

# Why a Patent License is Necessarily Implied ~~But a~~ Trademark License ~~Is Not~~

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**And So Is A**

**(and as long as we're not  
talking about exhaustion)**



# FOSDEM17

- General
- Description
- Links
- Files
- Resources
- Feedback

- Person
- Create Event
- Events
- Logout

## Submission notes

## General

<b>Event title</b>	<input type="text" value="The Legal Theory of Inbound-Outbound Licensing"/>
<b>Subtitle of the event</b>	<input type="text" value="Implied licensing in copyright"/>
<b>Event state</b>	undecided
<b>Progress</b>	new
<b>Submission of paper for proceedings</b>	unknown ▼
<b>Submission of presentation slides</b>	unknown ▼
<b>Language used for presentation</b>	▼
<b>Track</b>	▼
<b>Event type</b>	▼

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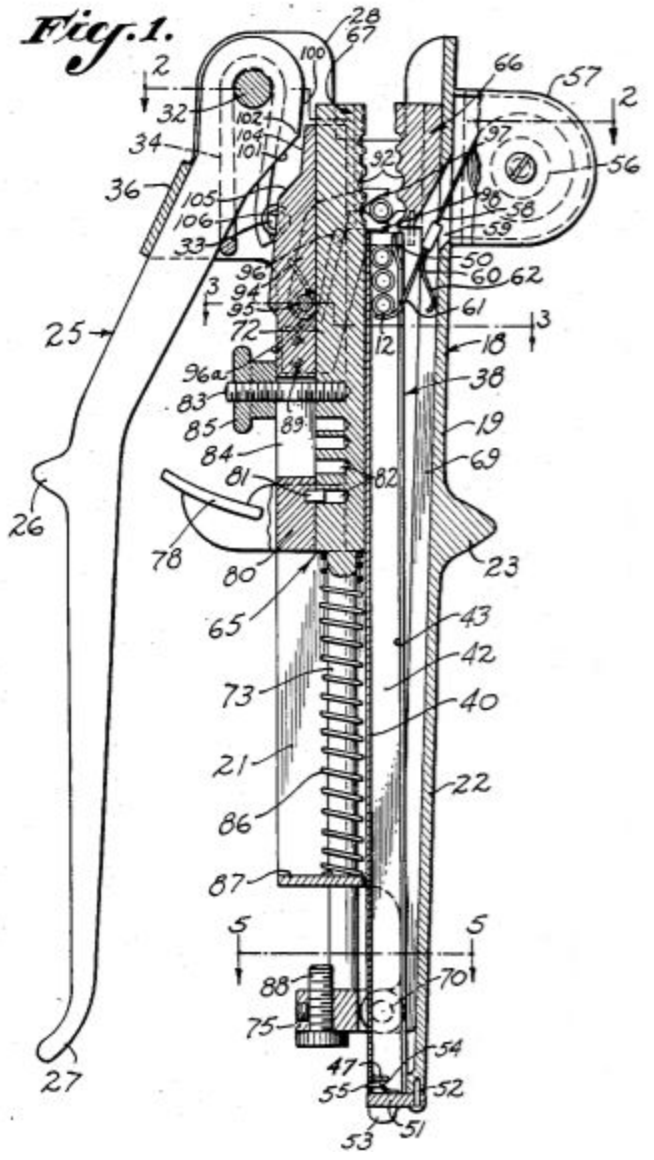
**Disclaimer**

“Any language used by the owner of the patent, or any conduct on his part exhibited to another from which that other may properly infer that the owner consents to his use of the patent in making or using it, or selling it, upon which the other acts, constitutes a license and a defense to an action .....

*De Forest Radio Tel. Co. v. United States*, 273 U.S. 236, 241, 71 L. Ed. 625, 47 S. Ct. 366 (1927).

# I'll categorize it as two types

- Agreement about something, but it is silent on the right in question
- Conduct



Sleeve Compressing Tool  
 Pat. No. 2,612,932

**“A grantor of a property right or interest cannot derogate from the right granted by his own subsequent acts”**

# Rights granted in FOSS licenses

- “Redistribut[e] and use in source or binary form ... with or without modification”
- “to deal in the Software ... use, copy, modify, merge, publish, distribute, sublicense, and/or sell”
- “copy, distribute and modify” the Program



# Theory of implied patent license for FOSS says you can't do these things without a patent license too

- Exactly what patents (after acquired)?  
Who knows.
- How much can you modify the software?  
Who knows.



# Rights granted

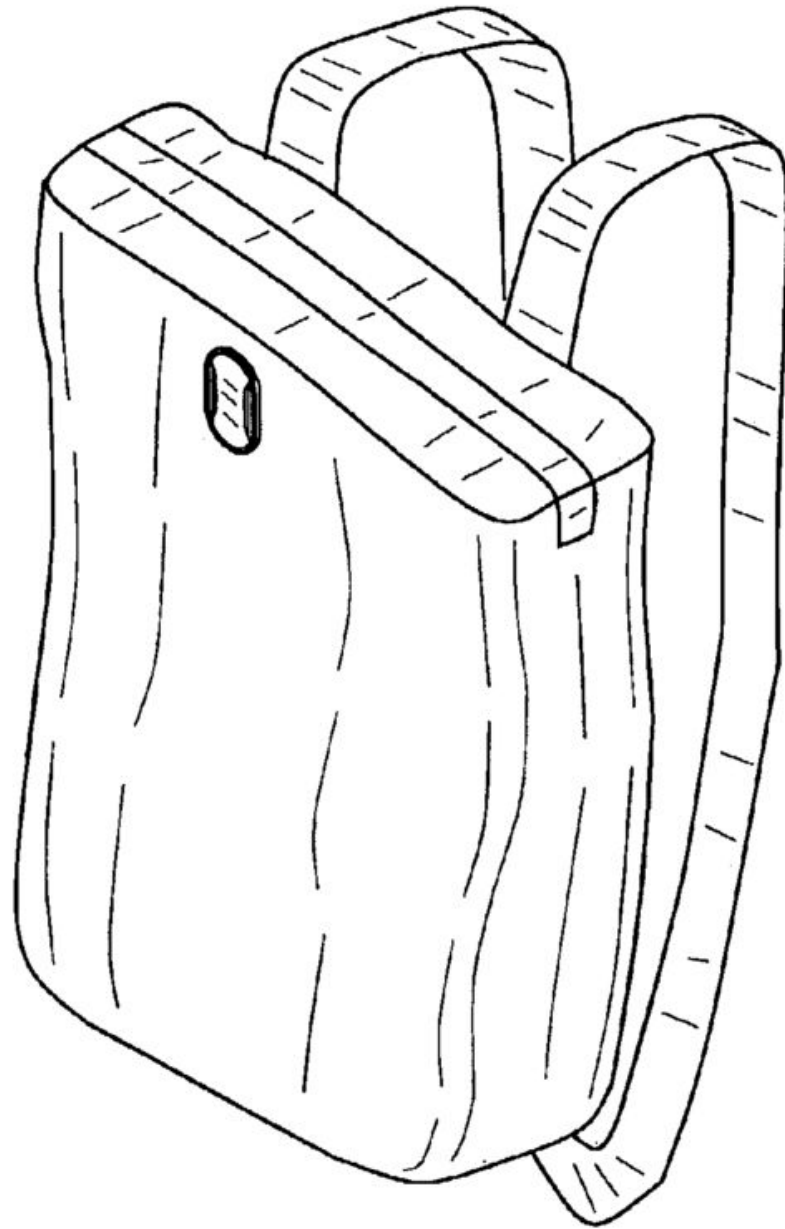
- “Redistribut[e] and use in source or binary *form* ... with or without modification”
- “to deal in the *Software* ... use, copy, modify, merge, publish, distribute, sublicense, and/or sell”
- “copy, distribute and modify” the *Program*

**You can do all of these things  
without the trademark (maybe?)**

I say “yes” because the interest  
protected is different  
function vs. reputation

*“assigns ... all worldwide right, title and interest in and to the artwork ....”*

Dry CD port for a backpack or bag  
Pat. No. 6,889,883



And if I'm wrong, is "control" a silver bullet?

“Permission to use the marks along with the exercise of reasonable control over such use can lead to the conclusion that an implied license existed even where no written agreement was made.”



All the cases are where the plaintiff needed to prove there *was* an implied license, not a claim that none was granted

Yeah, so there's exhaustion.  
I dunno.

**Exhaustion is for existing goods, so  
it probably doesn't apply here.**



# FOSSmarks

A practical guide to understanding trademarks in the context of Free and Open Source Software projects.

## Trademarks and Free Software

Trademarks and FOSS are not contradictory; instead, the trademark is a legal tool that is strongly aligned with FOSS principles. A trademark is an assurance that the recipient of the goods or services is receiving a product of known qualities. Controlling how the trademark is used protects the community and its software, by preventing its use in ways that are harmful to the reputation of the community or the software. This is not a theoretical problem, it happens [fairly often](#).

It may also be the case that the confusion isn't intentional wrongdoing, but a matter of differing views causing a fork. In that case, if both were to use the same trademark for the two projects, users wouldn't be able to sort out which was which.

## References:

- Anna Haapanen, “Free and Open Source Software & the Mystery of Software Patent Licenses,” 7 Int’l Free and Open Source Software Law Rev. 1 (2015) DOI: 10.5003/ifosslr.v7i1.107
- Joe Mutschelknaus, “Spillover Effect: Investigating Patent Implications to Open-Source Software Copyright Licensing, 19 Fed. Cir. B.J. 409 (2009-2010)
- Adam Pugh and Laura A. Majerus, Potential Defenses of Implied Patent License Under the GPL (Oct. 31, 2006)

*The End*