

UNDERSTANDING TRADEMARKS

in the context of open source

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RIDDER, COSTA & JOHNSTONE LLP





JOSH AAS

Executive Director
Encrypter in Chief
ISRG / Let's Encrypt



RIDDER, COSTA & JOHNSTONE

Ben Costa



Chris Ridder

INTELLECTUAL PROPERTY

- **Patents** - a government authority or license conferring a right or title for a set period, especially the sole right to exclude others from making, using, or selling an invention
- **Copyrights** - the exclusive legal right, given to an originator or an assignee to print, publish, perform, film, or record literary, artistic, or musical material, and to authorize others to do the same
- **Trademarks** - ???

UNDERSTANDING TRADEMARKS WILL . . .

- Help you to avoid legal issues with your project names!
- Set yourself apart!
- **Protect your users!**

WHAT IS A TRADEMARK?

A trademark is any symbol, word, phrase or design that identifies and distinguishes the source of the goods/services of one party from those of others.

Let's Encrypt

name



logo

FOSS OBJECTIVES VS. TRADEMARK BURDENS

FOSS projects are generally about being open; we don't want to place unnecessary restrictions on the uses that others make of our work.

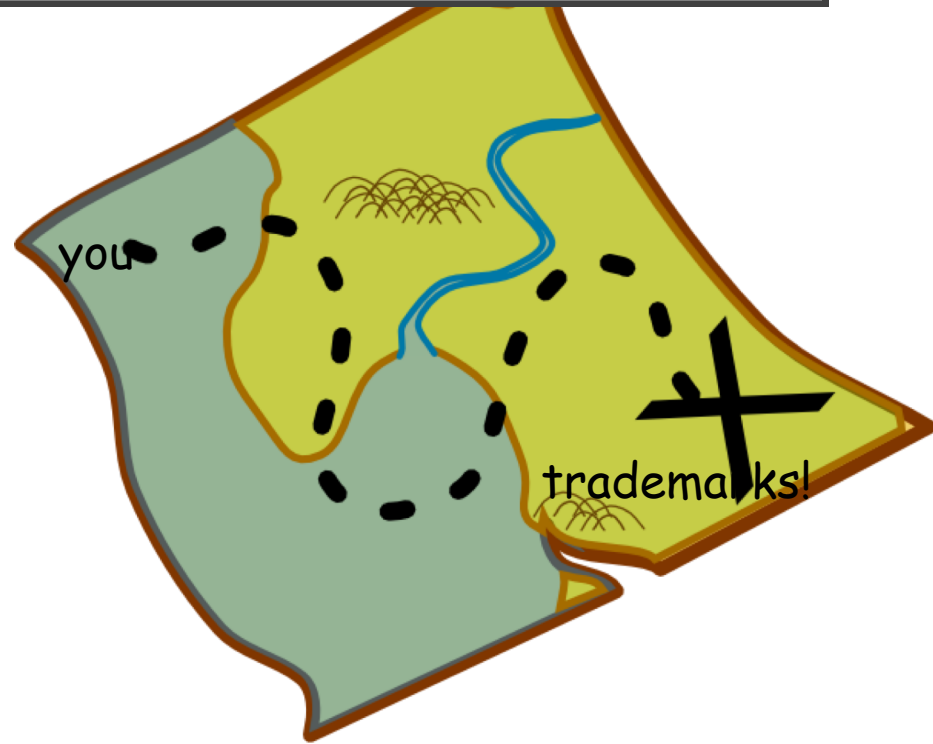
Trademark rights may seem inconsistent with FOSS ethics/objectives.

Trademark rules are all about **user and consumer protection!**

Trademarks help consumers recognize your products, enabling the public to associate your brand with the quality work you produce.

ROADMAP FOR PROTECTION

- Pick a strong brand!
- Clear the brand for use!
- Register your brand!
- Put a policy in place for your users!
- Defend your brand!
 - *as needed



HOW TO SELECT A TRADEMARK?

-or-

What makes a strong brand?

STRONG BRANDS ARE DISTINCT

(when applied to the goods on which they're used)

APPLE



Generic



Descriptive



Suggestive



Arbitrary

Bad Brands!

Good Brands!

Spectrum of Distinctiveness!

CLEARANCE

- Google it!
 - *sorry Google
- USPTO database search
- Full trademark clearance report

CLEARANCE: WHEN IS A BRAND TOO CLOSE?



TO REGISTER OR NOT TO REGISTER?

Spoiler alert: you want to register!

BENEFITS OF REGISTRATION IN US

- Deterrent to junior users.
- Statutory presumptions.
- Helps with intermediaries.

THE REGISTRATION PROCESS

- File your trademark application!
- USPTO review / examination phase!
- Third party review / opposition phase!
- Registration!
 - *as long as you're using the mark
- Use it or lose it!

PROTECTING YOUR TRADEMARK

without being a troll

THE “DUTY TO POLICE” YOUR MARK

- “[T]here are a number of trademarks around the Ubuntu name and logo which we are required to “enforce” or risk losing them altogether. ... That means: ... we actively monitor, mostly using standard services, use of the name and logo [and] we aim to ensure that every use of the name and logo is supported by a “license” or grant of permission.” - Mark Shuttleworth re: C&D to fixubuntu.com (2013)
- “The owner of a mark is not required to constantly monitor every nook and cranny of the entire nation and to fire both barrels of his shotgun instantly upon spotting a possible infringer.” – *Engineered Mech. Servs. v. Applied Mech. Tech.*, 584 F. Supp. 1149 (M.D. LA, 1984).

LIKELIHOOD OF CONFUSION FACTORS

***AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979):**

1. Strength of the mark;
2. Proximity of the goods;
3. Similarity of the marks;
4. Evidence of actual confusion;
5. Marketing channels used;
6. Type of goods and the degree of care likely to be exercised by the purchaser;
7. Junior user's intent in selecting the mark; and
8. Likelihood of expansion of the product lines.

PURSUIING INFRINGEMENT

- Consider whether the use is a non-trademark use, or fair use.
- Consider public/community perception.
- If infringer has applied for a trademark, TTAB proceeding is an option.
- In case of infringing domain name, UDRP available.
- Lawsuit if necessary.

DEFENSE: TRADEMARK FAIR USE

- Also known as “classic” or descriptive fair use. Defined as use (1) other than as a mark; (2) in a descriptive sense; (3) in good faith.
- HYGRADE FOOD PRODUCTS could not prevent a grocery store from using the phrase High Grade Food Stores to describe their stores.
- SWEET TARTS candy could not prevent Ocean Spray from referring to its cranberry juice as “sweet-tart” in taste.
- Abercromie and Fitch could not prevent others from using its SAFARI mark to describe clothing intended for use in a safari.

DEFENSE: NOMINATIVE FAIR USE

- Use of a trademark to describe the trademark owner's own goods or services, for purposes of comparison, criticism, point of reference, or similar purpose.
- Different standards in different jurisdictions.
- Ninth Circuit asks: (1) was the product readily identifiable without use of the mark? (2) Was more of the mark used than was necessary (e.g., logos)? (3) Was there a false suggestion of sponsorship/endorsement?

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*Int'l Information Systems Security Certification Consortium
v. Security University (823 F.3d 153 (2d Cir. 2016))*

TRADEMARKS AND THE COMMUNITY

- When others modify/distribute your software, to what extent are they allowed – or should they be allowed – to use your brand?
- How should your community interact with your brands?

“Traditional” TM Owner	Open Source Project
Exclusive	Inclusive
Consumptive	Generative
Propertize	Share

DO ALL USES NEED TO BE LICENSED?

- Potentially-infringing trademark uses that are not nominative/fair uses should be licensed.
- Linux Foundation's approach:
 - If the answer to all three of the following questions is “yes,” then you need to apply for a sublicense. If the answer to any of these questions is “no,” then you do not need to apply for a sublicense.
 1. Is my mark a trademark (see how we define “trademark,” below)?
 2. Does my mark contain the following string of adjacent letters, in this order: “Linux”? These letters may or may not be capitalized, and in the case of foreign characters, phonetic translations also apply.
 3. Do I use my mark to identify software-related goods or services (see how that phrase is defined, below)?

QUALITY CONTROL

- No “naked licensing” permitted. If you grant permission for use of a mark, you must exercise quality control. Failure to do so can waive all TM rights.
- Freecycle Network: promotes giving unwanted items to strangers instead of discarding. Allows like-minded people to create groups, spread the good news.
- Freecycle Network didn’t retain express contractual control; didn’t have actual control over Freecycle Sunnyvale’s use; unreasonably relied on FS’s quality control measures. TM abandoned. *Freecycle Sunnyvale v. The Freecycle Network*, 626 F.3d 509 (9th Cir. 2010).



EXAMPLE: FIREFOX AND ICEWEASEL



“The open source nature of Firefox allows you to freely download and modify the Firefox source code. However, if you make *any* changes to Firefox, you may not redistribute that product using *any* Mozilla trademark without Mozilla’s prior written consent and, typically, a distribution agreement with Mozilla. For example, you may not distribute a modified form of Firefox and continue to call it Firefox.”



“The Firefox ... official logos ... are covered by a different license which is far too restrictive for Debian.” Mozilla also required pre-approval of patches as a condition of using Firefox name.

2016:

“Mozilla recognizes that patches applied to Iceweasel/Firefox don't impact the quality of the product ... Mozilla trusts the Debian packagers to use their best judgment to achieve the same quality as the official Firefox binaries.”

EXAMPLE: FEDORA



Approval required in many circumstances, including for third-party uses limited to software included in the official Fedora repositories.

If guidelines followed, no prior permission to use Fedora mark on computer systems, virtual images pre-loaded with Fedora.

https://fedoraproject.org/wiki/Legal:Trademark_guidelines



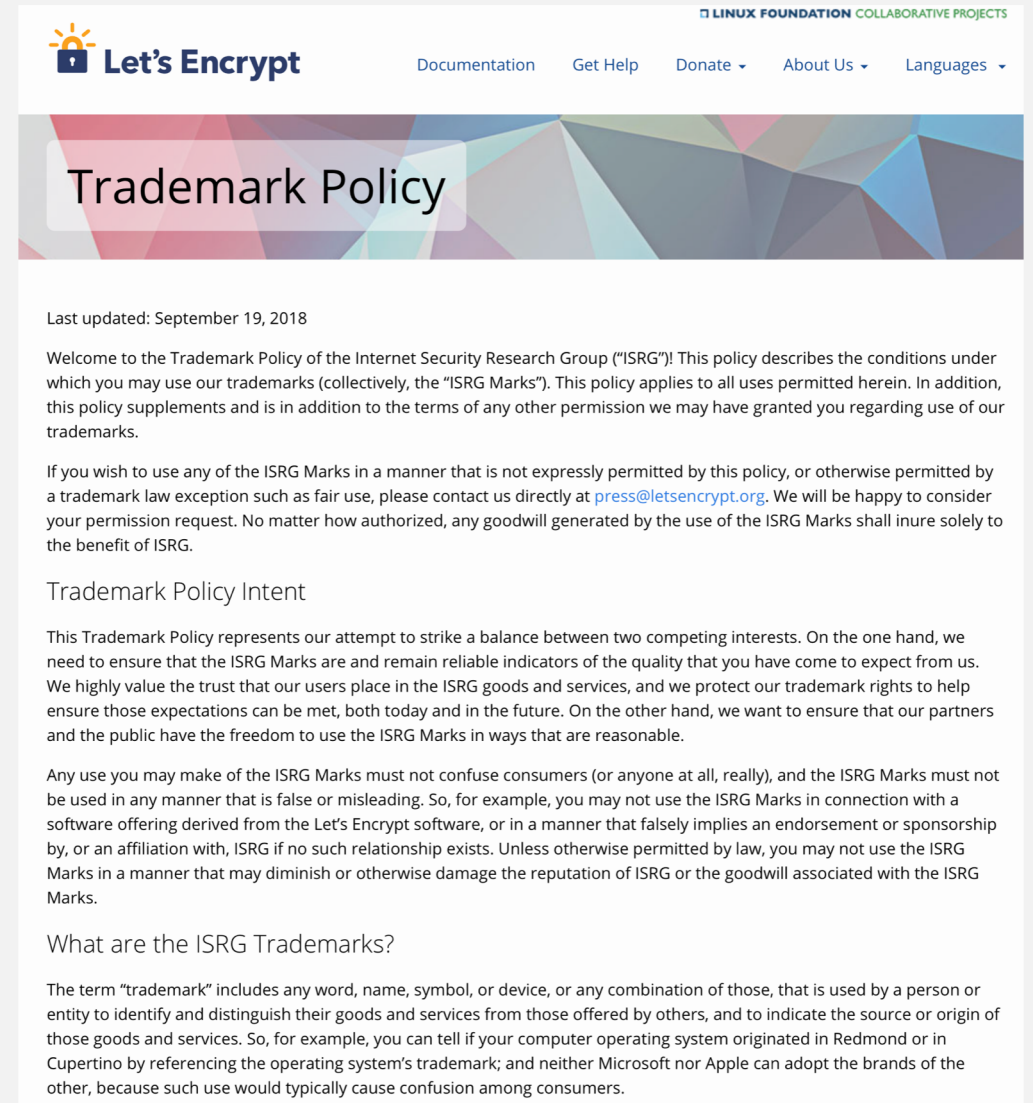
Can be used without permission to mark content derived from Fedora (e.g., modified software; combinations of Fedora and non-Fedora).

Use must clearly indicate that the work contains modified Fedora content or non-Fedora content. May not use phrases such as:

- "built from Fedora"
- "powered by Fedora"
- "contains Fedora"

TRADEMARK POLICY

- Explain your approach to TM issues.
- What your trademarks are.
- Lay down the rules of the road, to avoid honest mistakes on the part of your users.
- Tell the public which uses you will tolerate / clarify the kinds of uses you will consider to be nominative/fair uses.
- Give users a channel to contact you to request greater permission.



The screenshot shows the Let's Encrypt website's Trademark Policy page. The header includes the Let's Encrypt logo, navigation links for Documentation, Get Help, Donate, About Us, and Languages, and the Linux Foundation Collaborative Projects logo. The main heading is 'Trademark Policy'. Below this, it states the policy was last updated on September 19, 2018. The text explains that the policy describes the conditions for using Internet Security Research Group (ISRG) trademarks. It provides contact information for trademark requests at press@letsencrypt.org. The 'Trademark Policy Intent' section discusses the balance between trademark rights and public freedom. The 'What are the ISRG Trademarks?' section defines the term 'trademark' and provides examples of proper and improper usage.

Let's Encrypt

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Trademark Policy

Last updated: September 19, 2018

Welcome to the Trademark Policy of the Internet Security Research Group ("ISRG")! This policy describes the conditions under which you may use our trademarks (collectively, the "ISRG Marks"). This policy applies to all uses permitted herein. In addition, this policy supplements and is in addition to the terms of any other permission we may have granted you regarding use of our trademarks.

If you wish to use any of the ISRG Marks in a manner that is not expressly permitted by this policy, or otherwise permitted by a trademark law exception such as fair use, please contact us directly at press@letsencrypt.org. We will be happy to consider your permission request. No matter how authorized, any goodwill generated by the use of the ISRG Marks shall inure solely to the benefit of ISRG.

Trademark Policy Intent

This Trademark Policy represents our attempt to strike a balance between two competing interests. On the one hand, we need to ensure that the ISRG Marks are and remain reliable indicators of the quality that you have come to expect from us. We highly value the trust that our users place in the ISRG goods and services, and we protect our trademark rights to help ensure those expectations can be met, both today and in the future. On the other hand, we want to ensure that our partners and the public have the freedom to use the ISRG Marks in ways that are reasonable.

Any use you may make of the ISRG Marks must not confuse consumers (or anyone at all, really), and the ISRG Marks must not be used in any manner that is false or misleading. So, for example, you may not use the ISRG Marks in connection with a software offering derived from the Let's Encrypt software, or in a manner that falsely implies an endorsement or sponsorship by, or an affiliation with, ISRG if no such relationship exists. Unless otherwise permitted by law, you may not use the ISRG Marks in a manner that may diminish or otherwise damage the reputation of ISRG or the goodwill associated with the ISRG Marks.

What are the ISRG Trademarks?

The term "trademark" includes any word, name, symbol, or device, or any combination of those, that is used by a person or entity to identify and distinguish their goods and services from those offered by others, and to indicate the source or origin of those goods and services. So, for example, you can tell if your computer operating system originated in Redmond or in Cupertino by referencing the operating system's trademark; and neither Microsoft nor Apple can adopt the brands of the other, because such use would typically cause confusion among consumers.

COMODO LET'S ENCRYPT

Comodo, a direct competitor, filed three Let's Encrypt-formative trademark applications.

At the time, we did not have a registered trademark, but had been common law trademark users since 2014 with substantial public recognition.

We and our lawyers asked them to withdraw applications; they refused.

They backed down after we publicly told the story of what was happening.

APPLICANT INFORMATION	
*OWNER OF MARK	Comodo CA Limited

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Defending Our Brand [Updated]

Jun 23, 2016 • Josh Aas, ISRG Executive Director

Update, June 24 2016

We have confirmed that Comodo submitted Requests for Express Abandonment for all three trademark registration applications in question. We're happy to see this positive step towards resolution, and will continue to monitor the requests as they make their way through the system.

We'd like to thank our community for their support.

Some months ago, it came to our attention that Comodo Group, Inc., is attempting to register at least three trademarks for the term "Let's Encrypt," for a variety of CA-related services [1][2][3]. These trademark applications were filed long after the Internet Security Research Group (ISRG) started using the name Let's Encrypt publicly in November of 2014, and despite the fact Comodo's "intent to use" trademark filings acknowledge that it has never used "Let's Encrypt" as a brand.

QUESTIONS?