

A Method for Protecting Intellectual Property Rights in Reuse

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Abstract

All software professionals must have a basic understanding of key concepts and implications associated with intellectual property rights, including copyrights, patents, and trade secrets. Although in most cases a developer can easily resolve intellectual property issues related to reuse, developers must understand that reusing software has legal implications and consequences. This paper outlines a method used at IBM that helps resolve most of these issues by presenting them logically and concisely to the reuser.

Background

Programmers throughout the IBM corporation repeatedly expressed concern over the loss of intellectual property when providing a reusable component for general availability, e.g., via the corporate reuse library system. Furthermore, reusers had concerns over the legal ramifications and actions they must take when reusing a part. Although the reuse legal guidelines in use at the time explained the many considerations a developer must make, developers repeatedly asked for a straight-forward way to help identify potential concerns and to thereby give them “just a simple yes or no.” To meet this need, the author worked with attorneys from the Intellectual Property Law (IPL) department to develop a way to approach reuse legal issues that programmers and developers could easily follow.

We took the position that of the numerous intellectual property issues of reuse, a couple important situations stand out as those that require an IPL attorney. We also observed that since we supplied parts only once but reused them many times, we wanted to place most of the effort on the supplier. Recognizing that this does not relieve the reuser of IPL responsibility, it provided the greatest time savings and a reasonable assurance of security whenever a potential reuser saw that a part had undergone this IPL review.

To take the simplest possible approach, we created a guide to reuse Intellectual Property issues. The guide does not attempt to address the many complex issues involved in IPL. However, because the vast majority of reuse cases consists of clearly legitimate business-as-

usual use of software, the guide allows the reuser to quickly determine the parameters within which development can continue without worry. When the reuser approaches the bounds of these parameters, the guide advises the reuser to consult an IPL attorney.

Note that we restricted the legal guide to IPL issues. We did not consider that actions resulting from the use, mis-use, or malfunction of reused software fell within the scope of this guide, nor did we feel we could adequately address the many aspects of tort law in a simple manner. We believe this approach provides a simple and straightforward method for reusers to address IPL issues and serves as a front line of protection for company property and interests.

The legal guide for developers

We created the legal guide to help developers identify IPL concerns and raise issues to probe for elements of doubt. To make the guide easy to use, we developed a questionnaire that highlights important IPL situations by asking if certain potentially problematic situations apply. To further make the guide self-explanatory, we provided a simple summary and rationale along with every question. Finally, we provided a form for reuse suppliers to complete once they had answered all the questions. This recorded the information identified by completing the questionnaire, standardized the content and layout of the information, and stored it in a place where a potential reuser could locate and examine it easily.

The complete legal guide for reuse includes:

1. A questionnaire to help part suppliers determine if they can place parts in reuse libraries.
2. A questionnaire to help potential reusers determine if they can reuse specific parts.
3. A legal template that part suppliers can fill out to help protect the intellectual property in reusable parts.
4. An example of a completed legal template for part suppliers to follow.
5. A guide containing explanations of the legal template.
6. A description of other legal obligations.

The guide presents intellectual property issues surrounding software, microcode, and their related documentation. However, where the terms apply it also provides guidelines for general information reuse. Again, the guide encourages users to consult a local IPL attorney if any question arises.

IPL questionnaire

The questionnaire raises certain key IPL issues, explains in a limited fashion the significance of the issue, and advises the developer how to act. The foremost IPL implications arise when a developer wants to reuse software that the company may not own or have rights to use without restrictions. This generally occurs when the software did not originate from a full-time company employee who developed the software as part of the employee's job. For this reason, the initial questions focus on ensuring reusers establish the origin of all reused parts.

By determining the origin and ownership of the rights to software, the company ensures that it gives proper copyright and royalties to part developers. It also helps protect the company's rights in future products that might incorporate the reusable part. When any question arises as to the origin of a part, the reuser must seek appropriate clearances from an IPL attorney.

Other questions in the guide address compliance with legal issues and agreements. For example, if a reused part contains interfaces, copyrighted information, or object-code only (OCO) restrictions, the questionnaire and template make sure the reuser provides the proper information and protects the corporation. The questions include:

1. Does the part consist of all new code?
2. Did full-time employees develop the part as part of their jobs?
3. Did the corporation wholly fund development of the part you intend to supply?
4. Has the corporation published the part?
5. Did the U.S. Copyright office register the copyright?
6. Does the part provide a Programming Interface intended for use by Customers?

7. If you offer the part as object-code only, will you also supply source code?
8. Does the part contain potentially patentable material?

Comparison

Several detailed reports and studies explain the many ramifications of IPL [1], [3], [4], [5]. However, the subject guide provides the only known comparable reference intended for an audience of developers that both explains IPL issues and provides possible approaches to these issues. A planned reuse legal and acquisition handbook for the U.S. Government [2] also takes the straightforward question-and-answer approach, using a technology adoption model. In addition to IPL issues, the handbook includes privacy regulations, security requirements, and acquisition issues specific to government contracts.

Acknowledgements

This work depended on the input of Bill Porter, IBM Poughkeepsie IPL and Steve Lipton, IBM Mid-Hudson Valley Programming Lab Department of Programming Assets Protection.

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