

Open Source Clients And Their Trademarks:

Different Motivations & Different Needs

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Abstract

Clients engaging in the open source ecosystem often have different goals around use of trademarks than traditional software company clients. Counsel can provide better advice and save many headaches for themselves and their clients if they understand the differing expectations for “open source software”, and frame their advice to best serve client goals related to open source behaviors and business needs, both inside the company and in the broader ecosystem. A brief discussion of some different motivations for open source clients, including an *Appendix* surveying major open source trademark policies showcasing some of these goals.

Keywords

Free and Open Source Software (FOSS), trademarks, non-profits, Foundations.

Introduction

As open source software drives technical innovation to new areas, so too do the technical processes and business models that build software continue to change. The kinds of people and organizations driving change in the entire open source ecosystem today are different than the traditional software vendors of old, and are changing in approach and expectations from early open source vendors before 2010. Understanding the differences in motivation of your clients wishing to capitalize on the modern open source movement is important to be able to give the best advice. A key ethos to any “Open source” company or project is freely sharing specific parts of copyrighted software, as well as sharing some uses of trademarks. How this free sharing of work intersects with trademark policies and laws is an area still unfolding, both for clients and counsel.

Open Source Definition = Free Redistribution

The **Open Source Initiative** (OSI), a 501(c)3 non-profit, publishes the de facto definition of the term “open source”. While many companies may attempt to use the term in subtly different ways for their businesses, the definition itself is not only strong and specific, it also colors the ethos of both companies and individuals who make up the open source ecosystem today. To be credibly considered an “open source” license, software program, or company, it must abide by the **Open Source Definition** (OSD), which includes this key provision:

1. Free Redistribution

The license shall not restrict any party from selling or giving away the software as a component of an aggregate software distribution containing programs from several different sources. The license shall not require a royalty or other fee for such sale.

OSI's Open Source Definition, <https://opensource.org/osd-annotated>

The OSI evaluates common software licenses for compliance with the OSD, and publishes the list of which copyright licenses may be called “open source”, and therefore which software products that use those licenses may be called “open source”. While some marketing departments may make exaggerated claims, if software is not offered under a license on the OSI list, the industry will not consider it to be “open source”. A trend called “open washing” is where marketing departments oversell their software as open source, even when the license is not approved by the OSI. Open washing nearly always leads to strong bad publicity, and can often harm the client's bottom line.

While this may seem to merely apply to the licenses themselves, there are many practical reasons that this sharing mentality applies to the goods of those software products, and to a large degree the companies and brands that they are built on. Note that this view does not apply to proprietary brands – i.e. traditional software products and brands that are not under an open source license – so understanding different client motivations for different product lines within a single company is important.

A thorough treatment of open source client goals would include understanding distributed software development methodologies as well as the new business models being formed to capitalize on the improved and shared innovation that comes with those methodologies. But there are a number of core drivers and behaviors these clients show that will differ from traditional proprietary vendor behaviors when it comes to the brands in the open source arena.

In particular, the *Appendix* presents excerpts from the trademark policies of a number of major open source projects. These show important insight both into the motivations of open source brand owners, as well as some specific cases where trademark use expectations are explicitly more liberal than traditional nominative use.

Modern Software Is Often A Combination of Products

Software today is becoming more modular than ever. Where in the past a customer would simply buy a complete solution from a single vendor – typically with a long-term contract for maintenance and support – today's products are widely understood to be composites made of many parts. This distinction has long been clear to developers building software; today it is becoming understood to consumers of software.

The brand association that customers have to their software solutions is sometimes to an array of individual components (cloud layers, microservices, pluggable modules, etc.), rather than to a single monolithic software product. Vendors and open source clients alike understand they must be competitive in this new modular world of software, and want their individual component brands to be useable with other company's brands. Much like the

Powered By Intel branding was applied across a wide variety of computer manufacturers, today's Powered By Apache brand (see *Appendix*) is used widely in cases where vendors use Apache software products as part of their own branding and products. Other major open source producers have similar policies.

Similarly, most software vendors today rely on a large number of open source products within their technical strategy, and indeed as major components of their own (possibly proprietary) products. Understanding the business value of respect from those open source projects is critical for innovation and the long-term direction of that company's own products. When much of the company's business strategy is built on the goodwill and code of an open source brand, ensuring you treat open source trademarks appropriately is important for the bottom line.

Open Source – Driven More By Individuals And By Sharing

Software innovation – as well as the business innovation that powers it – is more often driven today by individuals or newer companies rather than traditional software vendors. This shift is happening on both the production side as well as the customer side:

- Individual software developers or small teams can create industry-changing software solutions in record time. The ethos of sharing brought by the individual employees in small companies like this colors how their company expects their software brands to be used. Beyond the personal desire for sharing, the practical advantages of sharing maintenance and combining new innovations quickly keep the business decisions focused on sharing. Even at large vendors, employee pressure to meet moral or social obligations to independent open source projects the company relies on is becoming a factor for the business.
- Customers – in technology and elsewhere – are becoming more comfortable with the faster iteration and improvement of open source software. No longer do most industries plan ponderous upgrade cycles with long term contracts; software innovations are picked up at a record pace in production today. Similarly, the use of open source software and development methodologies means that customers have more insight into the production of the software they consume, and can even participate in development themselves. Importantly, the ability to capture this value relies on the customer respecting the open source brands they use.

These shared drives combine to give open source projects a brand loyalty that has a broader and deeper meaning than traditional vendor brands. In the commercial vendor world, profit is the driver. In the open source world, individual pride, both at the employee and corporate level, takes a place at the table for popular projects. In software, the lines between producing and consuming organizations often blur. Clients will often be promoting their own brand that is based directly atop an open source brand. The methods you use to police your client's brand need to understand the underlying open source brands the client may be basing their reputation on.

Open Source Skills Are In Demand

Open source is now more of a factor for HR and talent acquisition than it is for marketing departments. While this may not have a direct effect on how clients use open source brands in the marketplace, it is becoming a factor in talent retention. Technical and non-technical staff alike are looking for companies that allow them to work in open source projects, and that will respect the work done there. Open source experience allows staff to more easily build a resume of work that can travel with them between employers. Employees want to see their company respecting other open source projects and trademarks. Understanding these underlying client needs can allow counsel to better help clients make the right business decision, rather than the tightest legal decision.

Non Profit Foundations

Many popular open source products are built by non-profit foundations that also hold the trademarks and other IP associated with critical and widely-used software. Examples include the Apache Software Foundation, Eclipse Foundation, and many Collaborative Projects organized under the Linux Foundation. These foundations represent a new kind of software production model that capitalizes on open source – as well as providing a significant number of the core software components running the internet today.

These foundations control important brands, but their goals aren't to compete, merely to get credit for their work. Their goal is to encourage as much use of their software and brands as practical, in the aim of having more contributors to their projects. While foundation brands may appear to be unprotected, they are not: it is still important that consumers understand which specific software components come from the foundation, versus what may come from differing commercial vendors. There are numerous cases of business leaders overriding legal department advice, where a company's reputation in the open source ecosystem is at stake.

Open Source Brand Use & Policing – A Business Decision

Given the sharing nature of many open source projects, many brand use decisions need to be made based on business needs, not legal definitions. Trademark law traditionally prevents third party use in the same context – however many open source project policies are **designed to allow** for this use in some specific, bounded ways. While open source projects still wish to be seen as the source of their specific goods, they welcome shared uses that respect their goals. These uses often may seem problematic compared to traditional proprietary vendor goals, but they are consistent with the ethos and good business practices of the modern software market.

Similarly, some open source foundations have specific policies for how their brands may be used or credited that seem unusual or irrelevant. While there may not be legal risks to ignoring seemingly unimportant open source policies, there are business risks that are far more important to your client. Ensuring that brand use decisions – and policing actions – are done with the business goals in mind is doubly important when dealing with anything open source.

Conclusion

The very definition of “open source” includes an explicit provision for sharing of goods. While trademarks are not explicitly included in this sharing, the ethos of the participants as well as new business models are driving new ways that diverse organizations can use trademarks of other vendor's open source products. Organizations using or promoting open source will often have business goals that require a very different risk tolerance of trademark use than traditional companies do today.

About The Author

Shane Curcuru serves as Vice Chairman for the non-profit Apache Software Foundation (ASF). In a previous role as Vice President, Brand Management he wrote and implemented the ASF-wide trademark policy that applies to over 200+ popular open source software projects.

Appendix – FOSS Trademark Policy Examples

A number of excerpts from the trademark policies of popular open source projects are included. In each case, the specific open source project – often a non-profit foundation holding trademarks on behalf of the community – provides specific cases where third parties may use those trademarks, often without separately signing a specific license for the trademark.

Open Source Initiative (OSI) definition of open source

<https://opensource.org/definition> – formal Open Source Definition (OSD) by OSI.

<https://opensource.org/osd-annotated> – Annotated version, highly recommended.

The OSI's definition of the term “open source” itself is well-understood and accepted throughout the modern software ecosystem. While the whole OSD is worth reading, the first criteria shows the broader sharing ethos that underpins the thinking of today's software developers. This sharing is not just a moral desire on the part of individual software engineers; it is also a key part of many open source business models.

1. Free Redistribution

The license shall not restrict any party from selling or giving away the software as a component of an aggregate software distribution containing programs from several different sources. The license shall not require a royalty or other fee for such sale.

Rationale: By constraining the license to require free redistribution, we eliminate the temptation for licensors to throw away many long-term gains to make short-term gains. If we didn't do this, there would be lots of pressure for cooperators to defect.

Recently, new software licenses have been used that attempt to restrict either monetization of the underlying software, or to prevent certain groups or companies (usually for moral reasons) from using the licensed software. While many of these software products were traditionally “open source”, the new licenses are not open source, because they do not follow the OSD, to wit:

6. No Discrimination Against Fields of Endeavor

The license must not restrict anyone from making use of the program in a specific field of endeavor. For example, it may not restrict the program from being used in a business, or from being used for genetic research.

Rationale: The major intention of this clause is to prohibit license traps that prevent open source from being used commercially. We want commercial users to join our community, not feel excluded from it.

Debian Project, at Software In The Public Interest, Inc.

<https://www.debian.org/trademark>

The Debian Project trademark policy works at being friendly and approachable, and purposfully finds ways that you can use their trademarks without permission. In particular, using the Debian marks to refer to the Debian software is allowed in third party advertisements and in other kinds of merchandise.

This allowance for merchandise is a common one in open source trademark policies; the trademark rights are held primarily in class 9 for the software products themselves. Other classes of products – including services – are often explicitly left open for others to capitalize on.

The objective of this trademark policy is:

1. to encourage widespread use and adoption of the Debian trademarks,
2. to clarify proper usage of Debian trademarks by third parties,
3. to prevent misuse of Debian trademarks that can confuse or mislead users with respect to Debian or its affiliates.

Please note that it is not the goal of this policy to limit commercial activity around Debian. We encourage businesses to work on Debian while being compliant with this policy.

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When You Can Use the Debian Trademarks Without Asking Permission

1. You can use Debian trademarks to make true factual statements about Debian or communicate compatibility with your product truthfully.
2. Your intended use qualifies as nominative fair use of the Debian trademarks, i.e., merely identifying that you are talking about Debian in a text, without suggesting sponsorship or endorsement.
3. You can use Debian trademarks to describe or advertise your services or products relating to Debian in a way that is not misleading.
4. You can use Debian trademarks to describe Debian in articles, titles or blog posts.
5. You can make t-shirts, desktop wallpapers, caps, or other merchandise with Debian trademarks for non-commercial usage.
6. You can also make merchandise with Debian trademarks for commercial usage. In case of commercial usage, we recommend that you truthfully advertise to customers which part of the selling price, if any, will be donated to the Debian project. See our donations page for more information on how to donate to the Debian project.

Debian Social Contract – The Original Definition

https://www.debian.org/social_contract

The Debian Social contract is a much broader document by the Debian Group that defines the ways they, as a whole community, will interact with each other, and will provide software freely for use by all. The Debian Free Software Guidelines are directly credited as the original inspiration and direct parent of the OSI's Open Source Definition.

The Debian Social Contract and Free Software Guidelines are not binding on other open source groups nor on commercial vendors. However the ethos and beliefs, both on the theoretical level as well as the practical level for efficient software business practices, are widely held and strongly color the behavior and motivations of many modern software vendors.

Apache Software Foundation Trademark Policy

<https://www.apache.org/foundation/marks/faq/>

The non-profit Apache Software Foundation (ASF) hosts over 180+ open source software projects, many of which are industry leaders in their own right, like the Apache web server (nearly 50% marketshare since 1999), and the Apache Hadoop big data software. The ASF trademark policy applies to the trademarks of all Apache projects.

Here, blanket permission is given for third parties to use Apache software trademarks directly in their own software products, as long as specific rules are followed. The purpose here is to encourage the use of Apache software brands while still giving the ASF and it's communities credit for the underlying software products.

MAY I USE APACHE POWERED BY... MARKS OR LOGOS IN SOFTWARE PRODUCT NAMES OR LOGOS?

Yes, under certain circumstances, you may use the Powered by... phrase or a project-specific Powered by... logo in direct conjunction with your software product or service's primary branding. This applies for all Apache project names and the Powered By... variation (inside a circle with Powered By Apache around the outside) of their logos.

Third parties providing products or services that are supersets of the functionality of an Apache product, or services are run atop Apache products, may use any "Powered by..." form of the Apache brand name of the related product. For example, "BigCo SuperThing, Powered by Apache Spark" would be acceptable, provided that all of the other requirements are met:

Any primary product home pages or landing pages for the SuperThing product must include a link from the homepage named "Apache Spark" pointing to the actual Apache project home page at <http://spark.apache.org/> Note that inclusion of the "Apache" before the product mark is required.

Your product name must consistently use the "Apache Spark" version of the Apache product name.

Do not visually combine the ASF product's Powered by... logo with any other images.

On your website make any Powered by... logo link to the homepage for the ASF project on the apache.org website.

Include a trademark attribution to the Apache Software Foundation on the page itself (footers are acceptable; links to separate pages are not).

Ensure that your website and marketing materials do not imply ASF endorsement or the affiliation of your products, services, or organization with ASF.

Ensure that your website and marketing materials will not confuse the average user about the source of

ASF products nor imply that ASF is associated with your products or services in any way, other than the fact that your product is built atop/to work with the Apache product.

See also the Apache Project brand usage guide for more requirements.

Django Software Foundation Trademark Policy

<https://www.djangoproject.com/trademarks/>

The Django Software Foundation's policy clearly emphasises their ethos of sharing. In particular, they allow broad re-use of their marks, even on software products, as long as the third party uses an OSI-approved license.

The Django Software Foundation (DSF) is the owner of the Django trademark, and as such, it is necessary for us to protect this mark. Part of this protection is to clearly define criteria that must be satisfied in order to use the Django trademark.

Django is an Open Source project, and as such it is important to the Django Software Foundation that the uses of the Django trademark are in the spirit of Open Source. This license attempts to codify the practices generally accepted in an Open Source community regarding the use of a trademark. Broadly speaking, this means that the community should be allowed to use the trademark to identify related products, libraries, community organizations, events, or education and training materials, as long as that activity doesn't violate the spirit of Open Source. The license also attempts to place some light social pressure on those directly using the Django trademark to make money. Anyone making a profit by using the Django trademark is required to report what proportion of that money will be contributed back to the community.

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2. Django-related software projects

You may use the Django name in the form "DJANGO-FOO" or "FOO-DJANGO" in any software library that can be used to augment or extend the capabilities of official Django project software, provided that:

1. The project is distributed under the terms of an OSI-approved open source license; and
2. The website for the project does not imply that it is official or otherwise endorsed by the DSF, or by the Django Core team as representatives of the Django project.

WordPress Foundation Trademark Usage Policy

<http://wordpressfoundation.org/trademark-policy/>

The WordPress Foundation builds the widely popular WordPress blogging platform. Here, they explicitly allow third party use in software products – as long as they are non-commercial, and support the original WordPress software itself. Note in particular the requirement for GPL compliance: they are using their trademark policy to help ensure compliance with other software project licenses.

Permission from the WordPress Foundation is required to use the WordPress or WordCamp name or logo as part of any project, product, service, domain or company name.

We will grant permission to use the WordPress name and logo for projects that meet the following criteria:

- The primary purpose of your project is to promote the spread and improvement of the WordPress software.
- Your project is non-commercial in nature (it can make money to cover its costs or contribute to non-profit entities, but it cannot be run as a for-profit project or business).

- Your project neither promotes nor is associated with entities that currently fail to comply with the GPL license under which WordPress is distributed.

If your project meets these criteria, you will be permitted to use the WordPress name and logo to promote your project in any way you see fit with one exception: Please do not use WordPress or WordCamp as part of a domain name. Examples of projects in this category are officially recognized WordCamps or international WordPress communities that are dedicated to the translation and distribution of WordPress in their respective countries.

Gentoo Foundation Trademark Policy

<https://wiki.gentoo.org/wiki/User:Swift/trademark>

The Gentoo Project builds a popular Linux-based operating system used on desktops and servers. Again, their policy allows re-use in many cases, as long as they are “in the spirit of Free Software”.

The Gentoo Project is a Free Software project, and as such it is important to the Gentoo Foundation, Inc. that the uses of the Gentoo trademark are in the spirit of Free Software. This license attempts to codify the practices generally accepted in a Free Software community regarding the use of a trademark. Broadly speaking, this means that the community should be allowed to use the trademark to identify related products, libraries, community organizations, events, or education and training materials, as long as that activity doesn't violate the spirit of Free Software. The license also attempts to place some light social pressure on those directly using the Gentoo trademark to make money. Anyone making a profit by using the Gentoo trademark is required to report what proportion of that money will be contributed back to the community.

Node.JS Foundation Trademark Policy

<https://nodejs.org/static/documents/trademark-policy.pdf>

The Node.JS Foundation, a division of the non-profit Linux Foundation, builds one of the key frameworks used in a large portion of software development today. While originally a proprietary product, the creating company wanted to broaden their contributor base and gave the codebase to the nonprofit foundation.

The Node.js trademarks, including “Node.js” (the word mark in plain text or in logo form), have come to represent both the Node.js community as well as the widely adopted Node.js platform for easily building fast, scalable network applications (the “Project”). Trademark protection reinforces the connection between the developer community and the Node.js Foundation (the “Foundation”) and ensures that the marks are only used for activities that promote the Foundation’s mission.

The goodwill supporting the Node.js marks has been generated by this prolific and passionate community. To preserve the goodwill it has created, we have prepared these guidelines in accordance with the community’s desires. The resulting guidelines safeguard that all uses of the marks are consistent with the Foundation’s mission, while at the same time making the marks available for use by the community. These guidelines seek to balance enabling the community and protecting the marks, while at the same time encouraging appropriate uses of the marks.

Model Trademark Guidelines

http://modeltrademarkguidelines.org/index.php?title=Model_Trademark_Guidelines

The Model Trademark Guidelines are a template set of trademark policies meant for simple re-use by any open source project. They were written to echo many of the existing trademark

policies of popular and widely-used open source projects already in existence. A small excerpt provides the rationale for the goals of groups using these policies. A key part of open source business models relies on participants and contributions from the wider community.

Our commitment to open source principles

We want to encourage and facilitate the use of our trademarks by the community, but do so in a way that still ensures that the trademarks are meaningful as a source and quality indicator for our software and the associated goods and services and continue to embody the high reputation of the software and the community associated with it. This Policy therefore tries to strike the proper balance between: 1) our need to ensure that our trademarks remain reliable indicators of the qualities that they are meant to preserve and 2) our community members' desire to be full participants in the Project.