

# Open and Trademarks

**Pamela Chestek**  
Principal  
Chestek Legal

Presented at OpenUK Future Leaders' Training

15 May 2020



**What Are You Hoping to Learn?**



## Some Vocabulary and Principles

When I say “mark” I mean trademark, service mark, or both

- I don't necessarily mean “registered”; each country gives different legal weight to registration
-

# The Overloaded “Mark”




## The Meaning of a Name

- ◉ The word may be used as the name of the ***community***
- ◉ It may be used to refer to the ***software*** product, or collection of products, that is distributed
- ◉ It may be used to indicate someone's ***affiliation***



## Open Source Projects Versus Products

- Is the name of software a “trademark”?
  - Isn't it just a **title**, like a game or a book?
  - 
  -
- 

# Trademark Basics

The ***rules*** are the  
***same***, it's the  
***audience*** that is  
different



## Trademark Basics

- ◉ A trademark is a ***symbolic representation*** of the sum of information about a product or service (in marketing terms, the "brand")
  - ◉ It points to a unique single source, but it can signal ***many types of relationships***
  - ◉ The law only prohibits a situation where there is ***confusion*** about the relationship being signaled
- (It is not the same thing as "attribution" contemplated in open source licenses)



## Trademarks and the Community

- ◉ The trademark may be the project's only asset
- ◉ It stands for --
  - The name of the project
  - The name of the community
  - The individual contributors' sense of belonging and ownership



“

*“I ... do not want to have ‘Linux’ as a name associated with unacceptable ... behaviour, and it’s important that ‘Linux’ doesn’t get a name of **being associated with scams, cybersquatting, etc** etc.”*

*—Linus Torvalds, Jan. 19, 2000*



# Trademark Rights

There is ***quality control***, there is an ***owner***, there is ***use***, and there is ***enforcement***



## Trademark Ownership

- ◉ Quality control
  - There is a canonical (i.e., “single”) source, just like any product developed in more traditional ways
  - The quality of the product is highly controlled

- 
- 
- ⦿ If you don't like the code, fork (but don't pick a name that is too similar)




...getting FireFox on Debian Linux



## What is Iceweasel?

Iceweasel is a fork [from  [Firefox](#)] with the following purpose :

1. backporting of security fixes to declared [Debian stable](#) version.
2. no inclusion of trademarked Mozilla artwork (because of #1 above)

Beyond that, they will be basically identical. (quoting Roberto C. Sanchez post in  [debian-devel](#) mailing list)



[https://wiki.debian.org/Iceweasel#How\\_to\\_install\\_iceweasel\\_28Firefox.29](https://wiki.debian.org/Iceweasel#How_to_install_iceweasel_28Firefox.29)

# Trademark Ownership

But who ***owns*** it?





## Open Source Project Governance

- Types of project governance
  - Benevolent dictator (*individual*)
  - Corporate ownership (*corporation*)
  - Small group of developers (*partnership*)
  - Trade association (*501(c)(6)*)
  - Charitable non-profit (*501(c)(3)*)

○

## Trademark Ownership

- ◉ Who owns the open source trademark, i.e., who can register it?
  - Individual
  - A recognized type of legal entity but not formally formed, e.g., partnership
  - Non-profit foundation
  - Corporation or benevolent custodian
  - Fiscal sponsorship

# Registration

***Nothing  
unusual  
here***



## Trademark Registration

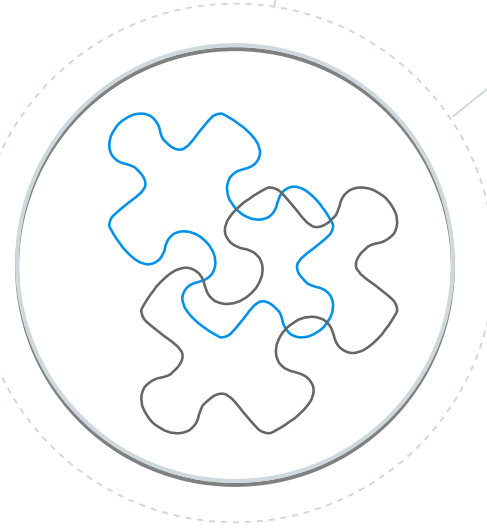
- ◉ Registration and enforcement are **territorial**, generally country-by-country
- ◉ For example, a registration in the UK **won't help** you with an infringement in China
- ◉ (And someone in China can stop you if they register first)

## Trademark Registration

- Registration is wise, given
  - The strong ownership sensibility of contributors
  - The appearance of decentralized development
- Common goods and services to register are software, training (conferences), support (IRC), and association-related services

# Certification/ Collective Marks

***Not*** a great ***fit***  
for the project  
itself



## Trademark Registration for Marks Used by Groups

### ◉ **Collective** Mark

- ◉ A mark used by the **members of** a cooperative, an association, or other collective group or organization



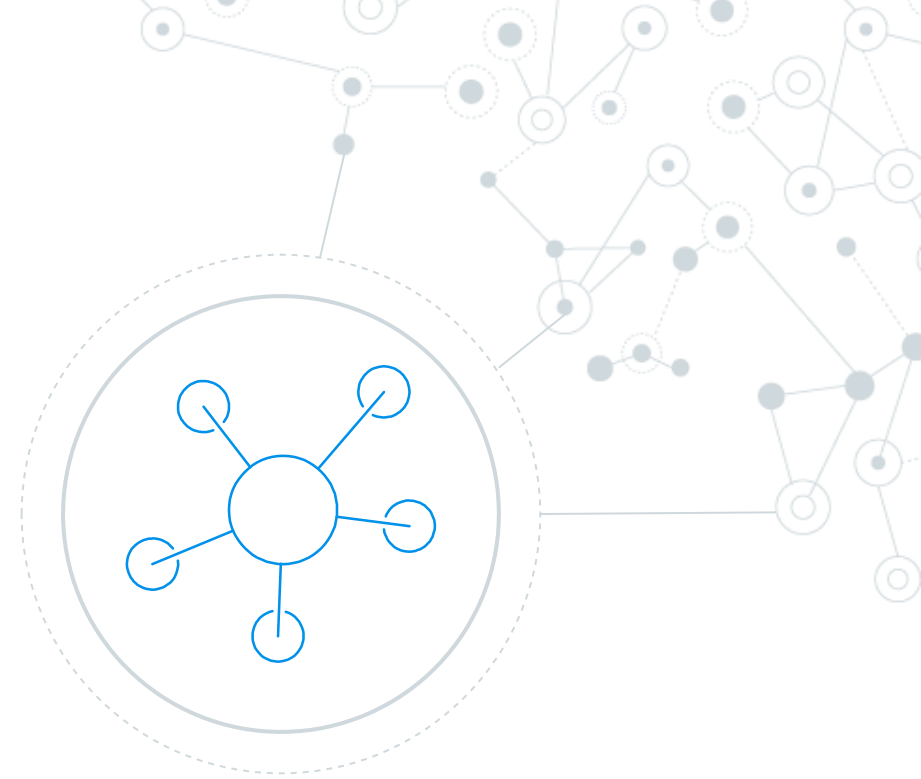
### ◉ **Certification** Mark

- ◉ A mark **used by a person other than its owner** to certify origin, material, mode of manufacture, etc.
- ◉ **Everyone who qualifies** is allowed to use the mark



# Trademarks and Community

Community  
engagement drives  
***different behavior***





## Trademarks and the Community

- ◉ No open source license in use grants a trademark license

*BUT*

- ◉ The ethos of sharing carries through to how the project manages its trademarks
- ◉ All while the open source project has the same challenges as a commercial company

## Trademark Guidelines

- ◉ Open source project guidelines will often grant licenses, especially for promotional goods
- ◉ Vendor marketing helps build ecosystem, brings additional contributors to the project
- ◉ The guidelines will also give clarity on lawful use
  - ◉ Referential use
  - ◉ Resale

# Using Another's Trademark

I ***have to*** use  
someone else's  
trademark!



## Use of Another's Trademark to Refer to Them

Blog of Andreas Jung

Sep 13, 2016

### Don't use "docker" in Github repo names or as Twitter handles

The strict trademark guidelines of Docker Inc. can easily be turned into a case against any open-source programmer or project using "docker" as a repository name or for example as a Twitter handle. Act now!



GitHub gives my fork the same name!

- I have to use a trademark to describe what it works with!



# Elastic v. AWS

# Trademark Enforcement

When to enforce is  
***malleable***, and  
requires a ***delicate***  
***touch***



## The so-called "DUTY TO ENFORCE"

Your trademark is "abandoned,"  
no trademark significance

What you  
have to stop

What you  
can stop

Some things you can't stop:

- Parody
- Commentary
- Resale
- Referential use

## Trademark Enforcement

- ◉ The community is often **highly engaged** in enforcement
- ◉ Because of the sharing culture, enforcement has to be approached **delicately**
- ◉ Enforcement is likely to be **social** and technical, not legal
- ◉ They **can't be bought**



# Resources

Learning about the  
open source  
perspective.



## Home: Model Trademark Guidelines

### Contents [\[hide\]](#)

- 1 [Welcome!](#)
- 2 [The Guidelines](#)
  - 2.1 [Model Trademark Guidelines](#)
  - 2.2 [Working drafts](#)
  - 2.3 [Project trademark policies](#)
  - 2.4 [Sites Using the Model Trademark Guidelines](#)
  - 2.5 [Case law](#)
- 3 [How the Project Works](#)
  - 3.1 [Site Organization](#)
  - 3.2 [How to Participate](#)

### Welcome! [\[edit\]](#)

Welcome to the Model Trademark Guidelines, written by and for free and open source software communities. This site proposes language one might use for trademark guidelines for FLOSS software projects. It describes various provisions that might be included in trademark guidelines and discusses the legal considerations for the provisions. It is not intended to advocate for any particular set of permissions or restrictions, but rather is designed to provide a range of choices that would be found lawful and enforceable under trademark law, that are consistent with FLOSS culture, and that respect the trademark owner's desire to ensure that the software distributed under the trademark delivers a consistent user experience and meets the brand promise of the name. If you're not yet familiar with the project, please read [How the Project Works](#) below.



# FLOSSmarks

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

All content is licensed under the [Creative Commons Attribution 4.0 International License](#). Thank you to FSFE for hosting this site.

[http://  
flossmarks.org/](http://flossmarks.org/)

# Credits / License



- ◉ Shane Curcuru- selected slides (Apache-2.0)
- ◉ Pamela Chestek and Hilary Richardson - selected slides (CC BY 4.0)
- ◉ Presentation template “Cordelia” by SlidesCarnival (CC BY 4.0)

A decorative network diagram in the top right corner, consisting of various sized circles (nodes) connected by thin lines (edges). Some nodes are solid grey, while others are hollow white with a grey outline. The connections are a mix of solid and dashed lines.

# Thanks!

## **Any questions?**

A decorative network diagram in the bottom left corner, similar to the one in the top right, featuring nodes of different sizes and styles connected by solid and dashed lines.