
The Patent Commons Project

A DEVELOPER'S GUIDE TO USING THE COMMONS

Developers in the open source community and others may use patents pledged to the Patent Commons in reliance on the pledges and covenants made (“Commitments”), provided they adhere to the terms and conditions of the relevant Commitments. The following guidelines provide a starting point for developers and others interested in using the Patent Commons.¹ An example of one possible use of a pledged patent is described in Appendix A.

Guideline 1: Developers need to read carefully the terms of each Commitment on which they intend to rely, in order to understand the terms and conditions on which permission is being granted to make, use or sell software implementing the pledged technology. Particular attention should be paid to how and when the covenant not to sue can be terminated. Each Commitment is different. If uncertain about the terms and conditions, developers may want to consider contacting the individual, company or university who made the Commitment.

Guideline 2: Developers should understand how the patented technology they use differs from any patented technology disclosed as a Secondary Reference in the patent. Generally, the more that is known about a patented technology disclosed as a Secondary Reference, the higher the amount of damages that can be awarded for infringement. A formal, competent legal opinion is one way to distinguish technology from that disclosed in a Secondary Reference.

The risk associated with making, using or selling technology described as a Secondary Reference spans a continuum, as illustrated in Figure 1. A Secondary Reference that merely discloses the title of a patent, the name of the inventor and the date of invention (e.g., a “References Cited” patent) does not tell the developer how to practice or implement the technology claimed in that reference. The risk level for enhanced damages associated with practicing that technology, without knowing anything more, is quite low.

In contrast, a Secondary Reference that describes how to practice or implement patented technology (e.g., a prior art patent), if known to the developer, increases the risk of enhanced damages. For example, a prior art patent might be disclosed in the section of the patent titled “Background of the invention” or “Detailed description of the invention,” and might take the following form:

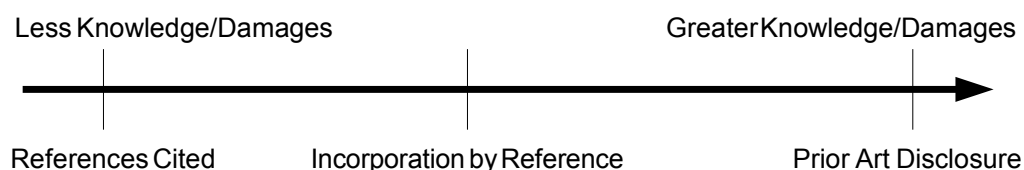
¹ As with any legal arrangement, it is a good idea to consult with your own legal adviser before relying on the Commitments. Please refer to *Understanding Patent Pledges: An Overview of Legal Considerations*, published at www.patentcommons.org, for information about the legal foundation on which Commitments rest, how they operate, and some of the legal risks associated with patents.

A DEVELOPER'S GUIDE TO USING THE COMMONS

“U.S. Pat. No. 1,234,567 teaches the static analysis of potential computer viruses, by running them in an environment where a number of “test files” are available for infection. U.S. Pat. Nos. 2,345,678 and 3,456,789 teach the use of emulation in the analysis of potentially-malicious software. . . .U.S. Pat. No. 4,567,890 teaches the use of an entirely modeled network to test the correct function of a control and command system whose expected functions are already fully specified.”

This provides additional detail that raises the degree of risk associated with implementing technology covered by a Secondary Reference.

FIG. 1



Guideline 3: Developers should only use the technology in the way described in the pledged patents, staying within the scope of technology claimed. Developers should not assume that patented improvements to the technology claimed in the patents have also been pledged to the Patent Commons. Improvements are, by definition, distinct from the contributed patents and may, in fact, already be patented by someone else who has not made a pledge to the Patent Commons. A search of patents for any improvements (when you know you want to improve upon a pledged patent) is advisable. Again, if patents are located, a formal, competent, legal opinion provided by a patent attorney should be sought describing how and why a user's technology is distinct from the patent technology of another.

APPENDIX A

Commitments may be useful to a developer to enhance a software application that she has written. Imagine a situation where a developer writes an application that utilizes UDP/IP to transmit or exchange data with a remote client or server application. Perhaps the developer would like to have her application utilize TCP/IP to transmit or exchange data for better reliability. One approach would be for the developer to re-write the application for use with TCP/IP. The problem with this approach is that the developer might infringe on patented technology, as is the case whenever software is written. Absent a prior art search, the developer has not made efforts to minimize her liability risk.

A second approach is for the developer to determine if any contributed patents relate to the conversion from a UDP/IP transmission protocol to a TCP/IP based protocol. By searching the Patent Commons Project website, the developer may discover technology that might help her convert the UDP/IP protocol used by the application.

A patent pledged by IBM titled “Compensation for Mismatched Transport Protocols in a Data Communications Network” (U.S. Patent No. 5,224,098) (the '098 Patent) discloses technology that, among other things, “will permit an application program to run over a non-native transport protocol without first generating a protocol compensation package tailored to the transport protocols assumed by the program's application programming interface and by the available transport provider”. The '098 Patent discloses the providing of connection data to the transmitted data of an application program, and claims a method of comparing the protocol utilized by the application's programming interface to that of the transport protocol provider, and compensating for protocol mismatches.

By using the technology disclosed in the '098 Patent, the inherent mismatches between UDP/IP and TCP/IP (e.g., protocol number, SYN/ACK handling etc.) could, in some cases, be addressed. Thus, the '098 Patent provides the developer with an opportunity to address problems such as protocol mismatches.

Once a developer is interested in using a particular technology disclosed in a contributed patent, she should read the entire patent and associated Commitment. By reading both the patent and its associated Commitment, the developer better ensures that she understands technology covered by the patent and how to properly use the technology without exceeding the scope of the Commitment.

For example, assuming that the developer read the entire '098 Patent, she should also read the Commitment entitled “IBM Statement of Non-Assertion of Named Patents Against OSS” that sets forth the terms and conditions for relying on the pledge. The developer should pay close attention to the type of commitment being made – in this case, IBM pledged the '098 Patent for use with Open Source Software defined as software “made available under a license agreement that permits recipients to copy modify and distribute the program's source code without payment of fees or royalties.”

In addition, the developer should understand the termination conditions associated with this patent, which provides in part that “IBM reserves the right to terminate this patent pledge and commitment only with regard to any party who files a lawsuit asserting patents or other intellectual property rights against Open Source Software”.

Because each of the Commitments associated with contributed patents vary, a developer should read and understand terms of these pledges prior to implementing the technology disclosed in the particular patent covered by a pledge.