstances to assess whether the plaintiff had intended to use the mark as a trademark, and other facts and circumstances also contributed to the court’s decision.


This opinion declares that “Bison is open source code, meaning that it is distributed by the [Free Software Foundation] at no cost,” that programs under the GPL are “freely released into the public domain” and “The GPL would prevent plaintiff from attempting to claim copyright in that modified version of Bison.” Again, understanding of open source licensing has developed significantly since this 2004 case, and so the court’s comments should be viewed with skepticism: they are incorrect, or at best, an oversimplified view of open source licensing.

F. gplviolations.org

This set of cases is usually considered the first significant enforcement effort for GPL. They were brought by gpl-violation.org, an organization spearheaded by Harald Welte, a technologist and open source advocate in Germany. That these cases preceded actions in the United States is not surprising; the German legal system differs substantially from the United States legal system. For instance, German courts allow ex parte actions for injunction—a suit for an injunction brought by the plaintiff where the defendant does

10. Id. at 1198, n.16.


12. My thanks to Terry Ilardi for pointing me to the Computer Assocs. Int’l, Inc. and Planetary Motion cases.
not participate, and the plaintiff pursues the injunction directly with a court. Some, but not all, of the initial string of cases brought by this organization related to Mr. Welte’s own software. The most widely publicized of these cases was against Fortinet UK. A Munich district court granted a preliminary injunction against Fortinet prohibiting distribution of their products absent compliance with the GPL. Welte also claimed that Fortinet was obfuscating the existence of GPL code in its product, a fact Fortinet disputed. Fortinet eventually agreed to make certain source code in its products available under GPL.

Since that time, other authors have apparently empowered gplviolations.org to bring claims on their behalf in a similar fashion, and gpl-violations.org has grown in scope to an ad hoc enforcement organization for GPL and other free software, working with FSF Europe.

III. Formal Enforcement in the United States Bears Fruit

A. The Busybox Cases

Starting in 2007, the Software Freedom Law Center (SFLC) filed a series of lawsuits on behalf of Erik Andersen and Rob Landley, two of the authors of the “BusyBox” software. BusyBox emulates many standard UNIX tools in a small, efficient executable useful for embedded devices. The first suit was filed against Monsoon Multimedia, Inc. That case was settled with release of source code and an undisclosed settlement payment. SFLC next brought suit


against Xterasys and High-Gain Antenna. Both soon settled. Further suits were brought in 2007 to 2009 against Verizon Communications, Bell Microproducts, and Super Micro Computer. All settled quickly.

On December 14, 2009, SFLC filed another lawsuit naming fourteen defendants including Best Buy, JVC, and Samsung. Some of these are still pending.

One case, against Westinghouse Digital Electronics, resulted in a damages award, but this was because the defendant was in liquidation and defaulted on the litigation by failing to answer discovery requests. The judge awarded statutory damages, attorneys’ fees, and injunctive relief. Although the order characterizes the damages as “treble,” that was only true in the sense that the court awarded three times the upper limit of statutory damages in the absence of willfulness. The better characterization is enhanced damages—under 17 U.S.C. § 504, a court can in its discretion award statutory damages of up to $150,000 per work if the infringement is willful. The court did not make a finding of actual damages because the defendant failed to respond to discovery and thus never presented evidence to support calculation of actual damages. Also, as described in footnote 39 of the order, absent the default, statutory damages might have been unavailable because the plaintiff failed to timely register the copyright. Given


22. Attorneys’ fees were awarded because of the default.

that most software authors do not register their copyrights, this
could often be a significant limitation in claims enforcing open
source licenses. This case’s result is interesting mostly because it
confirms that injunction and statutory damages are available for
open source claims, but the facts were unusual and thus probably
difficult to extrapolate to non-default judgments.

In a coda to the Westinghouse default judgment, the District
Court for the Southern District of New York subsequently held
Westinghouse Digital, LLC (WD) in contempt for failing to defend
the suit.\textsuperscript{24} Westinghouse Digital Electronics, LLC (WDE)\textsuperscript{25} liquidated
its assets after severe business distress, and told the court it would
not defend the litigation. WD then purchased the assets of WDE.
The court assessed whether there was “a substantial continuity of
identity between” WDE and WD, and found that there was. WDE
made a fair use defense that seemed feeble based on its description
in the court’s order. The court invited evidence on damages and
attorney’s fees, and ordered forfeiture of all infringing articles.

It is important to note that the BusyBox cases named as
plaintiffs only some of the developers of BusyBox, and notably did
not include Bruce Perens, the original author, and maintainer Dave
Cinege, who made significant contributions to BusyBox. Perens
subsequently released a statement criticizing the current BusyBox
developers, saying

\begin{quote}
The version 0.60.3 of Busybox upon which Mr. Andersen
claims copyright registration in the lawsuits is to a great extent
my own work and that of other developers. I am not party to
the registration. It is not at all clear that Mr. Andersen holds a
majority interest in that work.\textsuperscript{26}
\end{quote}

Joint ownership is a lurking issue in open source enforcement.
While in the case of BusyBox, the primary authors were more or less
sequential (the laboring oar having been passed from Perens to
Cinege and so forth), open source projects are often collaborative
efforts. The messaging and rhetoric regarding open source

\textsuperscript{24} Opinion and Order at 3–4, Software Freedom Conservancy, Inc. v. Westinghouse
\textsuperscript{25} Opinion and Order at 15–16, Software Freedom Conservancy, Inc. v. Best Buy
\textsuperscript{26} Bruce Perens, \textit{Statement on Busybox Lawsuits}, available at http://web.archive.org/
development often emphasizes its collaborative nature, and this is ripe fodder for an argument that open source projects are actually joint works. Under U.S. law, joint authors all have an undivided interest in the work and can freely license it. Therefore, defendants facing claims of a single author among many may be in a position to seek a license from a joint author and claim a license defense. Alternatively, defendants may be able to raise procedural arguments, that all authors must be joined to the suit for the claim to go forward. U.S. courts sometimes require this and sometimes do not. When they do, the reason given is that if any author could have granted a license, then the claim cannot be resolved until they are involved. Even if a defendant is not ultimately successful in claiming a license from a non-plaintiff author, he or she may be able to delay and complicate the suit enough to make enforcement difficult.

The initial BusyBox cases are in many respects the quintessential action of the “age of enforcement.” They are brought by SFLC, albeit on behalf of private parties. Their settlement tends to be quick, reflecting SFLC’s strategy of establishing a track record of enforcement by selecting clear violations to pursue. The press releases announcing the terms of these settlements read like a template and are almost always described in some detail in a press release: appointment of an open source compliance officer, covenants to bring distribution into compliance (via communication of notices and release of source code), and the payment of damages—though probably less than one would expect from a proprietary software lawsuit. This form of settlement reflects the quintessential concerns of a zealous plaintiff—with a focus on compliance and transparency, rather than substantial damages.


In August, 2008, the U.S. Court of Appeals for the Federal Circuit issued the most significant decision on open source licensing in the United States to date—and followed the guidance of the open source community.28

27. Subject to certain requirements to account, for instance. Oddo v. Ries, 743 F.2d 630, 633 (9th Cir. 1984).

The case arose from a complicated set of facts. Both parties developed and distributed software for controlling model railroads—Robert Jacobsen making his “Java Model Railroad Interface” (JMRI) software available under an open source license free of charge, and Matthew Katzer (via his company Kamind Associates) selling commercial products under proprietary licenses. In particular, Jacobsen made available through the JMRI project software called DecoderPro, which is used by model railroad enthusiasts to program decoder chips in model trains to control lights, sounds and speed.

Jacobsen received a letter inviting him to license patents owned by Kamind, suggesting the patents were infringed by the JMRI software. Jacobsen filed a declaratory judgment action asking the court to rule that the patent was invalid due to prior art (or failure to disclose prior art including that of Jacobsen himself) or not infringed. Katzer’s original claim received a great deal of press in the open source world, feeding on fears that the existence of software patents spell death for open source projects. As the patent case progressed, Jacobsen discovered that Katzer had copied some of Jacobsen’s open source software and used it in Katzer’s proprietary product. Jacobsen’s software was licensed under the Artistic License, which is a relatively rarely used license that was originally written to provide rights to the PERL programming language interpreter. The requirements of the Artistic License are modest; it is generally considered a permissive open source license, similar to the Apache Software Foundation (Apache), Berkeley Source Distribution (BSD) or Massachusetts Institute of Technology (MIT) licenses. The Artistic License requires, as a condition to exercise of the license, certain copyright and license notices, and identification of changes made to the original author’s source code. Because these notices were not preserved by Katzer, Jacobsen made a counterclaim, alleging violation of the license.

In 2007, the District Court for the Northern District of California issued a preliminary ruling in the case stating that the license violation constituted a breach of contract. However, the court’s ruling did not support a claim for copyright infringement. The court reasoned that Katzer was exercising rights in the copyrightable

work, but was licensed to so do and thus was not liable for infringement. Copyright infringement claims can result from breach of the scope of a license, but the court distinguished violations of license scope and license conditions. This distinction is core to open source law because open source licenses grant all the rights of copyright—and so it is generally not possible to violate the scope of an open source license, only its conditions.

Proponents of free software such as the Free Software Foundation have long taken the position that their licenses are not contracts. Originally, this position may have been a strategic attempt to avoid contract formation issues that plagued the law of online distribution of the software in the early 1990s, but the position persists notwithstanding the intervening publication of a line of cases supporting enforceability of contracts in the download context.

The issue in this case is sometimes referred to in the open source legal community as the “license or contract” issue. In other words, are open source licenses contracts, or are they merely conditional licenses? The status of an open source license as a “license or contract” dictates the types of remedies available if a licensee violates the conditions of the license. If the conditions of an open source license are mere contractual covenants, as the district court order stated, then injunctive relief is generally not available. If, however, violating the conditions places the activities of the licensee outside the scope of the license, as the appellate court stated, the unlicensed activity is copyright infringement and far more likely to garner injunctive relief. Open source advocates also are concerned that the money damages for violation of open source licenses under contract law may be more limited than those available under copyright law, which can include statutory damages as well as actual damages.

The Free Software Foundation has long taken the position that open source licenses are licenses rather than contracts—however, this can be misleading because the two are not mutually exclusive. Most licensing contracts are both conditional licenses and contracts. The Jacobsen case holds that violating the conditions of an open source license can constitute copyright infringement, but not that open source licenses are not contracts.

The flip side of this question—whether the conditions of a license could be considered covenants whose performance might be ordered by a court—was not at issue. But this is the “bet the
company” issue for most corporate free software users. If providing source code were a contractual covenant, then failure to do so would be a breach of contract. However, even if it were a breach, specific performance of covenants is not generally available under contract law. Most companies’ biggest fear when dealing with GPL is that they will be compelled to lay open proprietary software. In fact, the likely worst case is that they will be given a Hobson’s choice: to lay it open and comply with GPL, or replace the GPL code.

On the question of whether the claim could sound in copyright, the appellate court reversed, and remanded the case back to the district court to determine whether Jacobsen had established his claim to an injunction. The Federal Circuit opinion was hailed as a victory for open source licensing.

Ironies abounded in this case. This, possibly the most significant decision in open source software licensing to date, relates to the relatively obscure Artistic License—though the court’s mention of the GPL in a footnote suggests it intended the same result to hold for other open source licenses. Moreover, the decision was issued by the U.S. Court of Appeals for the Federal Circuit, which is the circuit that primarily adjudicates the enforcement of patents—the villains of the open source world. Finally, the case was only brought because Katzer chose to pursue a patent claim against a party whose code he had apparently copied—a strategy probably best avoided.

On December 10, 2009, on remand, the lower court issued an order granting and denying portions of motions for summary judgment by the parties. The court said, “Although it is undisputed that Plaintiff distributed the copied work on the Internet at no cost, there is also evidence in the record attributing a monetary value for the actual work performed by the contributors to the JMRI product,” and that the record “may establish a monetary damages figure.” This dispels the notion that no actual damages would be available for open source authors bringing claims of infringement because of the royalty free nature of open source licensing.

Jacobsen v. Katzer was finally settled in 2010, obviating a second appeal. The settlement included an injunction by the district court against further infringing activities, and was not sealed. Most

settlements are confidential, and an actual injunction by the court in a settlement is a bit unusual. But the injunction would have carried more precedential weight if it had been won in court rather than agreed to in settlement. (The District Court had previously declined to issue an injunction.)

It was significant that this case involved the original Artistic License. If a permissive license is enforceable, that lays substantial groundwork for enforceability of copyleft licenses. In Jacobsen, the question of actual harm to the copyright owner was squarely at issue. For Jacobsen to prevail, the court had to decide that there was sufficient harm to give rise to a remedy. With a permissive license, the harm is, essentially, failure to deliver notices. For a copyleft license, the conditions are much more significant, and violating them would give rise to greater harm, and in turn, greater opportunities for relief.


This suit was notable in that it was the first lawsuit filed for FSF as a plaintiff.\(^{31}\) Compliance issues regarding GPL software in Linksys consumer wireless routers had existed since Cisco acquired Linksys in 2003.\(^{32}\) This dispute resulted in a fairly quick release of source code, but FSF continued to find compliance issues with the routers, and finally filed suit in 2008. The accused software included various GPL and LGPL components.\(^{33}\) That suit was settled in 2009 with no substantial docket activity, via a settlement that, according to the press release describing it, was very similar to those in the BusyBox cases.\(^{34}\)


\(^{32}\) For details about the informal dispute that took place in the early 2000s see HEATHER J. MEEKER, Open Source and the Legend of Linksys, LINUXINSIDER (June 28, 2005), http://www.linuxinsider.com/story/43996.html?wlc=1300413418.

\(^{33}\) See Brett Smith, More Background About the Cisco Case, FREE SOFTWARE FOUNDATION (Dec. 18, 2008 12:05 PM), http://www.fsf.org/blogs/licensing/2008-12-cisco-complaint (including links to the complaint and FSF’s press release).

IV. Post-Jacobsen and Strategic Plaintiffs

A. Artifex Cases (2008–2009)

Artifex is the purveyor of the “Ghostscript” line of software, primarily used as embedded software in printers. In 2008 and 2009, it filed some of the first lawsuits brought by a private company to enforce GPL. The first plaintiff was Premier Election Solutions, at the time a subsidiary of Diebold. That case was settled quickly and confidentially. In 2009, in an action related to its MuPDF software (a high-performance PDF rendering engine), it brought claims against Palm, Inc. and various other defendants. The case was dismissed in early 2011.

B. U.S. Customs Case (Unfiled)—Fusion Garage

In September 2010, a Linux kernel developer, Matthew Garrett, posted a blog entry threatening a U.S. Customs case based on GPL violations. His blog describes failed attempts to get the source code for JooJoo Android tablets. According to this blog, the maker of the tablet, Fusion Garage, has not responded to requests for source code as required by GPL.

This method of enforcement is sometimes called a “337” action, because it is authorized by Section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337). If the U.S. International Trade Commission (ITC) finds Section 337 has been violated, it may issue an order directing that infringing goods be excluded from import into the United States. The order is executed by Customs and Border Protection (CBP), which may seize the goods at the border. The CBP’s border enforcement of copyrights is essentially limited to copyrights that have been registered with the U.S. Library of Congress and also recorded with CBP.

A circular published by the U.S. government says,

Members of the public may inform CBP of potential intellectual property rights violations via CBP’s on-line trade


violation reporting mechanism called e-Allegations. The public may access e-Allegations and additional relevant information at http://www.cbp.gov/xp/cgov/trade/trade_programs/e_allegations/. CBP also maintains an on-line recordation system, Intellectual Property Rights e-Recordation, which allows rights owners to electronically record their trademarks and copyrights with CBP, and facilitates IPR seizures by making IPR recordation information readily available to CBP personnel.38

This means that while only the owner of the copyright can bring a claim, anyone can report an infringing import.337 actions have long been used as a tactic to enforce intellectual property rights. They are generally faster and cheaper than federal litigation, and for this reason are particularly popular with patent plaintiffs. However, the remedies available are different from those in federal court—for example, a quick emergency exclusion order is more likely, but damages are not available. In addition, in a patent action, the complainant must show that the patent is being used in an “existing domestic industry.”39 This may exclude actions by non-practicing entities (NPE’s) or patent “trolls”—but the law is in flux.40

Since the blog post, nothing appears to have been filed, but the case is still worth mentioning because it shows another approach to litigation in the open source sphere—using a tactic already popular for patent and other intellectual property claims.

C. Microsoft’s Linux Patent Enforcement Program

In 2009, Microsoft filed a patent lawsuit against TomTom, makers of consumer GPS devices, accusing code in the Linux kernel of infringing certain patents of Microsoft, including three file management patents.41 The suit was settled very soon thereafter,

with payment of a license fee to Microsoft and a five-year patent

cross license between the parties. A joint press release called the

settlement “fully compliant with TomTom’s obligations under the

General Public License Version 2.”

TomTom also agreed to “remove from its products the functionality related to two file

management systems patents” over a two-year period.

The patent claims asserted in the TomTom case are also the

basis of a string of enforcement activities by Microsoft, which has

clearly identified Linux as a competitive threat. Virtually all the

enforcement has been in the consumer electronics space: I-O Data,

Amazon.com, Novell, Brother International Corp, Fuji Xerox Co.

Ltd., Kyocera Mita Corp., LG Electronics, and Samsung Electronics

Co. Ltd.

Although these claims are not strictly related to open source

licensing—the outbound license of the accused product being

irrelevant to the central patent infringement questions of

infringement and validity—they bear upon open source licensing

in two ways. First, Microsoft’s form of settlement was tailored to

conform to the defendant’s licensing of the accused software under

GPL version 2, but not GPL version 3, which contains provisions

that would contradict the terms of most such settlement

agreements.

Second, Microsoft is probably one of the very few

technology product companies that does not distribute Linux—if it

did, it might have significant challenges enforcing patents that read

on GPL code.

42. Press Release, Microsoft Corporation, Microsoft and TomTom Settle Patent


43. Id.

44. See the terms of paragraphs five, six, and seven of GPLv3 Section 11—the so-

called “anti-Microsoft” and “anti-Novell” provisions. GNU Affero General Public License,

Version 3, GNU OPERATING SYSTEM (Nov. 19, 2007), http://www.gnu.org/licenses/

agpl-3.0.html.

45. The topic of what patent rights are licensed under GPLv2 is a subject of

controversy—or better said, mystery—but is beyond the scope of this paper. For more

information, see Adam Pugh & Laura A. Majerus, Potential Defenses of Implied Patent


publications/ip/potential_defenses.pdf.

D. Oracle America v. Google (2010–present)

In 2010, Oracle, after having acquired Sun Microsystems (and renaming it Oracle America, Inc.), filed suit alleging that Google’s Android mobile platform infringed certain patents of Oracle America, as well as copyrights in Oracle’s Java platform. This suit is ongoing.

E. Penrose Trademark Dispute (2011)

A complaint was filed against Red Hat in the Northern District of California on May 6, 2011, alleging various claims, including a request to cancel a trademark registration. According to the complaint, Alex Karasulu, founder of the Apache Directory Server Project, set up a domain at www.safehaus.org to provide an ecosystem for open source software components related to directory and security infrastructure. Karasulu was approached by Jim Yang about the development of open source virtual directory software and Karasulu offered to develop the software as a project for Safehaus. Karasulu used the name “Penrose” for the virtual directory software project. The initial version of the Penrose software was released on May 23, 2005. On March 13, 2008, Yang filed an application to register the trademark Penrose for software


50. Id. at ¶¶ 10–15.
through a company he owned called Identyx, Inc. Yang subsequently sold Indentyx to Red Hat. The complaint alleges that in the trademark application, Yang misrepresented the facts underlyng the first use of the mark and failed to acknowledge prior use and ownership by Safehaus, and that Red Hat knew statements made in the trademark application by Identyx were false because of information received by Red Hat in the due diligence process for the acquisition. Based on the above allegations, the complaint alleged various claims and asks the court to declare the trademark registration invalid.

F. AVM v. Cybits (2011 – current)

AVM Computersysteme Vertriebs GmbH (AVM) v. Cybits AG (Cybits), an action brought in Germany, involved a dispute between two GPL licensees. AVM was in the business of distributing its Fritz!Box router, which included the Linux kernel. Cybit was in the business of distributing its Surf-Sitter software, which enabled customers to change the firmware in AVM’s routers to set time-related and web-filter controls for internet access. Both companies use the applications Memory Technology Device (MTD) and iptables/netfilter, which are included in the Linux kernel. AVM sued Cybits, claiming infringement of copyright in AVM’s router software, as well as trademark infringement. AVM aimed to prevent Cybit’s software from modifying the kernel and installing it back on the DSL terminal.

In late 2011, The Regional Court of Berlin rejected AVM’s claims, holding that AVM had no basis to prevent Cybit’s software from modifying the firmware of AVM’s routers, because the router software was licensed from third parties under GPL. The court,

51. Id. at ¶ 27.
52. Id. at ¶ 56.
however, enjoined Cybit from distributing software that caused the router to display incorrect information about the connection and web-filtering settings. The one-month statutory time for appeal has passed and the written opinion is pending.

Harald Welte, prominent for his work with gpl-violations.org and one of the Linux Kernel’s developers, intervened in the case as a copyright owner and licensor of the software. Welte considered AVM’s actions a GPL violation because AVM was attempting to stop a third party from distributing a derivative work of software that was licensed to AVM under GPL. AVM’s use of legal process to prevent downstream modification would have constituted an prohibited additional restriction under GPL.

G. Other Open Source Related Cases

Several notable cases did not strictly involve open source licensing issues, but had an impact on perceptions of intellectual property risk in open source:


While this set of related cases was by far the most publicized in the open source world, the SCO cases were primarily breach of contract cases, and did not seek to enforce any open source license. In fact, IBM raised SCO’s breach of the GPL as a counterclaim, but this series of cases was resolved on different facts. A jury verdict in

55. Id.
57. Id.
April 2010 determined that SCO did not own the copyright in UNIX, all but killing SCO’s claims. The true end will be dismissal of SCO’s case against IBM, which was stayed pending the disposition of SCO’s bankruptcy, and which will in turn depend heavily on the result in the Novell suit. This case, while not exactly over, is in the process of dying a long, slow death.


MontaVista sued its competitor, Lineo, claiming Lineo was distributing software written by MontaVista with the copyright notices removed. The case was settled. The issue in this case—the stripping of notice—was not particular to open source.


Monotype sued Red Hat claiming copyright and trademark infringements. The suit was settled and in December 2003, the parties entered into a license agreement that provided Red Hat the right to distribute certain Monotype commercial fonts over a five-year period. The license cost Red Hat $500,000. This was not a suit to enforce any open source license; it was an infringement suit regarding proprietary software.


This case did not involve open source software, but is notable for its possible tension with *Jacobsen v. Katzer*. This case involved the creation by MDY of Glider, a “leveling bot,” for use in Blizzard’s World of Warcraft. MDY sold copies of this ‘bot to users, causing concerns for Blizzard. Blizzard added a provision to its terms of use for WoW prohibiting the use of ‘bots. This case was an action for declaratory judgment by MDY, claiming that its exploitation of the ‘bot did not infringe Blizzard’s copyright in the WoW software. The


63. MDY Indus., LLC v. Blizzard Entm’t., Inc., 629 F.3d 928 (9th Cir. 2010) (vacating district court’s permanent injunctions and remanding for further proceedings on tortious interference with contract claim).
lower court awarded damages for contributory copyright infringement, based on MDY’s customers’ use of the ‘bot.64 The Ninth Circuit reversed, stating that the violation of the ‘bot prohibition did not have a sufficient nexus to copyright to support a claim for infringement.65 In so ruling, it interpreted the prohibition as a covenant rather than a condition, citing relevant state law. (In contrast, the Federal Circuit in Jacobsen did not defer to state law, viewing the case as an intellectual property claim.)

5. Ffmpeg Trademark Dispute (2011).

In May of 2011, Måns Rullgård demanded that the FFmpeg project, which promulgates an audiovisual decoder licensed under GPL, cease using a diagonal-lined logo in which Rullgård claimed copyright ownership.66 According to Michael Niedermayer, a current administrator of FFmpeg, stated Rullgård previously helped administer FFmpeg and Rullgård now administers the Libav software fork of FFmpeg.67 FFmpeg replaced the logo with a newer version, using the same general shape with different shading and contours. FFmpeg posted an email suggesting that the claimant did not come up with the original shape, only a particular rendering of it.

65. MDY Indus., LLC v. Blizzard Entm’t., Inc., 629 F.3d 928 (9th Cir. 2010).
68. Posting of Michael Niedermayer, Copyright Claims about Material on Ffmpeg.org, http://comments.gmane.org/gmane.comp.video.ffmpeg.devel/12956 (Mar. 14, 2011, 13:33 CET) (“Last year we never managed to decide on a logo in time for LinuxTag. I’m hoping we might be able to do better this year, so I’ve made a couple of variants based on one of the ideas I liked best from last year’s discussions.”).
6. **Koha Trademark Dispute (Current).**

Koha, an open source project in New Zealand garnered publicity regarding a dispute that was erroneously reported as a patent and copyright dispute, when the core issue was one of trademark priority. But apparently the publicity worked, as the project, according to its own blog post, got many donations to a legal fund, and also pro bono representation. A deal is reportedly being brokered to assign the trademark to a non-profit representing the Koha community.

7. **Patent Trolls.**

There have been a number of suits by non-practicing entities that accuse open source software. These include for instance *IP Innovation LLC vs. Red Hat Inc.* (filed October 9, 2007, E.D. Texas), *Software Tree LLC v. Red Hat Inc.* (filed March 3, 2009, E.D. Texas), and *Bedrock Computer Technologies, LLC v. Softlayer Technologies, Inc.* (filed June 16, 2009, E.D. Texas). But these cases are not unique to the open source context; software patent troll cases abound in the technology industry.

V. **The Cast of Characters**

Open source claims are not like other intellectual property claims. They must be addressed differently. Treating them like ordinary intellectual property claims may lead an accused party to do exactly the wrong thing on a strategic level.

The object lesson of the cases described above is that we are in a time of transition. Open source claimants today come in two varieties: the advocates and the strategists. Of course, free software

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has always had its zealous advocates—it is, after all, a movement started for the greater good, based on the idea that access to software source code should be a techno-political right. The first claims brought in the area of open source enforcement were claims brought by advocates. Those efforts bore the clear fingerprints of advocacy, and focused on embarrassing the miscreants and demanding their compliance. This strategy meant that filing a lawsuit was a last resort. Most compliance disputes were resolved informally and without resort to legal process. Once legal process was filed, the threat of bad press was gone, so few claims resulted in lawsuits. The main goals were compliance and transparency. Although the early enforcement actions of the SFLC sometimes included monetary settlements, these were often characterized as a contribution to offset the cost of litigation—and rightly so, as compared to the average intellectual property dispute, the amounts involved were minimal. Settlements were announced publicly in greater detail than customary in intellectual property disputes.

This type of claimant includes:

- **Free Software Foundation.** The FSF stewards the GPL and runs the GNU project. Although it was originally involved in enforcement of GPL violations, most of its enforcement activities have now been taken over by SFLC.

- **Software Freedom Law Center.** This is a legal advocacy organization that represents pro bono clients, including FSF, in GPL enforcement and other free software law matters.

- **Software Freedom Conservancy.** This is a legal advocacy organization that provides services, including pro bono legal representation, for certain open source projects, and has recently taken the lead on enforcement for Busybox.

- **gpl-violations.org.** As described above, this organization has brought various enforcement actions in Europe.

- **Moglen Ravicher LLC.** This is a private law firm, which represents those who do not qualify for pro bono service of SFLC. Eben Moglen is the former General Counsel of FSF (and a Columbia law professor) and Dan Ravicher is the Legal Director of SFLC. (To date this firm has filed no lawsuits.)

- Individual authors acting via any of the above.
As we move into the “teens,” a new kind of claimant is emerging—the strategic claimant—who has most of the same goals as other intellectual property claimants, and sometimes is both a copyright and patent claimant. Strategic plaintiffs are building on the foundation of *Jacobson v. Katzer* to enforce their rights in open source software via intellectual property disputes. And like other intellectual property disputes prosecuted by strategic plaintiffs, they tend to be the battles of titans. That kind of plaintiff wants a strategic edge, whether delaying a competing product’s release, embarrassing a competitor, or the extraction of money to de-fund a competitor’s development plans. Notably, however, this kind of claimant wants damages or remedies for past infringement, and not merely compliance going forward. Settlements tend to be slower and more confidential.

In between the advocates and the strategists are individual authors who are not affiliated with an advocacy organization. Many are academics who use open source licenses because of university policy or hobbyists who write open source software as a resume item. They often are not represented by counsel at all—eschewing the pure political motivation of the advocates and therefore not sharing their goals. These authors seldom make formal claims, and often demand modest license fees to grant an alternative license that would obviate the need to comply with open source requirements. (Advocates, on the other hand, would usually refuse to agree to other licenses.) Obviously, the claims of these individuals are best handled via a quick and confidential settlement. Attorneys handling such claims must be mindful of ethical issues relating to interaction with unrepresented parties, and are best advised to keep the discussion straightforward and the documents short. Adding complex releases, indemnities, and patent grants will usually backfire.

The possibility still exists that such authors will become “copyright trolls.” As open source software becomes ever more pervasive, and some companies still have inadequate controls to

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74. Of course, the ethical rule concerns represented parties. See Model Rules of Prof’l Conduct R 4.2 (2011). However, unrepresented parties can easily engage representation, and the client may not be aware of the effect of the rule. In other words, if you are negotiating a license with someone, and he engages counsel to review the license agreement you have proposed, you can no longer talk to him directly—and if he calls you, you must tell him so.
avoid unintended use of open source, it is quite possible that a popular bit of code could become the subject of “submarine” copyright claims.

VI. What to Do If You Receive a Claim

Best practices include, immediately and foremost, an assessment of the type of claimant facing you. Advocates primarily want compliance, and tend to be tolerant of foot-fouls.75 A sincere, timely and robust compliance program will often meet their demands, though they may require compliance with all open source requirements (whether they represent the authors of it or not) before settling a claim. But strategic plaintiffs can draw you into a world of complex and unsettled open source law, in addition to the typical, painful process of intellectual property litigation.

If you receive an open source claim, it is crucial to act on it quickly. That may sound simple, but can be unexpectedly difficult, because not all open source claims are made through formal channels. Companies should train their technical employees to recognize complaints and take them seriously. Complaints often come in the form of emails sent to technical employees, who, typically, represent the company’s face to the software development community. Claimants may not be aware that there are accepted formal means of making claims, such as service of process. In contrast, a traditional intellectual property complaint will often come to a legal or management representative, where it is easy to recognize as legal claim, or via a formal complaint. In addition, technical employees should be trained to react immediately to any request for source code made pursuant to a copyleft license like GPL. If that request is not timely answered, or the company demands fees to fulfill it, a formal open source claim is likely to follow soon. Of course, only a downstream recipient has the right to make such a request, and only the upstream author that has the right to make a legal claim.76 So in truth, these are not infringement

76. The conditions in a license like GPL run downstream only. Recipients are not third party beneficiaries of the GPL; those who take the position that the GPL is not a contract would say that there can be no third party beneficiary under a conditional license.
claims. However, recipients whose demands for source code are unmet often complain to advocacy organizations or the authors, who do have the right to bring a claim.

Because at this time advocates make up most claimants, quick action to remedy compliance issues or answer questions can often avoid legal process entirely. SFLC or SFC are not quick to file lawsuits, and first attempt to gain compliance via informal actions.

In truth, claims from advocates are the easiest to handle. The goals and actions of advocates are predictable. The emphasis is on compliance, attribution, and only secondarily on damages. Injunctive action is usually not on the table at all. Contrast strategists, who would generally prefer injunction and damages over compliance, because it serves their goal to disrupt the market for a competitive product.

Strategic plaintiffs may also make multiple claims, only one of which is copyright infringement. Those who receive such claims should consider the special legal issues that arise in open source claims. As a baseline, any lawsuit that involves open source licensing is likely to touch upon novel issues of law, as well as draw significant attention from the press and the free software community.

VII. Best Practices

In summary, here are the points to remember about open source litigation and disputes.

- The landscape of enforcement is in flux. For current developments, see the “Copyleft Currents” column in NEW MATTER. Be alert for an increase in private claimants.
- Take open source claims seriously, even if they are made informally or by unrepresented parties. Train your technical and helpdesk staff to recognize claims.
- If you receive a claim, act timely. Ignoring open source advocates who complain about your practices, formally or informally, is not an effective strategy.
- Don’t treat open source claims like other IP claims. The path to resolution is different. Open source disputes can be

resolved more quickly and economically than other intellectual property disputes, if you understand the landscape.