

Guide for Spec Leads in Licensing the RI and TCK

1. Do the licenses for the RI and the TCK have to be different agreements?

The license for the TCK needs to be available separately, i.e. on a standalone basis. The Spec Lead/Licensors could also choose to offer the RI and TCK bundled under a single license, but only as an option in addition to the possibility for a licensee to license only the TCK. See *Section 5.F.I*.

2. Does the RI have to be made available without requiring licensing of the TCK?

The Spec Lead could choose to make the RI available only when bundled with the TCK; however, because the Spec Lead also needs to offer a standalone license for the TCK, as a practical matter most Spec Leads have chosen to license the RI separately. See *Section 5.F.I*.

3. What is the basic principle for licensing the RI?

Section 5.F.1 establishes the basic requirement: the Spec Lead must offer to license the RI to interested parties on non-discriminatory, fair and reasonable terms. So long as this threshold is met, and it is admittedly an inexact one, and except for specific requirements set out in *Section 5.F*, the terms and conditions can be chosen by the Spec Lead in its reasonable discretion.

4. Can the RI license require fees and do those fees need to be disclosed?

Yes. The Spec Lead may require fees for licensing the RI so long as the terms are non-discriminatory, fair and reasonable, and the terms, including fees, are to be disclosed to the EC at Early Draft Review and at subsequent phases (e.g. Final Review Ballot). In contrast to the TCK, however (see below), there is no requirement that the RI be made available for free to Qualified Not for Profits and Qualified Individuals. See *Section 5.F.I* and the *JCP Process Document*.

5. Can the Spec Lead include compatibility restrictions in the license for the RI?

Yes, but only within limits. The Spec Lead must allow the user to copy, modify source code portions of (if provided) and distribute the RI, in whole or in part, as part of a complete binary implementation of the Spec that satisfies the core compatibility requirements:

- (a) fully implement the Spec(s) including all its required interfaces and functionality;
- (b) do not modify, subset, superset or otherwise extend the Licensor Name Space, or include any public or protected packages, classes, Java interfaces, fields or methods within the Licensor Name Space other than those required/authorized by the Spec or Specs being implemented; and
- (c) pass the TCK for such Spec.

The Spec Lead cannot impose more rigorous compatibility requirements, either as a condition of the “scope” of the license or as a contractual commitment, than satisfying the requirements of the TCK Users Guide plus the core compatibility requirements described above. See *Section 5.F.II*.

6. Can the RI be licensed under an open source license?

Yes, i.e. the Spec Lead can offer more generous terms to the licensee concerning its use of the RI than the compatibility restrictions allowed, but not mandated, as described above. For example, the Spec Lead may distribute the RI under an open source license that allows the redistribution of the licensed code, whether as provided or as modified, even if the code ends up in a non-compliant product. See *Section 5.F.I* and *II*.

7. Must the Spec Lead license the RI under its “essential” patent claims?

Yes. The Spec Lead cannot license the RI while refusing to license under its “essential” patent claims, i.e. patent claims where there is no technically feasible, non-infringing alternative in the course of implementing the Spec. This doesn't mean the license must be free – see #4 above – but as a practical matter any license fee under the patent grant would be built into the overall fee, if any, for licensing the RI. This patent license may be conditioned on reciprocity, i.e. requiring that the licensee be willing to grant a non-discriminatory, fair and reasonable license for its essential patent claims reading on implementations of the Spec. *See Section 5.F.II(b)*

8. Must the Spec Lead license the RI in source code form?

The JSPA takes an agnostic position on whether Spec Lead must offer the RI in source code form; it defers to how the Process document is interpreted. The Process document encourages, but has not been generally understood to require, licensing the RI in source code form. *See Section 5.F.V and the JCP Process Document.*

9. Can the Spec Lead license the Spec along with the RI?

Yes, but if the Spec Lead includes the Spec as part of the RI license, the Spec Lead must do so on terms consistent with how Spec Lead licenses the Spec for independent implementations, i.e. include the core compatibility requirements (see #15 below). *See Section 5.F.VI*

10. What are the basic principles for licensing the TCK?

In addition to the standalone requirement, as with licensing the RI the Spec Lead must offer to license the TCK to interested parties on non-discriminatory, fair and reasonable terms. So long as this threshold is met, the terms and conditions can be chosen by the Spec Lead in its reasonable discretion. *See Section 5.F.I.*

11. Can the TCK license require fees; and do those fees need to be disclosed?

Yes. The TCK license can require fees -- except for Qualified Not-for-Profits and Qualified Individuals, for whom there is to be no fee – so long as the terms are non-discriminatory, fair and reasonable. These fees, along with other terms, are to be disclosed to the EC at Early Draft Review and at subsequent phases (e.g. Final Review Ballot). *See Sections 5.F.I and III.*

12. Who needs to have free access to the TCK?

- (i) Qualified Not-for-Profits, i.e. a legally organized, not-for-profit entity (such as, but not limited to, a “501[c][3]” corporation) that is not effectively controlled by a commercial interest and that uses the TCK for the purpose of developing and distributing a compatible implementation of the Spec; and
- (ii) Qualified Individuals, i.e. an individual not acting for or on behalf of a legally organized entity that uses the TCK for the purpose of developing and distributing a compatible implementation of a Spec, and that has established to the satisfaction of the Spec Lead, in its reasonable discretion, that such individual is ready to begin testing its credible implementation of the Spec in question.

See Section 5.F.III.

13. Can the Spec Lead include compatibility restrictions in the license for the TCK?

Yes, but only within limits. The Spec Lead cannot impose more rigorous compatibility requirements

under the TCK license, either as a condition of the “scope” of the license or as a contractual commitment, than satisfying the requirements of the TCK Users Guide plus the core compatibility requirements described above. See *Section 5.F.IV*.

14. Must the Spec Lead license the TCK in source code form?

As with the RI, the JSPA is neutral on this question, in that it defers to how the Process document is interpreted. The Process document encourages, but has not been generally understood to require, licensing the TCK in source code form. However, experience has shown that licensing the TCK source code is more useful to licensees and is likely to spare the Spec Lead some resources in responding to queries about the TCK because of the licensee's greater ability to understand the structure of the tests. See *Section 5.F.V*.

15. What are the requirements for the Spec License?

Once a JSR has passed the Final Approval Ballot, it is to be published by the PMO at the JCP Web Site See *Section 5.A* under a no-charge license from the Spec Lead. The license, under both the Spec Lead's copyrights and patents (a bit complicated; see below) is to authorize the creation and distribution of Independent Implementations, i.e. implementations that do not incorporate any code from the RI (with a few caveats). See *Section 5.B*. Although the language of the JSPA (Section 5.B) commits the Spec Lead to include the compatibility requirements as a condition of authorizing the licensee to create independent implementations, Sun recognizes that enforcement of these conditions is up to the Spec Lead, and that the Spec Lead cannot be forced to choose how, or how not, to exercise its intellectual property rights. Accordingly, Sun is prepared to make the following statement:

The purpose of this statement is to confirm, as between Sun and another signatory to the JSPA that is acting as the Specification Lead for a particular JSR, that Sun would not view a commitment by the Spec Lead -- including but not limited to circumstances where the commitment is expressed as part of a license agreement pursuant to which other parties may gain access to the Specification developed under that JSR -- as to how it will or will not exercise its own intellectual property rights with respect to Independent Implementations as a breach of Section 5.B of the JSPA.

16. Can the Spec License require fees?

No. See *Section 5.B*.

17. Does the Spec License have to provide for commercial implementations?

For a Spec that has cleared Final Approval Ballot, yes, the license must allow for the creation and distribution of Independent Implementations. There is no equivalent requirement for early access (i.e. prior to Final Approval Ballot) versions of the specification. See *Section 5.B*.

18. What patent licenses must be granted by the Spec Lead?

This first requires some sorting into categories, both in terms of who owns the patent rights – the Spec Lead or other Expert Group members – and whether or not the patents are “essential,” meaning whether or not they would be infringed by all technically feasible implementations of the Spec.

When an Expert Group member makes a contribution to the work of the group, if the member's company owns a patent that would necessarily be infringed by the use of that contribution as part of the Specification, RI or TCK (the JSPA uses the term “Output” to describe all three of these together),

then the company grants a royalty free license to the Spec Lead under the essential patent for use of that contribution as part of the Output.

For essential patents associated with an EG member's contribution and licensed by that member to the Spec Lead, the Spec Lead must sublicense or flow through that member's license for Ind. Implementations that satisfy the compatibility requirements, but the license terminates automatically – and the Spec Lead needs to reflect this limitation in the Spec License – if the licensee first initiates a patent claim under its own essential claims against the contributing member (of the EG).

For essential patents owned by the Spec Lead, these can be conditioned on the licensee's being willing to license its essential patents (regarding the same Specification) to any party (including, but not limited to, the Spec Lead) on non-discriminatory, fair and reasonable terms.

The JSPA does not require either EG members or the Spec Lead to grant licenses under non-essential patents, that is, patents for which there is a technical workaround. This leaves the Spec Lead with the discretion whether to grant a broader or more generous license under its own patents than the JSPA requires. For example, some Spec Leads do grant licenses under all their “applicable” or “relevant” patents for compatible, independent implementations, but condition these grants on reciprocal behavior from the licensee.

See Sections 5.B and C.

19. Can the Spec Lead require its licenses (under the Spec License) to include or pass through particular provisions when the licensees distribute their Ind. Implementation?

The Spec Lead cannot require its licensees to include any particular provision in their “downstream” license (see Section 5.E). However, whatever IP grants that flow from the Spec Lead through to the Spec Lead's licensee including, where applicable, IP rights from EG contributors, stop when the implementation ceases to be compatible. To make this provision concrete, assume that “Big Company” is the Spec Lead for JSR #1000, and that “World's Finest Open Source Project” has developed and distributed a compliant, Independent Implementation of the JSR 1000 Spec under an open source license that permits modification and redistribution of the implementation whether or not it remains compatible. Big Company cannot force World's Finest Open Source Project to change the license under which it distributes its implementation. But Big Company could bring IP claims, if it had relevant IP, against WFOSP's licensees if they're using or redistributing products that no longer satisfy the compatibility requirements for JSR 1000. *See Section 5.E.*