Opinion on Covenant Not to Assert Patent Claims

Patent licenses are legal fictions. A patent gives its owner the power to exclude others from practicing a claim, but it does not confer an affirmative right to practice it. In essence, then, a patent license is nothing more than an undertaking not to sue the licensee, and such an undertaking is precisely what is needed to enable users of GPL'd code to exercise their rights without fear of liability to upstream distributors for infringement of software patents. In Draft 2 we replace the formalism of the express patent license given in the first paragraph of Draft 1, section 11 with a simpler covenant not to assert patent claims, which more accurately describes the obligations and rights of distributors and distributees under the GPL.

Our rewriting of the first paragraph of section 11 benefited from the comments we received from the public and from our discussion committees. The scope of the express patent license was unclear to many readers; many gave it a much broader reading than we had intended. The patent license operated to benefit "any and all versions of the covered work," which some read as extending well beyond works based on the covered work to cover all ancestrally and laterally-related works. The set of claims that were licensed were those that would be infringed by the distributed covered work "or any reasonably contemplated use of the covered work." The reference to "reasonably contemplated use" was taken from United States case law articulating the implied patent license doctrine in a conventional seller-buyer context. Readers questioned whether the phrase had any ascertainable meaning as used in our provision.

In the covenant provided in the revised section 11, the set of claims that a party undertakes not to assert against downstream users are that party's "essential patent claims" in the work conveyed by the party. "Essential patent claims," a new term defined in section 0, are simply all claims "that would be infringed by making, using, or selling the work." We have abandoned the phrase "reasonably contemplated use." This change makes the obligations of distributing patent holders more predictable.

Rather than referring ambiguously to "any and all versions of the covered work," the covenant not to assert runs in one direction along the branches of a distribution tree that, unlike the earlier patent license, begins explicitly with the original author. Each licensee receives the Program with a covenant from each author and conveyor of the Program and any GPLv3-covered material on which the Program is based. The covenant is an undertaking not to bring a suit that alleges infringement based on the licensee's exercise of any rights under the GPL. Each licensee conveying a covered work makes the same covenant to all direct and remote recipients, including recipients of works based on the covered work, with respect to that licensee's essential patent claims in that covered work.

The covenant makes no distinction between those who convey a work under section 4 (that is, a work in which they hold no copyright interest) and those who convey a modified work under section 5. Some members of our discussion committees, commenting on the patent license of our first draft, urged that such a distinction be made, either by applying the patent license only to "contributions" or by specifying a more limited form of patent license for mere distribution. We do not understand the argument that it is unreasonable for distributors of GPL-covered code to promise not to sue their own customers, or their customers' customers, for patent infringement arising out of that distributed code. Nor do we understand why the presence or absence of modifications by the distributor ought to make any difference. That there are other free software licenses that limit the operation of their patent license provisions to "contributions" is no reason to adopt an approach that does less to protect users from software patents.

Like the express patent license it replaces, the covenant not to assert patent claims is rooted in the basic principles of the GPL. Our license has always stated that distributors may not impose further restrictions on users' exercise of GPL rights. To make the suggested distinction between contribution and distribution is to allow a distributor to demand patent royalties from a direct or indirect recipient, based on claims embodied in the distributed code. This undeniably burdens users with an additional legal restriction on their rights, in violation of the license.