



## Software Freedom Law Center

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Greetings,

I represent the Free Software Foundation (FSF) and the Apache Software Foundation (Apache). I write, with their permission, to convey the content of legal opinions given our clients by the Software Freedom Law Center (SFLC) under my direction. The Software Freedom Law Center has examined whether there are any legal barriers to the use of the OpenDocument Format (ODF) in free and open source software arising from the standardization process. We have reviewed only publicly-available material; in order to reach conclusions freely available to all interested parties, we have relied upon no information obtained under attorney-client privilege in the conduct of this inquiry. We have independently verified all statements of fact material to our conclusions. Certain additional reservations concerning this opinion are set forth below. On the factual basis described, and subject to reservations, it is our opinion that ODF, as standardized and licensed by the Organization for the Advancement of Structured Information (OASIS), is free of legal encumbrances that would prevent its use in free and open source software, as distributed under licenses authored by Apache and the FSF.

### History of ODF

ODF was first implemented in OpenOffice 2.0, replacing the OpenOffice.org XML format used in version 1.0.<sup>1</sup> OpenOffice.org is in turn derived from StarOffice, a proprietary office suite originally developed by the German company StarDivision.<sup>2</sup> In 1999, StarOffice became the property of Sun Microsystems when Sun acquired StarDivision.<sup>3</sup> ODF was arguably first freed (at least with respect to any patented elements shared with StarOffice) in 2000, when Sun released the StarOffice source code under the GNU Lesser General Public License (LGPL), inaugurating the OpenOffice.org project.<sup>4</sup> The LGPL required Sun to license any patents covering ODF in a manner “consistent with the full freedom of use specified in [the LGPL].”<sup>5</sup>

In 2002, Sun called for formalization of ODF as “an open, XML-based file format specification for office applications” via OASIS’s standard-setting process.<sup>6</sup> Subsequently, concern arose within the free software community regarding OASIS’s revised patent

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<sup>1</sup>OpenOffice.org, The XML Project, <http://xml.openoffice.org> (last visited June 23, 2006).

<sup>2</sup>Stephen Shankland, *Sun buying Microsoft Office Competitor*, NEWS.COM, Aug. 20, 1999, <http://news.com.com/2100-1001-230096.html>; Press Release, Sun Microsystems, Inc., Sun Microsystems Open Sources StarOffice Technology (July 19, 2000), available at <http://www.sun.com/smi/Press/sunflash/2000-07/sunflash.20000719.1.xml>.

<sup>3</sup>Shankland, *supra* note 2.

<sup>4</sup>See Press Release, Sun Microsystems, Inc., Sun Microsystems Open Sources StarOffice Technology, *supra* note 2. The code was simultaneously licensed under the Sun Industry Standards Source License, but that license has since been abandoned, and OpenOffice.org is now licensed only under the LGPL. Steven J. Vaughan-Nichols, *Sun Changes OpenOffice.org Licensing*, EWEK.COM, Sept. 6, 2005, <http://www.eweek.com/article2/0,1895,1855892,00.asp>.

<sup>5</sup>GNU Lesser General Public License, Version 2.1, Preamble, <http://www.gnu.org/licenses/lgpl.html> (last visited June 21, 2006).

<sup>6</sup>E-mail from Karl Best, Vice President, OASIS, to OASIS members (Nov. 4, 2004), available at <http://lists.oasis-open.org/archives/tc-announce/200211/msg00001.html>.

policy, which permits essential patent claims practiced in some OASIS standards to be licensed under terms potentially at odds with free software licenses.<sup>7</sup> While the existence of technological standards that are incompatible with free software is still of great concern, OASIS ODF is not such a standard.

### OASIS Standardization Process

OASIS standards are developed by collaborative bodies termed Technical Committees.<sup>8</sup> Each OASIS standard necessitates the formation of a new committee, comprised primarily of OASIS members interested in the standard.

Committee members contribute technology and patents to standards according to OASIS's Intellectual Property Rights (IPR) Policy. This Policy defines the rights and obligations of committee members with regard to any of their patents, trademarks or copyrights which are needed to implement the standard.

According to the IPR Policy, contributing committee members must “grant to any . . . party: a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant)” to patent claims incorporated in any of its contributions which are essential to implementing the standard.<sup>9</sup> The license of any contribution may “include term[s] requiring the Licensee to grant a reciprocal license to its Essential Claims (if any) covering the same OASIS Committee Specification or OASIS Standard.... [and] providing that such license may be suspended with respect to the Licensee if that Licensee first sues the Obligated Party for infringement by the Obligated Party of any of the Licensee's Essential Claims covering the same OASIS Committee Specification or OASIS Standard.”<sup>10</sup> The Policy also ensures that all standards are unencumbered by copyright and trademark claims.<sup>11</sup>

The IPR Policy defines three modes in which standards are developed. Each mode imposes a different set of licensing obligations upon committee members. Each Technical Committee charter specifies in which mode the committee will operate, and once specified it cannot be changed.<sup>12</sup> The three licensing modes are:

**RAND [Reasonable and Non-Discriminatory]**—allows restrictive licensing of the committee members' technology required to implement the standard. Contributors to RAND mode standards may impose upon licensees any “fair, reasonable,

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<sup>7</sup>See The Free Software Foundation, A Call to Action in OASIS, <http://www.fsf.org/news/oasis.html> (last visited June 21, 2006).

<sup>8</sup>See OASIS, OASIS INTELLECTUAL PROPERTY RIGHTS POLICY § 2 (2005) [hereinafter OASIS IPR POLICY], available at <http://www.oasis-open.org/who/intellectualproperty.pdf>.

<sup>9</sup>See *id.* at §§ 10.1, 10.2.1.

<sup>10</sup>See *id.*

<sup>11</sup>*Id.* at §§ 5.2, 5.3.

<sup>12</sup>*Id.* at § 4. If a committee determines that the mode in its charter is unsatisfactory, its only recourse is recharter. OASIS, GOVERNING THE TECHNICAL COMMITTEE PROCESS § 2.12 (2005), available at [http://www.oasis-open.org/committees/process\\_2005\\_08\\_09.pdf](http://www.oasis-open.org/committees/process_2005_08_09.pdf).

and non-discriminatory” terms, including royalty fees, consistent with the requirement that the license be “nonexclusive, worldwide, non-sublicensable, [and] perpetual.”<sup>13</sup>

**RF [Royalty-Free] on RAND Terms**—is identical to RAND mode, except that contributors may not require royalty payments of licensees.<sup>14</sup>

**RF on Limited Terms**—provides contributors the least ability to set license terms, and allows the most freedom to projects that want to implement the standard. It not only prohibits contributors from extracting royalty fees from users of the standard, but also from “impos[ing] any further conditions or restrictions... on the use of any technology or intellectual property rights, or other restrictions on behavior of the Licensee” apart from the reciprocal license and patent reciprocity terms quoted *supra*. The only other terms left to contributors’ discretion are “reasonable, customary terms relating to operation or maintenance of the license relationship, including... choice of law and dispute resolution.”<sup>15</sup>

## ODF Standardization

When first chartered, the ODF committee operated according to a now-superseded policy, the terms of which resembled the RAND mode of the present IPR Policy.<sup>16</sup> However, in February of 2005, the ODF committee transitioned to the RF on Limited Terms IPR mode. This was done under a one-time option exercised by majority vote according to the IPR Transition Policy, which was instituted concurrently with the new IPR Policy.<sup>17</sup>

As a result of the transition, ODF committee members<sup>18</sup> must grant to ODF licensees a license to any “Essential Claims” (including patents) necessary to implement the standard, free of royalties and other conditions unrelated “to operation or maintenance of the license relationship.”<sup>19</sup> This irrevocable obligation<sup>20</sup> attached also to all unidentified

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<sup>13</sup> See *id.* at § 10.1.

<sup>14</sup> See *id.* at §§ 10.2.1, 10.2.2.

<sup>15</sup> See *id.* at § 10.2.3.

<sup>16</sup> See OASIS, LEGACY OASIS INTELLECTUAL PROPERTY RIGHTS (IPR) POLICY §3.2 (2000) [hereinafter LEGACY IPR POLICY], available at [http://www.oasis-open.org/who/ipr/intellectual\\_property\\_2000-1-13.php](http://www.oasis-open.org/who/ipr/intellectual_property_2000-1-13.php).

<sup>17</sup> E-mail from Mary McRae, Technical Committee Administrator, OASIS, to OASIS OpenDocument Format Technical Committee (Jan. 31, 2006); OASIS, OASIS INTELLECTUAL PROPERTY RIGHTS (IPR) TRANSITION POLICY 1 (2005), [http://www.oasis-open.org/who/ipr/transition\\_policy\\_02\\_05.pdf](http://www.oasis-open.org/who/ipr/transition_policy_02_05.pdf).

<sup>18</sup> The ODF committee included Adobe Systems, IBM, Intel Corporation, Novell, Sun Microsystems, and The Open Document Foundation, among others. A full list of the ODF committee are listed at Obligated Members, <http://www.oasis-open.org/committees/daycount/tc/office.html> (last visited June 20, 2006), though it should be noted that this list “may lag or vary from actual participation, so it is subject to correction by definitive documentation.”

<sup>19</sup> OASIS INTELLECTUAL PROPERTY RIGHTS POLICY, *supra* note 1, at § 10.2.3.

<sup>20</sup> Contributions by OASIS committee members are irrevocable. Though contributors may withdraw from the committee, they may not thereby escape their obligation to license prior contributions. See OASIS IPR POLICY, *supra* note 8, at § 11.1.

Essential Claims held by the Technical Committee members, including non-contributing members.<sup>21</sup>

## Licensing under the Standard

Public records of the standardization process show that Sun was the only Technical Committee member that submitted a statement to OASIS regarding its Essential Claims.<sup>22</sup> With regard to the licensing of Sun's patents, there are two provisions about which questions have been raised. The first is a defensive suspension clause,<sup>23</sup> while the second, already noted, requires a reciprocal license, or covenant not to assert, all licensees' essential claims.<sup>24</sup> The intended effect of the two provisions is identical: they both condition access to the licensor's essential claims on non-assertion of the licensee's. This purpose is in no way incompatible with free or open source licensing of any implementation in general. The defensive suspension right reserved by Sun does not exceed what is permitted to contributors to the Apache Software Foundation's works for release under the Apache Software License.<sup>25</sup>

Even if Sun required developers to accept its license, which has not been the case, that license does not inhibit any exercise of rights conveyed by the GPL, and hence does not trigger section 7 of the GPL. To prevent subsequent downstream reliance on rights not in fact conveyed, Section 7 provides that if conditions are "imposed on" licensees such that they cannot actually release to their distributees all the rights under copyright law covered by the GPL, then they cannot use the GPL at all. Sun's requirement that parties seeking to benefit from non-assertion of Sun's patent claims should not assert their own does not affect the exercise of rights under GPL, and can accordingly have no effect in "triggering" Section 7.

## Reservations and Limitations of Opinion

Patent-holders not qualifying as Obligated Members of the OASIS Technical Committee

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<sup>21</sup>The OASIS IPR Policy defines two types of obligations which bind members to the policy—a "Contribution Obligation" and a "Participation Obligation." Id. at §§ 9.1–9.2. The former applies to claims incorporated in contributed technology, the latter to claims held by any member of the OASIS Technical Committee that produced the specification, as long as that member "has been on... the [committee] for a total of sixty (60) calendar days," and "is on... such [committee] after a period of seven (7) calendar days" after a draft specification is approved by the committee. Id. See note 18, *supra*, for a full-list of Obligated Members.

<sup>22</sup>All such statements are posted by OASIS on the IPR Statement section of the Technical Committee's webpage. See OpenDocument Format Technical Committee IPR Statement, <http://www.oasis-open.org/committees/office/ipr.php> (last visited June 26, 2006).

<sup>23</sup>Sun reserved the right to "assert or enforce any or all of its patent rights against any individual, corporation or other entity that asserts, threatens or seeks at any time to enforce its own or another party's U.S. or foreign patents or patent rights against any OpenDocument Implementation." See Sun OpenDocument Patent Statement, submitted by Sun Microsystems, Inc., September 29, 2005, *available at* <http://www.oasis-open.org/committees/office/ipr.php>; Statement regarding IPR, submitted by Sun Microsystems, 11 December 2002, *available at* <http://www.oasis-open.org/committees/office/ipr.php>. Defensive suspension provisions are authorized by the Policy See *supra* note 1 at § 10.2.1.

<sup>24</sup>Statement regarding IPR, *supra* note 23.

<sup>25</sup>The Apache Individual and Corporate Contributor License Agreements state that, "If any entity institutes patent litigation against You or any other entity... alleging that your Contribution, or the Work to which you have contributed, constitutes direct or contributory patent infringement, then any patent licenses granted to that entity under this Agreement for that Contribution or Work shall terminate as of the date such litigation is filed." Software Grant and Corporate Contributor License Agreement, at § 3, *available at* <http://www.apache.org/licenses/cla-corporate.txt> (last visited June 27, 2006); Individual Contributor License Agreement, at § 3, *available at* <http://www.apache.org/licenses/icla.pdf> (last visited June 27, 2006). Once the license is so terminated, nothing in it prevents the licensor from asserting any patent claims it has.

may in future assert essential claims. Obligated Members could in future assert non-essential claims. Neither of these classes of legal risk to implementors of ODF is covered by this opinion. Programs with additional functionality beyond the implementation of the ODF standard, including programs with office suite functionality, may in fact practice licensed essential claims outside the field of use restriction of one or more licenses. This opinion expresses no view of the resulting legal rights and liabilities. This opinion expresses no view of the validity of any patent, nor whether any patent is infringed by ODF or by any implementation thereof. No patent search has been conducted in connection with the preparation of this opinion.

## **Conclusion**

On the basis of the facts presented, for the reasons given, and with the reservations and limitations noted, it is our opinion that:

1. Under the relevant OASIS patent policy, all Essential Claims held by OASIS Technical Committee Obligated Members are available to all implementors of ODF on terms compatible with free and open source software licenses.
2. Sun's license terms for access to its Essential Claims are fully compatible with free and open source software licensing.
  - Sun's terms are compatible with contribution and licensing under the policies and license of the Apache Software Foundation.
  - Sun's terms are not in conflict with Section 7 of the Free Software Foundation's GNU General Public License, and are not otherwise incompatible with the GPL.

We are authorized to represent our clients' agreement with the opinion here stated.

Very truly yours,

A handwritten signature in black ink, appearing to read "Eben Moglen", with a stylized flourish at the end.

Eben Moglen