Policing Apache® Project Brand Use By Third Parties

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APACHECON EUROPE

CORINTHIA HOTEL
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V2.0

Introduction

- Shane Curcuru

    - VP, Brand Management, The Apache Software Foundation (ASF)

- Volunteer, appointed by Apache Board of Directors

- Define and implement trademark & brand policy for all 180+ Apache project communities

- Provide trademark support for projects

- Involved at Apache since 1999

- Not a lawyer

- Questions? `<trademarks@apache.org>`

Topics

- Trademark concepts brief overview

    - Adjectives, nominative use, consumer confusion, and registration

- PMC Branding Responsibilities

- Policing Third Party Brand Use

- Granting Third Party Permissions

- When To Work With trademarks@

- Resources

Trademark Concepts In 30 Seconds

What are trademarks?

- A trademark is the **legal instantiation** of your brand

- Trademarks are about **preventing consumer confusion** as to the **source of goods** within a **specific field of commerce**

- The specific name and logo an informed consumer (user of your software) associates with a **specific downloadable software program** or service

- Trademarks **protect consumers** by ensuring expectations of quality, functionality, etc. available from a specific vendor

- A brand includes many elements – names, logos, look and feel – parts of which are specific trademarks that signify a software **product** or service

- Your **project** name is not *necessarily* a trademark, although it may be a service mark

Trademarks are adjectives

- Trademarks legally are used to **describe** the actual goods

- I buy Kleenex® brand tissues

- We run Apache CouchDB™ software and Apache Hadoop® software

- … but in common usage we just write: we're running Python

- Use as an adjective is important on your homepage & download page

- … not as important in other places

Nominative use is OK

- Nominative use for trademarks ~= fair use for copyright

- Other people may use the trademark to **describe** your goods

- Nominative use even allows people/companies to post bad reviews of your software product

- Personal blogs, newspaper articles, technical mailing list discussions are almost always nominative use

- Infringement is when a third party uses your marks in a way that may **mislead consumers** as to the true source of goods, or confuse users as to **which company** provides a specific software product

Registered trademarks

- In most countries, common law rights accrue from actual use of a mark to identify goods – without any registration

- Trademarks may also be registered with the USPTO, the EU/Community Trade Mark, and other individual country governments – improves our rights

- Every country has different registration laws

  - Some are "first to file" like China, Korea; most are "first to use"

- Apache PMCs may request their name be registered

  - Email tm-registrations@apache.org to request

But it's open source!

Apache License, v2.0

6. Trademarks. This License does not grant permission to use the trade names, trademarks, service marks, or product names of the Licensor, except as required for reasonable and customary use in describing the origin of the Work and reproducing the content of the NOTICE file.

PMC Branding Responsibilities

PMCs: Be responsible

- PMCs are **responsible** for their own brand

  http://www.apache.org/foundation/marks/responsibility

- Have a **consistent** brand and use it

- Be **aware** of how your brand is used in the marketplace

- Be **respectful** of other brands and the Apache brand

- Present an **independent** face to project governance

PMCs: Be consistent

- Your use of your Apache Foo brand is the reference implementation

- Attribute your own trademarks with ™ or ® to make their status clear to others – both words and logos

- Ensure consistency in your website

    - In your documentation, first and most prominent uses

    - On your download page: download **Apache Foo software**

    - In publicly visible parts of your product UI

- Trademark law is not a compiler: the general consumer perception is what counts

PMCs: Be aware

- Be aware of how other companies use your project brand

- Third party uses that may confuse consumers as to the source of software products are important to review and respond to

- Other uses probably don't need to be addressed formally

- Personal blogs, press articles, software reviews, benchmark reports, forum discussions, emails on dev@... are all places that are unlikely to be infringing uses

- Fairness to all users is critical – both with outsiders and with companies who are contributing to your project

PMCs: Be respectful

- Ensure you treat other organization's trademarks respectfully

- Charitable or community-based projects have no business infringing on other's trademarks

- Be liberal in attribution and giving credit to other communities or companies

- Respond calmly and professionally if a third party asks/demands for changes; always cc: trademarks@

PMCs: Be independent

- **Apache** projects are governed independently

  http://community.apache.org/projectIndependence

- Software products are clearly branded <u>Apache</u> Foo

- Treat all participants / contributors fairly

- Independence from undue commercial influence is a requirement for Apache projects

- Independence means Apache Foo software performs useful functions, without additional (proprietary) software

Policing Use Of Apache Project Brands

Police brand use privately

- When a third party is improperly using your project's brand, the PMC needs to take action and ask for corrections!

- Always contact third parties privately

  - Private, direct contact allows all parties to save face

  - Public confrontations often escalate, potentially damaging everyone's reputation

- Assume ignorance rather than malice

- Use reporting guidelines to determine if the use is (or is **not**!) a problem

  - http://www.apache.org/foundation/marks/reporting

Be professional and polite

- Whenever contacting anyone about improper brand use:

    - Be professional – make them understand the project is serious

    - Be polite – many cases are resolved through simple discussion

    - Be firm – state the ASF's clear ownership of the marks

    - Be specific – quote specific uses that we request to be changed

- Most potential infringements cases are resolved through discussion between private@, trademarks@, and the other party

    - Be patient – discussions take time to resolve

- Legal threats are **never** the first step

Get legal advice

- The ASF has pro bono corporate counsel from DLAPiper

- Send any legal questions, especially any from outside the ASF, to:

    - trademarks@ for anything brand-related (private archive)

    - legal-internal@ for any specific legal question the PMC has on behalf of the project (private archive)

    - legal-discuss@ for any general legal questions that can be discussed publicly (public archive)

- **Never** grant exceptions to brand policy without trademarks@ approval

- **Never** give legal advice (unless you actually are an ASF counsel)

- **Never** respond to an outside lawyer without asking ASF counsel

Responding to third party requests

- NEW POLICY CHANGE: PMCs may now **directly grant certain third party permissions for specific uses** (events, domains, swag / merchandise) of their project marks

- Best practices / how-to guides being rolled out

    - Respond promptly: acknowledge the question even if the answer is not ready yet

    - Respond professionally: many requesters are marketers or lawyers, not coders

    - Respond privately: keep on private@ unless OP used dev@

- Ask trademarks@ for help **anytime** you have a question!

Granting third party permissions

- Be consistent and fair when granting permissions

- Does a use of your project's brand by a third party / other company:

    - Not confuse consumers about the source of Apache software?

    - Help the image, impact, or reach of your project community?

- Only grant specific permissions as noted in policy

    - Events; domain names; services; merchandise

- Do **not** grant exceptions dealing with software **product** names

    - But: you can use allow Powered By phrases (For..., Plugin...)

When To Work
With trademarks@

Trademarks@ sets policy

- The ASF owns all Apache trademarks on behalf of the projects

- PMCs are required to comply with core use policy

- PMCs otherwise define and promote their own brand

- Project brand design, like technical direction, is completely up to PMCs to define for themselves

- trademarks@, like press@, infra@, etc. are here to serve the needs of all Apache projects

Deal with difficult third parties

- Any time a third party responds negatively, or when another company lawyer is involved – ask trademarks@ to help craft your reply

- Any difficult negotiations should be done by VP, Brand Management, with appropriate legal counsel

- Most corporations respond to official titles

- Patience is required: trademark issues are rarely time critical

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Trademark enforcement & legal action

- A Cease & Desist (C&D) is **never** the right place to start

- Consider the public image of "attacking" a third party

- Trademark litigation is expensive and risky

- Most issues can be resolved with polite, firm, and private discussion with the right parties

- A very few serious issues end up being resolved with other actions: making a public case; restricting PMC or commit access; or the board unilaterally restructuring a project

Thank You & Resources

Thank You!

- Thanks to all Apache Members

- Thanks to all Apache committers and PMCs

- Thanks to members of Apache Trademarks Committee, with special thanks to David Nalley

- Thanks to DLAPiper counsel: Mark Radcliffe, Dash McLean, Nikkya Williams, Carol Anne Bashir

- Thank you to companies who respect Apache brands

Trademark Resources - External

- Formal policy for third party use

    - http://www.apache.org/foundation/marks/

- Third party requesting permission for events

    - http://www.apache.org/foundation/marks/events

- Third party requesting permission for domains

    - http://www.apache.org/foundation/marks/domains

- All other questions

    - http://www.apache.org/foundation/marks/contact

Trademark Resources – for PMCs

- Policy for PMC websites

  - http://www.apache.org/foundation/marks/pmcs

- Linking to third party sites/products/services

  - http://www.apache.org/foundation/marks/linking

- Project Independence is **required** for PMCs

  - http://community.apache.org/projectIndependence

- Questions? <trademarks@apache.org> and relevant <private@project.apache.org>

Questions?

Please feel free to find Shane with any

questions this week!

Look for the Ask Me! Buttons, and just ask!

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When outside companies want to use Apache project brands in different ways, they often ask permission. PMCs may now start granting permissions for their own project brand directly. (this is a recent policy change)

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Reminder: this is not legal advice – if you have a legal question for an Apache project, ask on trademarks@ or legal-internal@ for a specific answer.

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Details matter – trademarks are defined by law in very specific ways, some of which are not necessarily obvious for the layperson.

Trademarks are adjectives

- Trademarks legally are used to **describe** the actual goods

- I buy Kleenex® brand tissues

- We run Apache CouchDB™ software and Apache Hadoop® software

- … but in common usage we just write: we're running Python

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Yes, this seems picky, but it's important!

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- Infringement is when a third party uses your marks in a way that may **mislead consumers** as to the true source of goods, or confuse users as to **which company** provides a specific software product

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Don't panic! Most uses are not infringing, and most/many uses are not even worth asking to change – even if it's a bad review, it's still not a problem as far as trademarks are concerned.
It's only the "consumer confusion" about actual products that really matters (from a legal perspective, that is – there are cases where socially/PR wise, some uses might not be good)

Registered trademarks

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Apache Project Brands

Part of a PMC's job in managing their project's brand is ensuring that any third party – other company – use of your project brand is not infringing on our marks.

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Never make the first contact in public – always privately. Almost **every** trademark infringement the ASF or any of our projects has pursued has been resolved privately.

Many cases result from ignorance by the other party; once the issue is clearly explained (we hold this trademark, here's the appropriate way to use it), the issue is fixed with a "oops, we're sorry!" from them.

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Remember: most of the time, the people you need to contact here are marketing people and lawyers – not coders or other typical project contributors. Our requests to make changes in other company marketing materials often get bounced around to find the right corporate decision maker to make the fix.

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Also: Community over Code. It's important, as is giving the thanks to the community members who have built everything the ASF and it's projects are about.

Members have built the Foundation.

Committers/PMC members have built our projects.

Members and the trademarks committee have assisted in forming and documenting our policies, as well as assisting our various projects in applying them and defending their brands.

Our pro bono law firms have helped with review and strategy. In the past we have also used other firms, including SFLC, however DLAPiper is our primary brand-related pro bono firm.

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