# FOSSmarks

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

## Trademarks and Free Software

Trademarks and FOSS are not incompatible; instead, trademarks are legal tools strongly aligned with FOSS principles. A trademark is an assurance that the recipient of the goods or services is receiving a product of known source and qualities. Controlling how a FOSS project trademark is used protects the community and its software, by preventing use of the trademark in ways that are harmful to the reputation of the community or the software. This isn't a theoretical problem, it happens fairly often.

It may be the case that confusion between two products with similar/identical trademarks isn't intentional wrongdoing, but rather a matter of differing views on a project's direction, sometimes resulting in a fork. But if both forks use the same trademark, users won't be able to distinguish them.

# Consider the following scenario:

You've created a free and open source software project and are hoping to attract contributors and followers. You want to create a name or logo that sets your project apart from other projects. Ideally, you want users to know they are using your project when they see your name or logo, and not some other software or another version of your software.

This FOSSmarks website serves as your guide, from the basics of what a trademark is, to tips on choosing a name, registering a name, and what to do if someone uses your name without permission. This resource is useful to those just starting out, but is also helpful for mature projects.

**You decide where to start:**

TRADEMARK BASICS

A GROWING PROJECT

COMMERCIALIZATION CONSIDERATIONS

SOMEONE IS USING OUR TRADEMARK

# Trademark Basics

Countries have laws designed to protect trademarks, like your name and logo. Generally, **a trademark is any word, name, symbol, or design, or any combination of those items, when used to indicate the source of the goods or services**. A trademark used in association with services is sometimes called a service mark, but the same law applies.

Trademark rights are not an absolute right to use a word in any context, but rather are limited to particular goods or services when used in commerce. That is why EAGLE pencils and EAGLE nuts can co-exist, and why, while there is a famous brand called ORANGE, we can all still talk about oranges.

A trademark is often called “intellectual property” but is distinct from other rights typically called “intellectual property” – copyrights and patents. Copyright and patent law protect the proprietary interests of the creator, but trademarks protect the consumer.

Trademark law prohibits others from using your trademark on inauthentic, or counterfeit, goods. In this way a trademark is a "stamp of approval" that the consumer can rely on when they are purchasing or downloading your product. But trademark protection goes beyond counterfeits, extending to other ways the consumer might become confused, for example, when two names are similar enough to be mistaken for each other, or when your trademark is used by someone to suggest they are associated with you when they are not.

There are several aspects of how trademarks work you should consider. It starts with choosing a good name. Additional benefits may be available if you register your name with various governments. Finally, what happens when someone else uses your mark without your permission, or uses a confusingly similar mark?

# Choosing a Name

A project "name" isn't necessarily a trademark – it might just be a term used to describe a technology, for example "rpm" (which started out as a Red Hat trademark) or "html." Some countries have the concept of a "software title," which is a legal form also entitled to some protection from confusion. For our purposes we will assume that every project name will be a trademark, now or later.

The goal is to **pick a name that won't be confused with anyone else's name for their software or related goods and services**: that is, you want to pick a name that won't infringe the existing rights of others.

It isn't as simple as letter string identicality—

You can find more information in the discussion of "Infringement" below to learn more.

While a trademark lawyer can do a legal analysis and provide more certainty, there are principles you can use when choosing the name that will improve the likelihood you instead, the legal concept of confusion considers the sound, spelling and connotation of the words or designs, whether they incorporate terms that are commonplace or unique, and how similar the goods and services are from the intended consumer's perspective.

can use your name without too much legal risk.

## Legal principles for choosing a name:

- A made-up word, or one with no relationship to the software, will serve you well in the long run.
  - *It can be inspired by a concept, but if the relationship is too close or predictable then it is more likely that someone else already used the same idea. For example, at this point you can be sure that every synonym for "cloud" is being used.*
- The more unusual the word is, the higher it will appear in search engine results and the more likely it will be that you can obtain a matching domain name.
- The more unusual the name, is the easier it will be to stop infringement.
- Don't name your project after well-known science fiction or comic book references, sports teams, famous people (whether living or dead), or a well-known trademark of others.
  - *You may intend it as a homage but the owner of the rights may not perceive it that way, and many of the owners of these famous rights are protectionist. The same is true for parody; generally the well-resourced owner won't be amused.*

- The same word in different languages will likely be considered confusing.
- A misspelled word will be considered confusing with the correctly spelled word.
- The word must be "distinctive," meaning it can identify one project uniquely. "Platform" for a platform, for example, could not function as a trademark.
- If the project is a fork, or related to other software, be careful about using a name too close to the original.
  - *An example of a good naming choice for a new fork is the fork of Hudson called Jenkins, which has the same English butler feel as Hudson but sounds and looks different.*
  - *An example of what didn't go so well was Nevernote, a Linux version of Evernote, but Evernote wasn't so happy with the name and Nevernote is now Nixnote.*

# Some Additional Considerations

If you just need a name for a new project and you don't know what the future may bring, there is probably a low risk in adopting a name casually. If your project isn't commercialized, most likely it won't be a high priority target even if someone believes the name is infringing. If you use the below techniques for picking names, it will also reduce the likelihood you will unintentionally pick a name too similar to another name already in use.

Conduct search engine searches, look in public source code repositories, and check domain names to see whether others are using the same letter string. The whohas tool will give you results for exact matches.

Many countries provide public access to

After choosing a name it may not make sense for you to hire someone to do a formal trademark clearance. However, if approached by someone who claims you are infringing their trademark, be prepared to change your name.

searchable trademark databases. Without training in trademark law you won't be able to say whether your name is available, but you can "knock out" names that are definitely not available.

## Helpful techniques for creating names:

Below are a handful of techniques you may find useful for creating a unique name for your project.

- **Make up a word.** Qpid is a Java message broker that implements the Advanced Message Queuing Protocol (AMQP). It uses "QP," and is a homophone for "cupid," successfully making a non-infringing reference to AMQP in a memorable way.
- **Use an acronym.** GNOME for the desktop environment is an acronym for GNU Network Object Model Environment, but the acronym has a different meaning that lent itself to a fun identity. Samba is from SMB, "server message block."
- **Concatenate two unrelated words or partial words.** Inkscape, the a vector graphics editor, combines the concepts of a drawing medium with a vista, like a landscape or oceanscape. The combination alludes to the object-oriented nature of vector imagery.
- **Play on words.** Make a verbal word play that changes the meaning significantly, for example "Drools" for a platform for rules.
- **Use a name generator.**

**Use a story.** A good story makes your name memorable; everyone enjoys that fact that "Apache" is a pun on "a patchy" web server.

## Legal Clearance

Trademark rights are territorial, with over 200 national trademark registries and a few multi-jurisdictional systems, like the pan-European Union system called the Community Trademark. There are several different databases and techniques for "clearance," which refers to determining whether a name can be used with a low likelihood of infringing the trademark rights of others. Because trademark infringement involves so many ambiguities no clearance can provide certainty, so instead the goal is to reduce the risk of infringement to a tolerable level. A trademark lawyer can do a clearance for you.

## A Growing Project

At some point it would be difficult to change the name throughout your entire project if you receive a complaint from someone claiming you are infringing. With a growing user and contributor base, it makes sense to have more assurance you can use your name into the foreseeable future. This is probably the time to consider a more formal legal clearance process for your name. You also should consider whether it is the right time for registration of your trademark to formally establish and document your trademark rights.

# Ownership

Before you apply to register your trademark, the first (and most important) question to answer is who will own it. Ownership of copyright in the code and ownership of trademark rights in the name and logo won't necessarily be the same. Unlike copyright in the code, community members are not co-owners of the trademark rights in the name or logo; rather, the trademark rights will be owned by a person or entity capable of owning property. Only the owner of the name may file for registration, so this question must be answered before applying.

There is further complexity if you have a logo. In that case, the person who designed the logo may own the copyright rights in the logo but not the trademark rights. Here, to avoid problems that might arise, the owner of the copyright in the logo should assign the copyright to the owner of the trademark rights.

Starting with the assumption that a member of the project creates the trademark, one can find the following approaches:

- The person who created the name remains the owner of the trademark (Linus Torvalds, for instance) or transfers the rights to another (the QGIS project for instance);
- A group of people, acting as partners or an unincorporated association, owns the trademark;
- The person who created the name transfers rights to to the community, embodied by an umbrella organization, society or non-profit corporation;
- The person who created the name does not bother with this issue—as it was (and is) the case in the Arduino project, but the consequences of such an approach are probably not going to turn out well.

If you transfer your rights to another person or entity, you will need to meet the legal conditions for the form of transfer in the respective jurisdiction—a written document is always best. Trademark registration and renewal fees are not cheap, so if you use an umbrella organization, society or non-profit you will have to decide who will cover the costs.

Why it is best to outline an approach in this area? Because potential clashes, like Hudson and Jenkins, might be avoided. The owner of a trademark can revoke the right of the project to use the trademark if the project no longer represents what the owner intended the project to be, as happened to the Jenkins project.

# Registration

Trademarks are referred to as "unregistered" and "registered." An "unregistered" trademark derives rights from actual use. A trademark can also be registered, which is done jurisdiction by jurisdiction. Most trademark registrations are for a specific country, although a few registration schemes cover multiple countries. The Community Trademark, which is a single trademark registration for all of the EU, is the most well-known and useful example.

Registration is a formal procedure in which the government grants you rights or officially recognizes your rights in the trademark. This does not mean that without registration you have no rights in your trademark; however, rights in unregistered trademarks are more difficult—and in some countries impossible—to enforce than a registered trademark. You may also register at any time, before or after using your trademark with your project.

Even if your trademark isn't registered, you may still use the trademark legend (™) alongside your trademark or provide a notice like “MYLOGO is a trademark of ME.” You don't have to, but it is a good signal to others that you believe you have trademark rights in the name.

You may only use the (®) symbol with your trademark if it is registered. However, the symbol is accurate only for the country of registration. It is therefore probably not advisable to use the (®) symbol for materials seen worldwide until you have registered the trademark in several countries.

If you decide to move forward with registering your trademark, it may be more practical and efficient to engage a knowledgeable attorney to assist you with registration, even if it is possible in some

There are common requirements for registering your mark. The trademark office will need a copy of the trademark, whether a word, logo or both, along with the identification of what goods and services the trademark identifies.

Whether to register or not is sometimes a difficult question, but it will save time and costs when combating infringement. It will also help to prove ownership, which can be ambiguous in the collaborative world of free and open source software. The Python trademark dispute is a good example, where the absence of registration by the Python project almost allowed a company to register this important trademark, which would have been detrimental to the project.

Finally, after the trademark is registered, the owner must to pay renewal fees, generally countries to file without one. The process, even with instructions, can be complicated, especially if you seek protection in several jurisdictions.

every ten years, and the trademark must be used. If the trademark isn't used by the owner for an extended period (usually over three to five years—depending on the jurisdiction), it is treated as abandoned or may be revoked.

# Commercialization Considerations

Your project has grown beyond a small circle of users and contributors, and companies have found your project and are using it as part of their own products or internal operations. They may be approaching you about providing support or additional features, or want to contribute resources. You are devoting significant time to the project, and maybe you even quit your job to work on the project full time.

## It's Time to Get Serious

It is probably time for a formal legal entity. Likely there is an umbrella organization like the Linux Foundation, the Apache Foundation or The Software Freedom Conservancy that can provide a more formalized administrative structure for your project. They may take over ownership and registration of the trademark for your project's benefit.

Whether you join an existing umbrella organization or start a new legal entity, it is time to complete legal clearance and registration if you have not already done so. You may have business partners that demand registration, so they will have assurances they won't infringe anyone else's rights as they extend the geographic footprint of the project. Also understand what enforcement strategy you will have and post a trademark policy, explaining to your users and the community how they may use the trademarks.

## Setting up a trademark policy:

You can find great guidance on modeltrademarkguidelines.org, which also provides a list of the trademark policies of several free and open source projects.

Browsing through those will show you the key aspects you want to include in your own Trademark Policy. When you write your policy, always remember most people reading your policy won't be trademark experts. So keep the language simple, and use lots of practical examples. This is what we are trying to do in this guide, too, and we hope it works for you. If not, please tell us what we can improve.

You may enter into business relationships for hosting or sponsoring conferences, or that provide training in the software. You may have companies that want to provide professional services relating to the software, like installation, support and customization. These relationships should all be licensed, with an agreement that covers elements such as the deliverables, standards for the partner's performance, payment terms, and termination. Because of the complexity of these relationships, have legal advice before entering into them.

# Someone is Using Our Trademark

Despite the openness of your software, you will still want to protect the name of your project, and the names of your individual software programs. You don't want others to claim their software is the official software or that they offer official services when they aren't associated with you. In the worst case scenario, if a bad actor takes your software, designs malware around it and distributes it under the same name, users will blame you for the infection of their computers (and this isn't at all hypothetical).

So what are they allowed to do, what can you do about it, and what do you want to do?

## Determine Your Strategy

You won’t know which road to take unless you know the extent to which you want to protect and enforce your trademarks. You first must be clear about what you can legally do. Second, you need to determine what you want to do, how you want to use your resources and how forceful your enforcement should be.

## Enforcing Your Rights

Under trademark law, you can prohibit anyone from using your trademarks for products and services that are not your own where such use is likely to create confusion about the true commercial origin of those products and services. This confusion can arise if those products or services are similar enough to your own project and software and use a name identical with, or similar to, your name, or that suggest a relationship with your software that doesn't exist. If that happens, there is a legal risk that users might erroneously believe that the third party product or service is yours or associated with you.

As a general rule, you are legally entitled to object to confusing use of your trademark.

Conversely, there are some forms of use that you cannot stop, because they are not considered confusing in the legal sense.

- **You can't, using trademark law alone, stop anyone from using your trademark for a copy of your own official software if that copy has already been placed on the market with your consent.** Say you have sold a copy of your software on a data carrier to a company based in Italy. The data carrier depicts your name and logo. You can't prevent the Italian company from reselling the copy of your software on that data carrier to someone else.

- **You can't stop anyone from using your word marks as a descriptive reference to a service they are offering.** Say you are called "Project X." If another company specializes in technical support for your software program "Fancy," they may advertise their services by saying they offer "Support for Project X's Fancy." They won't be allowed, however, to use any references that might create the false impression they are commercially linked to your project, or authorized or endorsed by you. An example of such a confusing use of your trademarks, which you could prevent, would be "Official Project X Fancy support."

- **You can't stop others from using your trademark when they have no way to say what they mean without using it.** "Great Game Y uses the rendering libraries in Project X" would be an example.

- **If your trademark isn't only the name of your own software, but also has a different, descriptive meaning, you can't prevent anyone from using the name in that descriptive way.** For instance, others would be free to refer to their own software as "amazingly fancy software" in advertising, so long as the circumstances of that use don't create confusion. The legal assessment would be different if someone used the expression "Amazing FANCY® software," suggesting that fancy was not just general marketing language but the actual name of the software – your name. Such confusing use is something you could prevent.

# To Be Permissive or Not?

Given you are a free software project, you probably will be more permissive with your trademarks than other right owners. Typically, you will want to encourage free and open dissemination of your original software under its name. So, even though sometimes you may have the legal right to stop others from making copies of your software and distributing them, in a commercial setting you will probably not want to stop that use. There may also be a point where enforcement of trademark rights will be a breach of the FOSS license, but we do not know where that line might be.

Projects don't always agree about the extent to which they want others to use the project's trademark. Because opinions differ, a trademark policy will help others respect the choices you have made.

- **Using your trademarks for modified versions of your software.** Users must be sure that when they download a program called "Fancy" they are getting software with the known attributes and qualities they desire. It is a valid legal position that only software downloaded from an official repository may be called "Fancy," meaning that, even though third parties will be free to change your code, you can require that they find a different name for any product that isn't your official version. Alternatively, you may permit some changes that won't negatively affect the user's expectations or opinion about your software, like cosmetic changes, porting, bug fixes, or add-ons. What these permitted changes might be will be specific to the functionality of the software, but if you allow use of the trademark for modified software you should state, either publicly or in a private license, what those changes can be. Also monitor the variations to ensure that they remain faithful to the original software.
- **Selling your software under your trademarks.** Some projects, such as Mozilla, prohibit the use of their trademarks for their branded software unless the software is distributed at no cost. Other projects allow their software to be sold or incorporated into software that is sold commercially.
- **Using your trademarks for related goods or services.** If someone uses "Fancy" as a name for a product or service related to software, such as a hard drive, or a software consultancy, you will have a legal basis to object if a potential consumer might believe there is an association with you when there isn't. For example, they might believe that you are endorsing the service provider's services or have approved the quality of the hardware. But the “Fancy“ hard drive may be of bad quality, or the “Fancy“ software consultancy might give bad advice and your reputation will be harmed. This is a a tricky area though; we mentioned before that others may use your trademark if they have no other way to accurately describe the situation. There is no bright line between what might confuse and what is understood by the user as having no relationship to you —does "Joe's Fancy Training" mean Joe's training is called "Fancy" or that Joe provides training for "Fancy" software?
- **Using your trademarks in domain names.** Whether or not you can object to domain name use depends on two things: Is your trademark unambiguous, and is it used with goods or services covered by your trademark registration. For instance, if you have registered "Fancy" for software, and someone registers "fancy-software.com" and

There are legitimate reasons for either approach and the law allows for both, so this is a policy call you need to make.

offers software-related advice on that website, then there may be little you can do about that. "Fancy software" in that case will just be understood as a descriptive reference to "fancy" software in general, and anyone will be free to register and use a domain name containing such descriptive terms. But if your software is called "Xpectors," and a bad actor uses xpectors.com to offer malware, that is something you can prevent because in this case "xpectors" is a unique name understood by users to refer only to your original software. This use will therefore create confusion about commercial origin, which would not happen with "fancy-software.com."

If you have identified an activity that might infringe your rights, you will want to seek legal advice. Speak to a trademark law expert and discuss your options.

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## Seek Advice

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Anthonia studied law with a strong international focus. She obtained her Magister Juris degree with distinction from the University of Oxford, where she was also awarded the John Morris Prize in Conflicts of Law.

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This webpage is a project of the FOSSmarks special interest group of the European Legal Network. The source is available on Github.

Contact us if you have suggestions or would like to become a member of the special interest group. Thank you also to the Free Software Foundation Europe for hosting this site.