Opinion

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Preamble

I am a lawyer practising in Italy and admitted to the Bar of Milan. I have more than a decennial experience in dealing with technology transfer agreements and I am since 2004 counsel to the Free Software Foundation Europe, and as such I have extensive experience in dealing with matters concerning Free and Open Source Software. I am also now General Counsel of the Free Software Foundation Europe, member of the Core Team of the Freedom Task Force and recommended by the same as lawyer expert in open source matters. I have been consulting the Software Freedom Law Center in the preparation of Version 3 of the GNU GPL. I am also retained by Fluendo Multimedia Group to assist and advise it for licensing and technology transfer matters on a rolling basis.
I have been requested by my Clients Fluendo Multimedia Group to assess what are the consequences for a distributor of a media codec in software form licensed under the conditions of the GNU Lesser General Public License ("GNU LGPL") from also taking a license under patent rights from the patent holder of the technology reading on the standard implemented in the codec. In particular, whether the distribution of the software codec is likely to infringe either the GNU LGPL or the patent license, or both.

Discussion

The GNU LGPL is a Free (Open Source) Software license ("FOSS" license), which is characterised by some *copyleft* provisions which impose that any distribution of the software or derivatives of the same (with some limitations) must be always made under the same license, or – in certain cases when indicated by the initial developer – under later versions of the same license. Attempting to change the licensing conditions by a distributor, also by adding restrictions or other conditions for further distribution of the software compared to those imposed by the GNU LGPL, is a copyright infringement and would terminate the license (Section 8).
Conversely, the patent licensed for multimedia standards about which I have experience[1], invariably demand – among others – that the licensee reports the number of copies sold of an implementation of the patented technology and that imposes distribution conditions that prohibit the further distribution. Sometimes, as in the Microsoft Windows Media Format, the licensing conditions expressly prohibit that the product implementing the licensed technology is licensed under "excluded licenses", which included FOSS licenses.
Section 11 of the GNU LGPL (version 2[2]) expressly provides that "11. *If, as a consequence of a court judgment or allegation of patent infringement or for any other reason (not limited to patent issues),* ***conditions*** *are imposed on you (whether by court order, agreement or otherwise) that* ***contradict*** *the conditions of this License,* ***they do not excuse*** *you from the conditions of this License. If* ***you cannot*** *distribute so as to satisfy simultaneously your obligations under this License and any other pertinent obligations, then as a consequence you may not distribute the Library at all. For example,* ***if a patent license would not permit royalty-free redistribution*** *of the Library by* ***all those who receive copies directly or indirectly through you****, then the only way you could satisfy both it and this License would be to* ***refrain*** *entirely from distribution of the Library*." (emphasis added).

1 This includes: Mp3; Mpeg 2; Mpeg 4 (AAV, Video, h.264, Windows Media); Dolby AC3.
2 Version 3 is even more drastic in the possibility to impose more restrictive conditions

Conclusions

Section 11 seems utterly clear in that it is impossible, for anybody who distributes software under the GNU LGPL v.2 conditions, to impose any different and more restrictive conditions compared to the conditions upon which the licensee has received the software.
There appears not to be any way to comply both with the conditions of the license that prohibits any further restriction in the circulation of the software and the usual restriction imposed by the various licensing authorities in the further redistribution of the licensed products by the end users.
On the other end, the very attempt to implement a patented licensed technology in a FOSS licensing condition is frequently an outright violation of the patented licensing agreement, even in the event that the FOSS license is purported to be limited to copyright conditions and separate licensing conditions are used for patents. If a distributor attempted to separate the end user patent license (or in other words the conditions upon which the end user can legally use the software under patent rights) from the copyright conditions, this would very likely constitute a violation of both the upstream patent license and of the FOSS license. GNU LGPL is no exception to this general rule.
Although we have no reported court decisions that expressly rule on this particular case, we have a small number of decisions which hold the conditions of licensing contained in FOSS licenses as being copyright conditions and enforceable, both in contract and in copyright[3]. Therefore a violation of the GNU LGPL would expose the violator to a copyright infringement and would give cause of action to any copyright holder of the software whose license has been violated.

In my opinion, there is only one way to comply both with GNU (L)GPL – and other copyleft FOSS licenses – and software patents, other than avoiding altogether to distribute the code, and it is to embed all patented technology in a clearly separated part of the software, in a way which would not amount to making the separate part a derivative of the main software. This is commonly referred to as the “kernel exception”: while said name is largely misleading, the underlying theory is relatively safe. Two separate, modular products are not derivatives of each other when they are functionally separate and communicate through standard APIs[4]. The separated part, which is commonly called “a plug-in” or a “module”, can therefore be put under a proprietary software license, compliant with the patent licensing requirements, and distributed as such. This is by the way the solution I have advised Fluendo. A full discussion of this theory, which should expand on subtleties ad distinctions, would be out of the scope of this opinion.

This is my opinion according to the generalities of the case as submitted to my attention and it is possible that some of the conclusions could change under better knowledge of the details.

3 The most recent case in this line is of the Court of Appeals for the USA Federal Circuit Jacobsen vs. Katzer, on which I have reported on my blog website at http://www.piana.eu/jacobsen,

4 API = Application Programming Interfaces