

The Trademark Reporter®



The Law Journal of the International Trademark Association

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WHO OWNS THE OPEN SOURCE PROJECT NAME?

*By Pamela S. Chestek**

I. INTRODUCTION

In the United States, ownership of trademarks can be bedeviling. A trademark registration is not a grant of rights, only recognition of already-existing rights. Instead, a trademark is owned by the first to use it and may be registered only by the owner.

U.S. trademark law also eschews the concept of joint trademark ownership, considering it inconsistent with the role of a trademark as a sole source identifier or assurer of quality. When deciding ownership disputes, there is no consistent rule or standard that courts apply, leaving courts in the position of having to identify a single owner of a trademark using poorly defined law.

This is a challenging legal environment for a free and open source software (FOSS) project. FOSS projects are often informally operated without a clearly defined management structure. They also have a fundamental philosophy that software can and should be shared, meaning that they must also tolerate some third-party use of their marks. Thus, on questions of trademark ownership, FOSS projects tread on riskier legal ground than do more traditionally organized businesses.

This article will provide some background information on how FOSS projects operate, review the various ways that courts have decided who owns a trademark if there is more than one potential owner, and provide guidance to free and open source software projects about how to best manage their project names so that the project has a clear claim of ownership and a path to trademark enforceability.

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This article is based on an article entitled "Who owns the project name?" published in the *International Free and Open Source Software Law Review*, Volume 5, Issue 2 (December, 2013). The original article is available online at <http://www.ifosslr.org> and licensed under a Creative Commons UK (England and Wales) 2.0 license, no derivative works, attribution, CC-BY-ND available at <http://creativecommons.org/licenses/by-nd/2.0/uk/>.

II. BACKGROUND

U.S. trademark law is not well suited to businesses that have decentralized decision-making models. Trademark theory developed around the concept of a centralized process for the creation of product:

Of course, corporations, partnerships, joint ventures and marriages are combinations of individual persons. But when such an entity sells trademarked goods or services, control over quality and consistency is centralized. Someone is in control. A single decision results from internal study and discussion. Similarly, when a mark is licensed or franchised, the licensor or franchisor is a single entity controlling quality. A licensed mark indicates uniform quality. Uniform quality is produced by a single source of control.¹

As will be described in Part III of this article, this approach is almost the antithesis of how a free and open source software (FOSS) project operates, with its loose management structure, contributions by many different individuals to the finished product, and generous permission to reproduce the software (that is, manufacture new product) granted by the FOSS copyright license. This is a manufacturing model that traditional trademark law has not seen.

Putting aside the challenges arising from the FOSS development model, even for traditional business models the courts have not settled on any single standard for deciding the rightful owner of a trademark. Part IV reviews various theories the courts use to identify the lawful trademark owner in the case of a dispute.

The proactive FOSS project, despite its unorthodox management and project development method, will take steps to ensure that, if challenged, the project name clearly indicates a sole source of software of a predictable quality under traditional legal doctrine. Part V of this article will provide advice on the steps a project can take to ensure the protectability of its project name.

Note that this article is limited specifically to classic trademark theory with respect to the use of the project name for software and promotional goods. The term “project name” is used in the title of this article to describe a term that may potentially acquire trademark rights, even if a project name may not, in all instances, function as a trademark.

While this article assumes that the “project name” will function as a trademark, certainly the concept of a “project” encompasses more than software: it is members of a community

1. 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 16:40 (4th ed. June, 2013).

acting both individually and collectively, a source code repository, a website and domain name, and many intangible assets and qualities. The ownership of these aspects of a FOSS project is outside the scope of this article.

III. THE DEVELOPMENT MODEL FOR FREE AND OPEN SOURCE SOFTWARE

“Free and open source software” is generally understood to refer to a copyright licensing scheme for software that allows liberal access to, modification of, and redistribution of the source code,² the human-readable form of software.³

There are several philosophical bases for the belief that permitting copying, distribution, and modification of source code is beneficial. The primary proponent of “free” software, the Free Software Foundation, states that allowing the modification of software and sharing is an issue of citizen empowerment and helping one’s neighbors.⁴ The Open Source Initiative, the primary proponent of “open source software,” frames the advantage in more businesslike terms, stating that “[t]he promise of open source is better quality, higher reliability, more flexibility, lower cost, and an end to predatory vendor lock-in.”⁵ Both caretakers of FOSS philosophy, however, consider the concept of freely sharing the software a fundamental component of FOSS.⁶

2. See GNU Operating System, The Free Software Definition, <http://www.gnu.org/philosophy/free-sw.html> (last visited Aug. 2, 2013) (defining “free software”); Open Source Initiative, The Open Source Definition (Annotated) Version 1.9, <http://www.opensource.org/docs/definition.php> (last visited Aug. 2, 2013) (defining “open source” software).

3. Denis Howe, The Free On-line Dictionary of Computing, <http://foldoc.org/source+code> (last visited Aug. 2, 2013) (“Source code: The form in which a computer program is written by the programmer. Source code is written in some formal programming language which can be compiled automatically into object code or machine code or executed by an interpreter.”)

4. See Richard Stallman, *The GNU Operating System and the Free Software Movement in Open Sources: Voices From the Revolution* 53-57 (1999); Richard Stallman, *Why Software Should Not Have Owners*, <http://www.gnu.org/philosophy/why-free.html> (last visited Aug. 7, 2013).

5. Open Source Initiative, About the Open Source Initiative, <http://opensource.org/about> (last visited Aug. 7, 2013).

6. See The GNU Operating System, The Free Software Definition (June 18, 2013), <http://www.gnu.org/philosophy/free-sw.html> (listing, as part of the definition of “free software” “The freedom to redistribute copies so you can help your neighbor (freedom 2)” and “The freedom to distribute copies of your modified versions to others (freedom 3). By doing this you can give the whole community a chance to benefit from your changes. Access to the source code is a precondition for this.”); Open Source Initiative, The Open Source Definition, <http://opensource.org/osd> (last visited Aug. 7, 2013) (listing, as part of the definition of open source software, “2. Source Code: The program must include source code, and must allow distribution in source code as well as compiled form” and “3. Derived Works: The license must allow modifications and derived works, and must allow them to be distributed under the same terms as the license of the original software.”).

FOSS, therefore, has an ideological heritage that influences how the software projects operate. For example, one operating system project, the Debian Project, has a “Social Contract” that states “We will allow others to create distributions containing both the Debian system and other works, without any fee from us. In furtherance of these goals, we will provide an integrated system of high-quality materials with no legal restrictions that would prevent such uses of the system.”⁷ This means that the Debian Project and other FOSS advocates struggle with restrictions based on trademark and whether they are inconsistent with a free software license. For example, one Debian project member, in commenting about a Debian logo, said that the statement “This logo or a modified version may be used by anyone to refer to the Debian Project, but does not indicate endorsement by the project” “fails most interpretations of the DFSG” (Debian Free Software Guidelines).⁸ Debian is also well known for altering the Mozilla Foundation’s “Firefox” browser to remove the Firefox logo because the logo was not under a copyright license that allowed its unrestricted use.⁹ When Mozilla objected, Debian was adamant that including the logo would be contrary to its social contract,¹⁰ so it could not include the logo in its distribution. Instead, Debian began distributing the browser under the name “Ice Weasel”¹¹ so it could remove the logo,¹² and it still does so today.¹³

Few FOSS projects are as stringent as Debian, but nevertheless the moral imperative to share is still strong: “The objective of The Document Foundation (“TDF”) mark policy is to

7. Debian Project, Debian Social Contract (July 5, 1997), http://www.debian.org/social_contract; see also Weasel Gnu/Linux, Social Contract, <https://sites.google.com/site/weaselgnulinux/social-contract> (last visited Aug. 13, 2013) (same language).

8. Debian Project, Proposed Trademark Policy, <https://wiki.debian.org/ProposedTrademarkPolicy> (last visited Aug. 13, 2013).

9. Debian Bug Report Logs - #354622, Uses Mozilla Firefox Trademark Without Permission, Msg. 25 (Feb. 27, 2006), <http://bugs.debian.org/cgi-bin/bugreport.cgi?bug=354622#25> (“I had to break the switch, because I need to call it Firefox, but I can’t include the official graphics. . . . Because it uses graphics which have a non-free copyright license.”).

10. Debian Bug Report Logs - #354622, Uses Mozilla Firefox Trademark Without Permission, Msg. 49 (Sep. 18, 2006), <http://bugs.debian.org/cgi-bin/bugreport.cgi?bug=354622#49> (“That appears to be the only license associated with the logo and it pretty clearly DFSG [Debian Free Software Guidelines]-nonfree.”).

11. Available at <http://www.geticeweasel.org/> (last visited Aug. 13, 2013).

12. Debian Bug Report Logs - #354622, Uses Mozilla Firefox Trademark Without Permission, Msg. 374 (Nov. 27, 2006) <http://bugs.debian.org/cgi-bin/bugreport.cgi?bug=354622#374> (“it’s sad to see that the safer path (renaming Mozilla applications in order to avoid being restricted by any trademark policy) was really the one to choose . . . :- (“This has now happend [sic] . . .”). The entire thread discussing the problem is an interesting read. Debian Bug Report Logs - #354622, Uses Mozilla Firefox Trademark Without Permission, <http://bugs.debian.org/cgi-bin/bugreport.cgi?bug=354622> (last visited Aug. 13, 2013).

13. Debian Project, Package: iceweasel (3.5.16-20), <http://packages.debian.org/squeeze/iceweasel> (last visited Aug. 13, 2013).

encourage widespread use of TDF marks by the community while controlling that use”¹⁴

Further complicating matters, there are also several different categories of people who will want to or will use the trademark. First are the “contributors,” that is, those who participate in creating the software. These project participants are from all over the world.¹⁵ This group can be quite large—the Linux Foundation reports that 9,784 developers representing 1,064 different organizations committed code to Linux between 2005 and 2012.¹⁶ The Gnome Project had over 3,000 individuals commit changes to the code since the project began,¹⁷ and Debian claims 1,000 active volunteer developers around the world.¹⁸ But FOSS projects can also be quite small, with one survey reporting that over half of active projects listed on Ohloh, a website that tracks open source projects,¹⁹ have only one contributor, and 87 percent of the projects have five or fewer committers per year.²⁰

Free and open source projects flourish in an environment of inclusion, participation and collaboration; FOSS would not exist without this type of environment.²¹ Thus, those who participate in

14. The Document Foundation, TDF/Policies & TradeMark Policy, https://wiki.documentfoundation.org/TradeMark_Policy (last visited Aug. 13, 2013); *see also* Mozilla Foundation, Mozilla Trademark Policy (2009) <http://www.mozilla.org/en-US/foundation/trademarks/policy/> (“Mozilla’s Trademark Policy attempts to balance two competing interests: Mozilla’s need to ensure that the Mozilla Marks remain reliable indicators of quality, source, and security; and Mozilla’s desire to permit community members, software distributors, and others with whom Mozilla works to discuss Mozilla’s products and to accurately describe their affiliation with us. Striking a proper balance is a tricky situation that many organizations—in particular those whose products are distributed electronically—wrestle with every day and we’ve attempted to balance it here.”); Wordpress Foundation, Trademark Policy, <http://wordpressfoundation.org/trademark-policy/> (last visited Aug. 13, 2013) (“We’d like to make it easy for anyone to use the WordPress or WordCamp name or logo for community-oriented efforts that help spread and improve WordPress.”).

15. Open Source Contributions by Location, <http://davidfischer.github.io/gdc2/#languages/All> (last visited Sept. 18, 2013) (interactive map of contributions to the top 200 GitHub code repositories during the first four months of 2013).

16. Jonathan Corbet, Greg Kroah-Hartman, & Amanda McPherson, *Linux Kernel Development: How Fast it is Going, Who is Doing It, What They are Doing, and Who is Sponsoring It*, in the Free Linux Foundation Publication, at 7 (2013), available at <http://www.linuxfoundation.org/publications/linux-foundation/who-writes-linux-2013>.

17. Neary Consulting, *The GNOME Consensus: Who Writes GNOME*, at 10 (2010), available at http://www.neary-consulting.com/docs/GNOME_Census.pdf.

18. Debian Project, About Debian: Who Are You All Anyway?, <http://www.debian.org/intro/about#who> (last visited August 2, 2013).

19. Ohloh, <http://www.ohloh.net/> (last visited Aug. 13, 2013).

20. Donnie Berkholz, *Donnie Berkholz’s Story of Data: The Size of Open-Source Communities and Its Impact upon Activity, Licensing, and Hosting*, Redmonk (Apr. 22, 2013). <http://redmonk.com/dberkholz/2013/04/22/the-size-of-open-source-communities-and-its-impact-upon-activity-licensing-and-hosting/>.

21. Matthew Mascord, *How to Build an Open Source Community*, OSS Watch, <http://www.oss-watch.ac.uk/resources/howtobuildcommunity> (last visited Sept. 17, 2013).

creating the software often have a sense of ownership about the project.²² This means that, although they are not employed by the FOSS project, they may feel empowered to act as an employee would, by creating websites that appear to be affiliated with the project, ordering promotional products, distributing versions of the software with different features from those in the canonical repository, speaking publicly as a representative of the FOSS project, setting up local user groups, and sponsoring and attending events that promote the project. It is critically important to the success of a FOSS project that it foster this kind of participation, though, requiring a delicate balance between allowing use of the project mark and ensuring that the mark nevertheless remains a reliable source identifier.

Other potential trademark users are the users and redistributors of the software. The software may be burned onto a disk or preinstalled on hardware, either in original or modified form, all permissible acts under the copyright license.²³ Similarly, there may be service providers who build a business around the software. Traditional software companies will control their relationship with these service providers and distributors through contract, where they will include provisions covering quality control of licensed goods, use of the mark in promotional materials, display standards for the mark, and no-challenge provisions. However, because FOSS software is free for the taking, that is, it is offered under a unilateral contract accepted simply by complying with the conditions stated in the “public” license, the user or distributor of the FOSS software may be entirely unknown to the trademark owner. This results in a very limited contractual opportunity to impose controls on the trademark.²⁴

A FOSS project may be associated with a legal entity. Some provide a wide range of support services,²⁵ while some are largely

(“Community is vital to an open source project. An active and supportive community is the heart of the project.”).

22. Cf. Karl Fogel, *Producing Open Source Software* 36 (2006) (describing a culture where members are encouraged to behave as part of a group).

23. See *supra* note 2 and accompanying text.

24. Some FOSS licenses state expressly what should be understood to be the case in the absence of any statement, which is that the software license is not a trademark license. See, e.g., Apache Software Foundation, *Apache License, Version 2.0*, ¶ 6 (2004), <http://www.apache.org/licenses/LICENSE-2.0.html>; Mozilla, *Mozilla Public License Version 2.0*, para. 2.3 <http://www.mozilla.org/MPL/2.0/> (2012). Most open source licenses, however, do not mention the trademark per se, although they may have a “no endorsement” clause that prohibits using the name of the organization or names of contributors for endorsement purposes. See, e.g., *BSD 3-Clause License*, <http://opensource.org/licenses/BSD-3-Clause> (last visited Sept. 17, 2013) (“Neither the name of the <ORGANIZATION> nor the names of its contributors may be used to endorse or promote products derived from this software without specific prior written permission.”).

25. See, e.g., The Apache Software Foundation, <http://apache.org/foundation/> (last visited Sept. 18, 2013) (hosting software repositories, project webpages and email services

designed to simply support trademark-related activities.²⁶ Alternatively, a corporation may act as the custodian of the trademark, not unlike a corporation established to function as an intellectual property holding entity, and may allow the project a great deal of latitude in its operations.²⁷ Despite this formal association, however, these organizations are in the role of service provider to the project and do not decide directly what attributes the software will have—that is the project’s responsibility.²⁸

But even if a FOSS project does not have a formal legal structure, it will still have a well-defined process for creating software.²⁹ There is generally one official code repository; that is, the true “source” of the sanctioned software.³⁰ There are different ways that a project might control the engineering decisions for the software; for example, the “benevolent dictator” model has one individual who maintains ultimate control over the software³¹ and

and providing organizational, legal, and financial support); The Eclipse Foundation, <http://www.eclipse.org/org/> (last visited Sept. 18, 2013) (stating that the Foundation provides IT services, intellectual property management and development process).

26. See, e.g., Linux Mark Institute, <http://www.linuxfoundation.org/programs/legal/trademark> (last visited Sept. 18, 2013) (“The Linux Mark Institute (LMI) protects the public and Linux users from unauthorized and confusing uses of the trademark and to authorize proper uses of the mark through an accessible sublicensing program.”); SPI, Inc., <http://www.spi-inc.org/projects/services/> (last visited Sept. 18, 2013) (stating that SPI accepts donations, holds funds and tangible and intangible assets, signs contracts, and obtains trademarks for associated projects).

27. See, e.g., The Fedora Project, Trademark Guidelines, https://fedoraproject.org/wiki/Legal:Trademark_guidelines (last visited Sept. 18, 2013) (“Fedora®, the Fedora word design, . . . are trademarks of Red Hat, Inc. . . . Red Hat protects the Fedora Trademarks on behalf of the entire Fedora community.”); Ubuntu, Intellectual Property Rights Policy, <http://www.canonical.com/intellectual-property-policy> (last visited Sept. 18, 2013) (“Canonical owns and manages certain intellectual property rights in Ubuntu and other associated intellectual property . . .”).

28. For example, the Apache Foundation provides support services to many FOSS projects, but each project is responsible for its own engineering decisions. See The Apache Software Foundation, Foundation Project, <http://apache.org/foundation/> (last visited Sept. 23, 2013) (distinguishing the Foundation governance and individual software project governance); SPI, Inc., Relationship Between SPI and Associated Projects, <http://www.spi-inc.org/projects/relationship/> (last visited Sept. 23, 2013) (stating that SPI is a fiscal sponsor but does not govern or control the software projects).

29. See, e.g., Ludovico Pratto, *Governance of Open Source Software Foundations: Who Holds the Power?* Tech. Innovation Mgmt. Rev., Dec. 2012, at 37-42, available at http://timreview.ca/sites/default/files/article_PDF/Pratto_TIMReview_December2012.pdf; Ross Gardler & Gabriel Hanganu, *Governance Models*, OSS Watch, <http://www.oss-watch.ac.uk/resources/governanceModels> (last visited Sept. 18, 2013).

30. See, e.g., Mozilla, Mozilla Trademark Policy, <http://www.mozilla.org/en-US/foundation/trademarks/policy/> (last visited Sept. 18, 2013) (allowing redistribution of software with the Mozilla trademarks so long as they were obtained from the official Mozilla site).

31. The Linux operating system is an example of a benevolent dictator model: one individual, Linus Torvalds, ultimately decides what is included in the Linux kernel. Linux Kernel Newbies, KernelDevViewpoint, <http://kernelnewbies.org/KernelDevViewpoint> (last visited May 14, 2013) (describing how patches ultimately are added to the Linux kernel, with Linus Torvalds deciding what to merge). Torvalds also owns the U.S. trademark

the “meritocracy” model is one where a participant earns more responsibility as he or she continues to demonstrate worth, reaching a point where the individual has the authority to accept new code into the canonical codebase.³²

The project management style associated with FOSS also goes beyond software. For example, the encyclopedia site Wikipedia allows anyone to edit,³³ following a set of collaboratively created rules for decision-making about what should or should not be in entries.³⁴ OpenStreetMap is a worldwide map created through individual contribution³⁵ and there is now also “open source hardware.”³⁶

As a result of these different approaches, oftentimes a FOSS project does not have a clear path to trademarks ownership by one individual or one corporate entity. This attribute of the FOSS project is further compounded by the current state of United States trademark law, which does not recognize multiple owners of a trademark, as discussed in Part IV below.

IV. U.S. LAW ON OWNERSHIP OF TRADEMARKS

Courts have applied a number of different legal doctrines to decide cases involving disputed trademark ownership, which will be reviewed in Part IV.A. Part IV.B will discuss the various types of legal entities that can own trademarks, and we will end with a discussion in Part IV.C of the potential for loss of trademark rights under a theory known as a “naked license.”

registration. United States Patent and Trademark Office, Trademark Status Document and Retrieval, http://tsdr.uspto.gov/#caseNumber=74560867&caseType=SERIAL_NO&searchType=statusSearch (last visited June 5, 2013).

32. See, e.g., Apache Foundation, How It Works: Meritocracy, <http://www.apache.org/foundation/how-it-works.html#meritocracy> (last visited Sept. 18, 2013); Habari Project Wiki, Getting Involved: Meritocracy http://wiki.habariproject.org/en/Getting_Involved#Meritocracy (last visited Sept. 18, 2013) (stating that it follows the Apache model of meritocracy).

33. Wikipedia, <http://en.wikipedia.org/wiki/Wikipedia> (last visited Aug. 2, 2013).

34. Wikipedia, http://en.wikipedia.org/wiki/Wikipedia#Rules_and_laws_governing_content_and_editor_behavior (last visited Aug. 2, 2013). For an interesting view on how individual editing action can go awry, see James Gleick, *Wikipedia's Women Problem*, New York Review of Books (April 29, 2013) <http://www.nybooks.com/blogs/nyrblog/2013/apr/29/wikipedia-women-problem/>.

35. OpenStreetMap home page, <http://www.openstreetmap.org/> (last visited Aug. 2, 2013).

36. Open Source Hardware Association, Definition, <http://www.oshwa.org/definition/> (last visited Sept. 18, 2013) (“Open source hardware is hardware whose design is made publicly available so that anyone can study, modify, distribute, make, and sell the design or hardware based on that design.”).

A. Legal Theories for Deciding Trademark Ownership

In the United States, registration of a trademark does not grant any substantive rights.³⁷ Instead, a registration has only an evidentiary function, serving as prima facie evidence of validity, ownership, and exclusivity of rights.³⁸ Only the owner of a trademark may register it,³⁹ and a registration can be cancelled if the registrant is not the owner of the underlying trademark rights.⁴⁰

Although in the United States ownership of a trademark is not a right granted by registration, there is also no universally accepted legal doctrine for deciding the legitimate owner or first user of the trademark. Approaches can vary widely.

Some courts approach the problem as if the parties have two separate trademarks and determine the first user between the two,⁴¹ applying this method even where the parties have submitted the same evidence as proof of first use.⁴² A court may apply several different theories to choose between the two: it may find that the losing party was a “related company”⁴³ whose use was not for its own benefit but instead inured to the benefit of the winning

37. *In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999) (“The federal registration of a trademark does not create an exclusive property right in the mark. The owner of the mark already has the property right established by prior use. The mark identifies and distinguishes the owner’s goods from others. It also signifies the source and quality of the goods. These attributes are not established or granted by federal registration of the mark. The owner of a trademark need not register his or her mark in accordance with the Lanham Act in order to use the mark in connection with goods or to seek to prevent others from using the mark.”).

38. U.S. Trademark (Lanham) Act of 1946 § 7(b), 15 U.S.C. § 1057(b) (2012).

39. Lanham Act § 1(a), 15 U.S.C. § 1051(a) (2012); *Chien Ming Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 1460 (Fed. Cir. 1988).

40. This is true only for the first five years after the trademark is registered. *See infra* note 96-97 and accompanying text regarding trademarks that have become incontestable.

41. *See, e.g.*, *Knights Armament Co. v. Optical Sys. Tech., Inc.*, 636 F. Supp. 2d 1283, 1296 (M.D. Fla. 2009) *aff'd*, 654 F.3d 1179 (11th Cir. 2011); *Lab. Corp. of Am. v. Schumann*, No. 3:06-CV-01566, 2009 WL 275859, at *4 (D. Conn. Feb. 4, 2009); *O.T.H. Enter., Inc. v. Vasquez*, Cancellation No. 9205056, 2012 WL 5196156, at *11 (T.T.A.B. Sept. 28, 2012); *Gallego v. Santana’s Grill, Inc.*, Cancellation Nos. 92043152, 92043160 & 92043175, 2009 WL 4073531, at *4 (T.T.A.B. May 6, 2009).

42. *Knights Armament Co.*, 636 F. Supp. 2d at 1296 (noting that both parties relied on the same documents, a purchase order, a request for quotation, and a statement of work, as proof of use); *100 Blacks in Law Enforcement Who Care, Inc. v. 100 Blacks in Law Enforcement Who Care, Inc.*, Opposition No. 91190175, 2011 WL 1576733, at *2 (T.T.A.B. Apr. 12, 2011) (noting that both parties relied on the same web page as evidence of first use); *cf.* *Louisiana Athletics Down on the Bayou, L.L.C. v. Bayou Bowl Ass’n*, No. 11-303-BAJ, 2013 WL 2102354, at *3 (M.D. La. May 14, 2013) (noting that all materials attached to the plaintiff’s trademark application as proof of use were created by members of the defendant).

43. *See* Lanham Act § 5, 15 U.S.C. § 1055 (2012) (providing that use of a mark by “related companies” imputes to the owner of the mark as long as the owner is controlling the nature and quality of the goods and services).

party.⁴⁴ It may instead find that the losing party was only an agent of the other party and thus developed no independent trademark rights of its own.⁴⁵ Or, a court might find that the losing party's use was not of a quality and scale to be considered "use in commerce," failing to establish independent trademark rights.⁴⁶

Alternatively, rather than looking at the problem as two marks and two owners, a court may instead recognize that there is a single, unitary property with two claimants to ownership. This results in additional approaches to decide the ownership dispute.

A court may rely on private agreements between parties that allocate ownership of a trademark.⁴⁷ Courts may look solely at who "controls" the use of the mark—that is, who is responsible for the nature and quality of the goods and services with which the mark is used.⁴⁸

A more comprehensive approach has developed in the frequently occurring scenario of goods manufactured by one but marketed by the other.⁴⁹ In this case, the doctrine is well settled.

44. See, e.g., *Estate of Coll-Monge v. Inner Peace Movement, Inc.*, 524 F.3d 1341, 1349 (D.C. Cir., 2008) (reversing district court decision that first use by defendant nonprofit corporations was not a use by related companies for the plaintiff's benefit); cf. *Consumerinfo.com, Inc. v. Money Mgmt. Int'l, Inc.*, No. 07-04275 SJO (EX), 2008 WL 4183928, at *3 (C.D. Cal. Sept. 2, 2008) *rev'd on other grounds*, 374 F. App'x 696 (9th Cir. 2010) (in defendant's challenge to plaintiff's ownership of the mark, finding that parent was a related company of the plaintiff subsidiary so the parent's use inured to the benefit of the subsidiary).

45. See, e.g., *Asociación de Industriales de Puerto Rico v. MarketNext, Inc.*, No. 09-1122 (JAF), 2009 WL 793619, at *8-9 (D.P.R. Mar. 23, 2009).

46. *Louisiana Athletics Down on the Bayou*, 2013 WL 2102354, at *8 (plaintiff did not have his own separate use in commerce after he was no longer associated with the defendant); *Eat BBQ LLC v. Walters*, No. 12-71-GFVT, 2012 WL 5835679, at *5 (E.D. Ky. Nov. 16, 2012) (use of mark in email address, procurement of estimate for signs and emailing menu to other party in litigation did not establish use in commerce); *Knights Armament Co.*, 636 F. Supp. 2d at 1296 (defendant's first public use of the mark was later than the plaintiff's); *Lab. Corp. of Am.*, 2009 WL 275859, at *4 (although the defendant thought of the mark, he did not have use independent from that of the plaintiff).

47. *Premier Dental Prods. Co. v. Darby Dental Supply Co., Inc.*, 794 F.2d 850, 854 (3d Cir. 1986) ("The ownership of a trademark as between a manufacturer and an exclusive distributor is largely determined by the parties' agreement"); see also *E & J Gallo v. Proximo Spirits, Inc.*, No. CV-F-10-411 LJO JLT, 2012 WL 273077, at *10 (E.D. Cal. 2012) (relying on an agreement between the manufacturer and distributor about ownership of the trade dress rights in a tequila bottle configuration); *Green v. Ablon*, No. 09-10937-DJC, 2012 WL 4104792, at *16 (D. Mass. Sept. 17, 2012) (deciding that an employment agreement not only vested ownership of new trademarks in the employer, but also assigned a preexisting one to it).

48. See *Arredondo v. Arredondo*, No. 3:02-CV-2200 CFD, 2010 WL 4929250, at *6 (D. Conn. Nov. 30, 2010) *aff'd*, 460 F. App'x 59 (2d Cir. 2012) (citing *Liebowitz v. Elsevier Sci. Ltd.*, 927 F. Supp. 688, 696 (S.D.N.Y. 1996)).

49. "These relationships usually arise in one of two factual situations: either (1) the manufacturer licenses the distributor to use a trademark owned by the manufacturer, or (2) the distributor owns its own mark, sometimes called a 'private label,' which it affixes to the manufacturer's product before delivery." *Sengoku Works v. RMC Int'l*, 96 F.3d 1217, 1220 (9th Cir. 1991).

First, the agreement generally controls.⁵⁰ There is also a presumption that the manufacturer owns the trademark, but the presumption can be rebutted by considering (1) which party invented and first affixed the mark onto the product; (2) which party's name appeared with the trademark; (3) which party maintained the quality and uniformity of the product; and (4) with which party the public identified the product and to whom purchasers made complaints.⁵¹ Although developed in the context of the manufacturer-distributor relationship, this approach has been extended to other types of relationships, such as resellers⁵² and family disputes.⁵³

Music band names are disputed so often that this area has also developed a specialized doctrine. In these cases, quite contrary to the manufacturer-distributor arena, contracts assigning ownership of the musical group's name to a given party in the relationship may have little effect.⁵⁴ Instead, a court will identify what quality or characteristic a group is known for, and then who controls that quality.⁵⁵

In an effort to create a more predictable method for deciding ownership disputes, this author proposed a single framework that could be applied to all different types of ownership disputes, one that would take into account contractual expectation, responsibility for the quality of the goods and services, and consumer perception.⁵⁶ The proposal has been acknowledged by several courts⁵⁷ but has not been formally adopted.

50. *Id.* But see *Premier Dental Prods.*, 794 F.2d at 854 (stating "While the parties' agreement is important in settling the question of ownership, it is not dispositive. The ownership of the product's goodwill must also be determined. The intent of the parties to create a perception that a particular firm is the legal entity standing behind the mark is not conclusive evidence of what the public actually did perceive but is circumstantial proof, absent evidence to the contrary, that what the parties intended to be the public perception was, in fact, their actual perception." (ellipses and brackets omitted)).

51. *Sengoku Works*, 96 F.3d at 1220.

52. *ZAO Gruppa Predpriyatij Ost v. Vost Int'l Co.*, Opposition No. 91168423, 2011 WL 3828709, at *23 (T.T.A.B. Aug. 9, 2011).

53. *Stephen W. Boney, Inc. v. Boney Servs., Inc.*, 127 F.3d 821, 829 (9th Cir. 1997) (stating that manufacturer-distributor framework would apply to dispute between brothers each selling goods under the same brand); *Arredondo*, 2010 WL 4929250 at *5-6 (discussing factors in context of family business).

54. *Crystal Entm't & Filmworks, Inc. v. Jurado*, 643 F.3d 1313, 1323 (11th Cir. 2011) (holding that, despite three agreements stating that the promoter owned the band name, the band owned the name).

55. *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575, 581 (D. Mass. 1986); see also *Kuklachev v. Gelfman*, 629 F. Supp. 2d 236, 254 (E.D.N.Y. 2008) (extending test to circus act); cf. *Cheng v. Dispeker*, No. 94 CIV. 8716 (LLS), 1995 WL 86353, at *4 (S.D.N.Y. Mar. 2, 1995) (describing two different tests for performance groups).

56. Pamela S. Chestek, *Who Owns the Mark? A Single Framework for Resolving Trademark Ownership Disputes*, 96 TMR 681 (2006).

57. *LunaTrex, LLC v. Cafasso*, 674 F. Supp. 2d 1060, 1073 (S.D. Ind. 2009) (noting suggested test but deciding ownership based on corporate law principles); *C.F.M. Dist. Co.*

B. Organizational Structure

As discussed above, a court might apply a variety of legal doctrines when deciding a question of disputed ownership. Further complicating matters, because a trademark is an indivisible property, it means that a court must identify only one owner.⁵⁸ Any type of legally recognized organization can own a trademark,⁵⁹ but while some types of juristic persons, like corporations and limited liability companies, require an act of formation, others come into existence without any formal act at all.⁶⁰ Therefore, in pursuit of identifying a sole owner, the court may assign ownership of the trademark to an entity that the litigants never contemplated might have ownership rights in the trademark.

For example, in *LunaTrex, LLC v. Cafasso*,⁶¹ various individuals joined together to enter the Google Lunar X Prize competition to land a robot on the moon.⁶² They collectively picked the name “LunaTrex” for their team.⁶³ Things fell apart, and two members of the group each created legal entities—“LunaTrex Inc.”

v. Costantine, Opposition No. 91185766, slip op. at 30, n.44 (T.T.A.B. March 20, 2013), available at <http://ttabvue.uspto.gov/ttabvue/ttabvue-91185766-OPP-83.pdf> (noting article).

58. *Bell v. Streetwise Records, Ltd.*, 761 F.2d 67, 75-76 (1st Cir. 1985) (Breyer and Coffin, JJ., concurring) (“[W]e specify two mistakes that we believe the district court made. First, the court entered a decree that, in effect, left both plaintiffs and defendants free to use the trade name. Even if this result were fair as between the parties, it is not fair in respect to the public. It creates the very ‘source’ confusion that legal trademark, and tradename, doctrine developed to avoid. When arguing parties are, in a sense, both responsible for the success of a name, a court may find it difficult to decide which, in fact, ‘owns’ the name; the temptation may be great to say ‘both own it’ or try to ‘divide’ the name among them. The public interest, however, normally requires an exclusive award.”); *Lunatrex*, 674 F. Supp. 2d at 1075 (“A trademark, however, is not divisible. If it were shared among the different splintered partners, the resulting confusion would destroy the value that each partner worked so hard to create.”).

59. See Lanham Act § 45, 15 U.S.C. § 1127 (2012) (“The term ‘person’ and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term ‘juristic person’ includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.”).

60. See Revised Uniform Partnership Act of 1997 (stating that a partnership has been formed where there is “the association of two or more persons to carry on as co-owners a business for profit forms a partnership, whether or not the persons intend to form a partnership”); *Comm. for Idaho’s High Desert, Inc. v. Yost*, 92 F.3d 814, 819-20 (9th Cir. 1996) (noting that under federal law, an “unincorporated association” is “a voluntary group of persons, without a charter, formed by mutual consent for the purpose of promoting a common objective.”). It may also be a “joint venture,” *Shain Inv. Co., Inc. v. Cohen*, 443 N.E.2d 126, 129 (Mass. App. Ct. 1982) (describing a joint venture as “a partnership of a sort or, at least, it has many of its characteristics. It differs, however, from a partnership in that it is ordinarily, although not necessarily, limited to a single enterprise, whereas a partnership is usually formed for the transaction of a general business.”).

61. 674 F. Supp. 2d 1060 (S.D. Ind. 2009).

62. *Id.* at 1063.

63. *Id.* at 1063.

in Nevada and “LunaTrex, LLC” in Indiana.⁶⁴ Both filed applications to register the trademark.⁶⁵ Once the X Prize Foundation learned of the falling out, the LunaTrex team was suspended from the competition.⁶⁶ The parties then sued each other for trademark infringement.⁶⁷

The court framed the problem this way:

The basic problem here is one that has arisen often in trademark law: a loose and informal group of people start a new band or another new venture, establish a new and valuable trademark, and then have a falling out. In the absence of a formal agreement, how does a court decide who controls the trademark?⁶⁸

The court’s solution here was to find that the main players had created a de facto partnership and the trademark was an asset of the partnership.⁶⁹ Further, the partnership had broken up, and, although as a normal practice partnership assets are distributed among the partners, the court acknowledged that a trademark is not a divisible asset.⁷⁰ The court therefore granted both parties’ motion for preliminary injunction and enjoined all parties from using the mark.⁷¹

Another common situation is where an individual files a trademark application in his or her own name but the trademark is used by an entity of which the individual is sole owner. Lines get blurry when there is a single owner of a legal entity, so it can be hard to distinguish the acts of the individual from the acts of the entity.

For example, in *Restifo v. Power Beverages, LLC*,⁷² an individual, Paul Kidd, filed the trademark application in his own name but had his company grant the trademark license. The Trademark Trial and Appeal Board held in favor of Mr. Kidd’s ownership, finding that the corporation was the alter ego of Kidd

64. *Id.* at 1069.

65. *Id.* at 1067-70.

66. *Id.* at 1069. The ban was until LunaTrex provided Google with clear evidence of the ownership of the name and the team registration. It never did and so did not compete. Pamela Chestek, *LunaTrex Out of the Race*, Property, intangible® (Jan. 9, 2011), <http://propertyintangible.com/2011/01/LunaTrex-out-of-race.html> (last visited June 4, 2013).

67. *LunaTrex, LLC v. Cafasso*, 674 F. Supp. 2d 1060, 1069 (S.D. Ind. 2009).

68. *Id.* at 1072.

69. *Id.* at 1073.

70. *Id.* at 1075.

71. *Id.* See also *Third Educ. Grp., Inc. v. Phelps*, No. 07-C-1094, 2009 WL 2150686, at *4 (E.D. Wisc. May 15, 2009) (holding that defendant created name for use by voluntary association, not for himself personally); *Boogie Kings v. Guillory*, 188 So. 2d 445, 448-49 (La. App. 1966) (band was unincorporated association and ownership of the name was vested in the band, not any individual member).

72. Opposition No. 91181671, 2011 WL 5014028 (T.T.A.B. Sept. 21, 2011).

and therefore the corporation's acts were done at the behest and on behalf of Kidd.⁷³ One treatise agrees with this approach;⁷⁴ however, another court disagreed with the treatise and instead found that under state law a corporation and its single shareholder remain distinct legal entities and the sole shareholder did not own the trademark merely by virtue of her ownership of the corporation.⁷⁵

C. Loss of Ownership

To further complicate matters, a trademark is vulnerable to invalidation if the trademark owner is too lax in monitoring the quality of the goods or services with which the mark is used. Under U.S. law, this legal theory is known as a "naked license" and generally results in total loss of rights.

Different courts vary on the exact parameters of a naked license, but the most unforgiving standard is that of the Court of Appeals for the Ninth Circuit as described in *FreecycleSunnyvale v. Freecycle Network*.⁷⁶ The case defines a naked license this way:

Naked licensing occurs when the licensor fails to exercise adequate quality control over the licensee. Naked licensing may result in the trademark's ceasing to function as a symbol of quality and a controlled source. We have previously declared that naked licensing is inherently deceptive and constitutes abandonment of any rights to the trademark by

73. *Id.* at *4 ("Here, the corporations were essentially the alter egos of the individuals. Accordingly, we construe all relevant activities taken by the companies as having been done at the behest and on behalf of the individuals."). *See also* Gaffrig Performance Indus., Inc. v. Livorsi Marine, Inc., Nos. 99 C 7778 and 99 C 7822, 2003 WL 23144859, at *11 (N.D. Ill. Dec. 22, 2003) (use of the mark by the corporation inured to the sole shareholder's benefit so he owned the mark); *Newton v. Brown*, Opposition No. 91174441, 2011 WL 810222, at *7 (T.T.A.B. Feb. 7, 2011) (trademark was acquired by individual, not his company, and subsequent use by a number of companies he owned inured to his benefit).

74. 2 *McCarthy*, *supra* note 1, § 16:36 ("If a corporation is using a mark, then a principal officer and shareholder is not the 'owner.' It is presumed, however, that a real person who owns all the stock of a corporation controls the corporation so that use of the mark by the corporation inures to the benefit of the real person, who is presumed to be the 'owner' of the mark.")

75. *Taylor v. Thomas*, No. 2:12-CV-02309-JPM, 2013 WL 228033, at *6-7 (W.D. Tenn. Jan. 22, 2013). *See also* *Smith v. Coahoma Chem. Co.*, 264 F.2d 916, 919 (C.C.P.A. 1959) (holding that trademark registered by individual was invalid when the trademark was used only by companies of which he was part owner); *Paul Audio, Inc. v. Zhou*, Cancellation No. 92049924, 2011 WL 6780740, at *11 (2011) (holding that, "because [shareholder] Boning Zhou and [his company] Shenzhen Bao Ye Heng Industrial Development Company Limited are distinctly different entities, Baoning Zhou had never used the mark in his capacity as an individual, and the mark had always been used by Shenzhen Bao Ye Heng Industrial Development Company Limited, the company is the owner of the mark"); *American Forests v. Sanders*, Opposition No. 89370, 1999 WL 1713450, at *5 (T.T.A.B. Sept. 23, 1999) (finding that a trademark application that was filed in the name of an individual, when instead it was the partnership that had the bona fide intent to use the mark, was void ab initio).

76. 626 F.3d 509 (9th Cir. 2010).

the licensor. Consequently, where the licensor fails to exercise adequate quality control over the licensee, a court may find that the trademark owner has abandoned the trademark, in which case the owner would be estopped from asserting rights to the trademark.⁷⁷

An individual started The Freecycle Network (“TFN”) in 2003. The name comes from combining the words “free” and “recycling” and refers to the practice of giving an unwanted item to a stranger, rather than disposing of it, so that the item can continue being used for its intended purpose.⁷⁸ Similar to many open source projects, the organization didn’t have a formal legal entity and operated through a democratic leadership structure.⁷⁹ Local volunteer groups would form through Yahoo! Groups and Google Groups.⁸⁰ The Freecycle Network had a website that provided a directory of member groups and resources for volunteers, including a section with etiquette guidelines.⁸¹

The Freecycle Network operated under the “Freecycle Ethos,” where decisions were made through a process of surveys and discussions among volunteer moderators.⁸² The local volunteer moderators were responsible for enforcing The Freecycle Network’s rules and policies, but the moderators had flexibility in enforcement depending on the moderators’ assessment of their local communities.⁸³ The moderators would collaborate on various matters, like whether they should limit listings to legal items only.⁸⁴

77. *Id.* at 515-16 (Internal quotation marks and citations omitted). Note that the court says that the naked license “may” result in the trademark ceasing to function as a mark, but its analysis did not hinge on determining whether there had been a loss of distinctiveness. Rather, it was based on the owner’s failure to perform adequate acts to control the quality of the goods and services. However, the Fifth Circuit has taken the position that a naked license exists only where the trademark has indeed ceased to function as a mark. *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1079-80 (5th Cir. 1997). Some cases have also held that a naked license is only a partial loss of rights. *See, e.g., Sheila’s Shine Prods., Inc. v. Sheila Shine, Inc.*, 486 F.2d 114, 125-26 (5th Cir. 1973) (limiting abandonment through naked licensing to a specific geographic area); *Patsy’s Italian Rest., Inc. v. Banas*, 575 F. Supp. 2d 427, 453 (E.D.N.Y. 2008), *aff’d*, 658 F.3d 254 (2d Cir. 2011) (limiting loss of rights to two restaurants, not all: “Realty has not engaged in conduct that necessitates a finding of total abandonment of all rights in the marks PATSY’S and PATSY’S PIZZERIA. Most crucially, Plaintiffs have failed to submit any evidence that the marks PATSY’S and PATSY’S PIZZERIA as used by the original East Harlem location have lost their significance as an indicator of the source of Defendants’ pizzeria services.”).

78. *FreecycleSunnyvale*, 626 F.3d at 512.

79. *Id.*

80. *Id.*

81. *Id.*

82. *Id.*

83. *Id.*

84. *Id.* at 513.

The defendant chapter FreecycleSunnyvale was licensed by email to use the Freecycle trademark, with the instructions “just don’t use it for commercial purposes.”⁸⁵ Two years after FreecycleSunnyvale started, for reasons that are unclear, The Freecycle Network sent cease and desist letters to FreecycleSunnyvale.⁸⁶

The Freecycle Network argued that its email prohibition on commercial use, the rule that the members “Keep it Free, Legal & Appropriate for All Ages,” the “Freecycle Ethos,” and the terms of use for Yahoo! Groups were an adequate exercise of control over the use of the mark, but the Court of Appeals disagreed.⁸⁷ It found that The Freecycle Network “engaged in naked licensing and consequently abandoned the trademarks.”⁸⁸ Note the plural “trademarks”: the decision is about the word marks FREECYCLE and THE FREECYCLE NETWORK and also the highly distinctive design shown below:



Figure 1: The Freecycle Network logo

Arguably, FreecycleSunnyvale gives us a bottom threshold, an example of a case in which there is not enough control over the trademark attached to a FOSS project or a similar public project, such as The Freecycle Network. As to how little control is enough to avoid naked licensing, though, we remain in the dark:

We have stated that the standard of quality control and the degree of necessary inspection and policing by the licensor will vary. The licensor need only exercise control sufficient to meet the reasonable expectations of customers. However, because TFN did not establish any quality control requirements for its member groups, we do not need to decide what efforts to oversee a licensee’s performance might meet a low standard of quality control.⁸⁹

85. *Id.*

86. *Id.* at 513-14.

87. *Id.* at 516-18.

88. *Id.* at 520.

89. *Id.* at 519 (internal quotation marks and citations omitted); *see also* *Eva’s Bridal Ltd. v. Halanick Enter., Inc.*, 639 F.3d 788, 791 (7th Cir. 2011) (“Trademark law requires that ‘decisionmaking authority over quality remains with the owner of the mark.’ Restatement § 33 comment c. How much authority is enough can’t be answered generally; the nature of the business, and customers’ expectations, both matter.”)

Further complicating matters, the validity of a mark for promotional goods may also rest on the validity of the mark for the primary goods. For uses that might otherwise be considered “ornamental,” such as on T-shirts, mouse pads, or decals, a mark may nevertheless be considered distinctive for the promotional goods because it indicates a sponsorship relationship.⁹⁰ For example, the words “Mork & Mindy” on T-shirts entailed a trademark use, understood to indicate sponsorship by a television show of the same name.⁹¹ It therefore follows that, because the distinctiveness for promotional goods may rely on the distinctiveness for the primary goods, when the indicator fails to function as a mark for the primary goods under the naked licensing doctrine it might likewise fail to function as a mark for the related promotional goods.

V. MANAGING THE PROJECT AND THE NAME

Above we have divided the legal analysis into two categories: the acts of a trademark owner and the organization that performs them. But because in the United States trademark ownership is a use-based system, a question of ownership is recursive: the entity that acts like the trademark owner becomes, by its actions, the trademark owner.

Nevertheless, we will continue to discuss the two concepts separately. Part V.A will discuss how a FOSS project should behave to show its ownership of the mark and Part V.B will discuss what kind of legal entity the project might be.

A. *The Acts of a Trademark Owner*

As described above, courts will consider a number of factors when deciding who owns a trademark: the owner as identified in the registration,⁹² the owner as identified in any agreements, the inventor of the mark, the party first responsible for affixing the mark to the goods or services, the company’s name that appears on packaging and promotional materials associated with the trademark, the party exercising control over the nature and quality of the product, the party who paid for advertising and promotion, and to the party to whom purchasers make

90. *Go Pro Ltd. v. River Graphics, Inc.*, No. 01CV600JLK, 2006 WL 898147, at *4 (D. Colo. Apr. 5, 2006) (noting that marks can be both ornamental and source-indicating where they are used decoratively on T-shirts and the like but also identify a secondary source of sponsorship); *see also* Trademark Man. of Exam. Proc. § 1202.03 (Apr. 2013) (Allowing an applicant to show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function by submitting evidence that the proposed mark would be recognized as a mark through its use for goods or services other than those being refused as ornamental).

91. *In re Paramount Pictures Corp.*, 213 U.S.P.Q. 1111 (T.T.A.B. 1982).

92. *See supra* note 38 and accompanying text.

complaints.⁹³ Thus a project should optimize all these factors in its favor as much as possible.

Although registration is not required,⁹⁴ registration is a more valuable legal step for FOSS projects than for other types of manufacturing. A registration is *prima facie* evidence of ownership,⁹⁵ and after five years the registration become “incontestable,”⁹⁶ which means that the registration is conclusive evidence of the registrant’s ownership of the mark.⁹⁷ Registering the mark will therefore reduce the likelihood of, or altogether prevent, an ownership challenge. Further, the act of application and registration will force the FOSS project to explore, understand, and make decisions about ownership.

Next, a project should adopt trademark guidelines. They can serve as documentary evidence in support of an ownership claim with respect to many factors a court will consider.

The trademark guidelines can serve the role of a written agreement allocating trademark ownership.⁹⁸ Stating expressly in the guidelines who owns the trademark and that the use of the trademark by project members or unrelated parties is use that inures to the benefit of the owner of the project trademark will aid in forestalling a claim that a third-party use is independent of the project use. If the project itself expresses this understanding about the relationship between the trademark and those who use it, and the party using the mark has expressly or implicitly agreed to the terms, it should predispose a court to come to the same conclusion.

Next is evidence of control. The concept of “control” is used both to identify the owner of a mark and to determine whether

93. See generally 2 McCarthy, *supra* note 1, § 16:48.

94. See *supra* notes 37-39 and accompanying text.

95. Lanham Act § 7(b), 15 U.S.C. § 1057(b) (2012).

96. Lanham Act § 15, 15 U.S.C. § 1065 (2012). There are predicate conditions that must be met before a trademark is incontestable and an affidavit of incontestability must be filed with the U.S. Patent and Trademark Office.

97. Lanham Act § 33(b), 15 U.S.C. § 1115(b) (2012). See also *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198, 105 S. Ct. 658, 83 L. Ed. 2d 582 (1985) (“The incontestability provisions, as the proponents of the Lanham Act emphasized, provide a means for the registrant to quiet title in the ownership of his mark.”).

98. Courts will consider any document that might contain a trademark grant, expressly or impliedly. See, e.g., *Lingo v. Lingo*, 785 F. Supp. 2d 443, 451 (D. Del. 2011) (looking at a will for help in deciding trademark ownership); *Nothing Heavy Inc. v. Levinson*, No. 10 CV 03466 GBD, 2010 WL 4968137, at *4 (S.D.N.Y. Dec. 6, 2010) (holding that a lease amendment addressing registration of the trademark for the restaurant name was not an agreement on the ownership of the name); *Norden Rest. Corp. v. Sons of Revolution in State of N. Y.*, 415 N.E.2d 956, 957 (1980) (holding lessor was the trademark owner where the lease stated “The right to use the name ‘Fraunces Tavern Restaurant’ in connection with Tenant’s business shall be limited to the restaurant business conducted in the premises and to no other business or location, and such right shall terminate upon the expiration or earlier termination of this Lease.”).

there is a naked license.⁹⁹ Of all areas related to ownership and validity of a mark, control therefore is the most significant: the project's ability to demonstrate that it actively supervises the nature and quality of the software and the use of the trademarks associated with such software will help solidify its ownership claim to the mark and avoid an allegation of naked licensing.

First note that the requirement for control relates primarily to the nature and quality of the product, not just the characteristics of the trademark itself.¹⁰⁰ Design guidelines for the logo form of the mark, advice on where to use the ® and ™ symbols, and instructions on how to use the trademark as an adjective, not a noun—while all valuable components of the trademark guidelines—do not demonstrate that there is an exercise of control over the quality of the product, only how the trademark should appear.

Cases that examine control over the quality of the goods do so on a case-by-case basis,¹⁰¹ with the end effect that there is no fixed list of steps to take to ensure that the owner of the trademark is active enough in its oversight. A court may consider who formulated the product,¹⁰² who trained employees,¹⁰³ whether products were inspected,¹⁰⁴ or who was responsible for the overall

99. This is not by happenstance; at least in the Courts of Appeal for the Second and Ninth Circuit both legal doctrines find their statutory basis in the same section of the Lanham Act § 5. Section 5 states, in the context of use by a related company (i.e., a licensee), that “If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.” Lanham Act § 5, 15 U.S.C. § 1055 (2012). It therefore by its terms invokes control over the nature and quality of the goods as the hallmark of ownership. The Second and Ninth Circuits also cite § 5 as the basis for the naked licensing doctrine. *See Siegel v. Chicken Delight, Inc.*, 448 F.2d 43, 51 (9th Cir. 1971) (“The licensor owes an affirmative duty to the public to assure that in the hands of his licensee the trade-mark continues to represent that which it purports to represent. For a licensor, through relaxation of quality control, to permit inferior products to be presented to the public under his licensed mark might well constitute a misuse of the mark. 15 U.S.C. §§ 1055, 1127.”); *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 367 (2d Cir. 1959) (stating that Section 5 imposes a control requirement so that there is not an abandonment through naked licensing).

100. *CNA Fin. Corp. v. Brown*, 922 F. Supp. 567, 574 (M.D. Fla. 1996), *aff’d*, 162 F.3d 1334 (11th Cir. 1998) (“In order for its family’s use of the service marks to be deemed use by CNAF, CNAF must control not only the use of its marks, but also the ‘nature and quality of the . . . services’ associated with the marks.”).

101. In the context of naked licensing, “It is difficult, if not impossible to define in the abstract exactly how much control and inspection is needed to satisfy the requirement of quality control over trademark licensees.” 3 McCarthy, *supra* note 1, § 18:55.

102. *Country Fare LLC v. Lucerne Farms*, No. 3:11CV722 VLB, 2011 WL 2222315, at *1, 9 (D. Conn. June 7, 2011) (holding that company that conceived of a proprietary mulch composition and had it manufactured by another company owned the trademark).

103. *Arredondo v. Arredondo*, No. 3:02-CV-2200 CFD, 2010 WL 4929250, at *7 (D. Conn. Nov. 30, 2010), *aff’d*, 460 F. App’x 59 (2d Cir. 2012) (exercising control by training associates and managing the day-to-day operations of the facilities).

104. *E & J Gallo v. Proximo Spirits, Inc.*, No. CV-F-10-411 LJO JLT, 2012 WL 273077, at *10 (E.D. Cal. Jan. 30, 2012) (requirement that manufacturer deliver product “of the

image of the service.¹⁰⁵ Note that the goods do not have to be identical but instead must only be within a range of predictable quality adequate to meet consumer expectation.¹⁰⁶

Adequacy of control over the nature and quality of free and open source software—or of any kind of software—has never been considered by a court. Nevertheless, there are a number of ways we can speculate that a FOSS project will be able to show that it exercises control. A software project can show that there are one or several canonical repositories for the software and that all copies originate with a single source.¹⁰⁷ Therefore, for those repositories not within the project's control, the project will want to encourage those who provide any alternative repositories to indicate they are not the authoritative repository and where one can obtain the original code.

A project will also want to demonstrate its control over the quality of the software by showing that it has a systematic quality control process for creating the software. For example, a software project could show that only a limited few individuals, the committers, have the ability to decide what ultimately goes into the final product, thus ensuring consistent quality. If it is a project that requires assignment of copyright, it may be able to argue that the ownership of the entirety of the copyright in the software shows its control over the ultimate product. The software project might be able to demonstrate that it has quality control measures in place that assure a new version of the software will not be released if there are critical bugs.

The project must also be able to demonstrate that it controls the nature and quality of goods produced by others, that is, by

highest quality and in good and merchantable condition” and that the distributor performed chemical, sensory, and related analyses on every production lot and every bottling run was control of the nature and quality of tequila).

105. O.T.H. Enter., Inc. v. Vasquez, Cancellation No. 9205056, 2012 WL 5196156, at *9 (T.T.A.B. Sept. 28, 2012) (registrant owned the mark because he added unique characteristics such as lighting, costumes, musical arrangement and overall sound).

106. TMT N. Am., Inc. v. Magic Touch GmbH, 124 F.3d 876, 886 (7th Cir. 1997) (citing Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 387 (5th Cir. 1977)) (“Admittedly, licensing always entails some loss of control over product quality. If a licensor maintains reasonable control over product quality, however, consumers ultimately do rely upon the licensor’s quality control. Absent a significant deviation from the licensor’s quality standards, a licensor does not forfeit its trademark rights through licensing agreements.”); Kevin Parks, “*Naked*” Is Not a Four-Letter Word: Debunking the Myth of the “Quality Control Requirement” in Trademark Licensing, 82 TMR 531, 536 (1992) (explaining that a trademark owner that manufactures its own goods can make goods of diverse quality without risking the trademark).

107. Note that in *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509 (9th Cir. 2010) (discussed *supra* in notes 76-89 and the accompanying text) the FREECYCLE mark was used only for a service. In what may be a significant distinction, a FOSS project creates a product, software. Being able to point to a product with a canonical source should help a FOSS project distinguish its situation from *Freecycle*, even though there is some similarity in the management style of FOSS projects and the Freecycle Network.

users and redistributors,¹⁰⁸ to avoid invalidation by naked license. This is another role for the trademark guidelines.

Trademark jurisprudence has never dealt with the concept of a public trademark license, that is, a license granted to anyone who complies with the conditions of the license, without requiring execution, meaning that the licensee may be unknown. It is outside of any discussion by the courts and legal scholars that a trademark licensee may be unknown.¹⁰⁹ Therefore a public trademark license may provoke a challenge that it is a naked license, even if trademark ownership is clearly attributable to one entity or individual.

However, in the author's opinion there is no fundamental problem with the public license concept. As noted, the concern of trademark law is to ensure that the goods are of consistent quality. If the conditions described in trademark guidelines are clear enough that a licensee complying with the terms necessarily creates a product that will be of adequate quality and meet consumer expectations, then the policy basis for the naked licensing doctrine is not implicated.¹¹⁰

We have examples in currently existing FOSS trademark guidelines showing different ways projects handle permission to reproduce, modify, and distribute software using the mark. For example, Mozilla, distributor of the Firefox browser and the Thunderbird email client, permits use of its trademarks for the redistribution of copies of its software only if the software is unmodified.¹¹¹ The Document Foundation, distributor of the LibreOffice office software suite, permits the use of its mark only for versions of the software in "substantially unmodified form," where "substantially unmodified" means software that is built from The Document Foundation source code with only minor modifications, such as enabling or disabling of certain features by default, translations into other languages, changes required for

108. See *supra* notes 22-23 and accompanying text.

109. See, e.g., *In re XMH Corp.*, 647 F.3d 690, 696 (7th Cir. 2011) (noting that, as a default, a trademark license is not assignable because of the need for quality control: the trademark owner "will have picked his licensee because of confidence that he will not degrade the quality of the trademarked product").

110. *Doebler's Pennsylvania Hybrids, Inc. v. Doebler*, 442 F.3d 812, 823 (3d Cir. 2006) ("[L]icensing arrangements are permissible so long as the license agreement provides for adequate control by the licensor of the nature and quality of the goods or services."); *Arthur Murray, Inc. v. Horst*, 110 F. Supp. 678, 680 (D. Mass. 1953) (holding that the contract provisions that controlled licensee's method of operation were adequate to avoid a naked license).

111. Mozilla Foundation, *Mozilla Trademark Policy for Distribution Partners*, v. 0.9 (DRAFT), <https://www.mozilla.org/foundation/trademarks/distribution-policy.html> (last visited Sept. 27, 2013) ("You may distribute unchanged official binaries downloaded from mozilla.com to anyone in any way subject to governing law, without receiving any further permission from Mozilla Corporation. However, you must not remove or change any part of the official binary, including Mozilla trademarks.").

compatibility with a particular operating system, or bundling the software with additional fonts, templates, artwork, and extensions.¹¹² The OpenJDK project, which develops a free and open source implementation of the Java Standard Edition Platform, permits use of its trademark for “a substantially complete implementation of the OpenJDK development kit or runtime environment source code retrieved from [an official website], and the vast majority of the Software code is identical to that upstream Original Software,” with some exceptions.¹¹³ OpenStack, a cloud computing project, provides for the use of the trademark if the software passes a test suite.¹¹⁴ Some projects take the safest route, which is to require a bilateral license with anyone who wishes to use the trademark for software.¹¹⁵ There is no way to predict whether these licenses would pass muster, but they do demonstrate an effort to ensure that the trademark is used only for goods that consumers will perceive as having the same quality and functionality as the original product.

The trademark policy should also cover use of the trademark for promotional nonsoftware goods, like T-shirts, mugs, decals, and keychains. The standard for control over these types of goods, however, is probably more relaxed:

If a licensee uses the trademark of a beer or soft drink manufacturer on clothing or glassware, for example, prospective purchasers may be unlikely to assume that the owner of the trademark has more than perfunctory involvement in the production or quality of the licensee’s goods even if the manner of use clearly indicates sponsorship by the

112. The Document Foundation, TDF/Policies & TradeMark Policy, https://wiki.documentfoundation.org/TDF/Policies/TradeMark_Policy (last visited Sept. 27, 2013); *see also* Sugar Labs, Trademark, <http://wiki.sugarlabs.org/go/Trademark> (last visited Sept. 27, 2013) (similar); ArchLinux, DeveloperWiki:TrademarkPolicy, <https://wiki.archlinux.org/index.php/DeveloperWiki:TrademarkPolicy> (last visited Sept. 27, 2013) (defining “remixes” as derivative works and permitting trademark use for remixes with minor changes such as adding applications from the archives or removing default applications, but not removing or changing any infrastructure components).

113. OpenJDK Trademark Notice, v.2011/11/11 (2011), <http://openjdk.java.net/legal/openjdk-trademark-notice.html>.

114. OpenStack Cloud Software, How To License The Powered By OpenStack Logo, <http://www.openstack.org/brand/powered-by-openstack/> (last visited Sept. 27, 2013) (“As of January 1st, 2012, your product must pass any Faithful Implementation Test Suite (FITS) defined by the Technical Committee that will be made available on <http://www.openstack.org/FITS>, to verify that you are implementing a sufficiently current and complete version of the software (and exposing associated APIs [application program interfaces]) to ensure compatibility and interoperability. Your product will be required to pass the current FITS test on an annual basis, which will generally require you to be running either of the latest two software releases.” Note, however, that the test suite was not yet available at the identified website at the time of this writing).

115. *See, e.g.*, Perl Foundation, Perl Trademark, http://www.perlfoundation.org/perl_trademark (last visited Sept. 27, 2013) (requiring specific permission to use trademarks for conferences and software).

trademark owner. On the other hand, if the licensee's use is on goods similar or identical to those produced by the trademark owner, purchasers may be likely to assume that the goods are actually manufactured by the owner of the mark. Greater control by the licensor may then be necessary to safeguard the interests of consumers who may purchase the goods on the basis of the licensor's reputation for quality.¹¹⁶

There should nevertheless be some effort to have standards that will ensure consistent quality, like the use of vendors authorized by the project or specifications of level of quality for the promotional product.

The remaining facts that courts have looked at in trademark ownership cases are of less weight and will not save a situation where the owner has not controlled the quality of the goods and services. Nevertheless, the project can position itself to its best advantage by documenting the creation of any logos and ideally owning the copyright in the logo design.¹¹⁷ The project should document when the name was chosen, when it had its first public visibility on a website or project hosting site, when the software was first made available in alpha, beta, and general availability, and the users to which the software was made available.¹¹⁸ A project's staffing of software support channels, like forums, email lists, and Internet Relay Chat (IRC) rooms, will also demonstrate its ownership of the mark.¹¹⁹

Projects should discourage third parties from using the project trademark in a way that might suggest that the third party has some kind of control or oversight over the project and ask them to disclaim any official relationship with the project.¹²⁰ Any in-kind contributions to the project, such as placement of advertising,¹²¹ or the contribution of hardware or server space, should be documented, at least informally with an email, as a contribution

116. Restatement (Third) of Unfair Competition § 33, cmt. c (1995); *see also* Experience Hendrix, LLC. v. Elec. Hendrix, LLC., No. C07-0338 TSZ, 2008 WL 3243896 at *7 (W.D. Wash. Aug. 7, 2008) ("The type of quality control required to prevent abandonment varies with the circumstances").

117. *See supra* note 93 and accompanying text noting that who invented the mark is a factor. Owning the copyright in the logo means that the project will have full control over its use. Another option would be to take an exclusive license, including to the exclusion of the logo designer-copyright owner, so that the owner cannot license it to others.

118. *See supra* note 93 and accompanying text noting that who first affixed the mark is a factor. What is considered a "use" in which trademark rights first arise is a complicated legal question and outside the scope of this article.

119. *See supra* note 93 and accompanying text noting that "to whom customers make complaints" is a factor.

120. *See supra* note 93 and accompanying text noting that who the packaging and promotional materials identify as the owner is a factor.

121. *See supra* note 93 and accompanying text noting that who paid for advertising or promotion is a factor.

for the benefit of the project. This will avoid any ambiguity about ownership, for example, because the software is hosted on hardware owned by someone else.

The author has created a Model Trademark Guidelines project¹²² that incorporates the above recommendations, and welcomes others' participation in the project.

B. Who Is Performing the Acts?

We have seen the steps a project should take to ensure that a court would reach a legal conclusion that the project owns the trademark and that it is valid and can withstand a naked license challenge. But the analysis begs the question—who, exactly, is the person or organization that makes up the “project” that is performing these acts?

As described above,¹²³ any type of legal entity—whether an individual, a partnership, an unincorporated association, a corporation, etc.—may own a trademark. All are legally valid choices, so it becomes a question of which person, natural or juristic, is behaving like the trademark owner?

1. Initial Ownership

When a project begins, one individual may be the main decision-maker—he or she has written the bulk of the code, picked the name, and set up the source code repository and website. In this situation the owner of the trademark would clearly be the individual.

It may be instead that the ownership of the mark vests in more than one person, for example, where two or more individuals collaborate equally to create the project. This, in theory, could be problematic because it may mean that the trademark is not functioning as a mark (that is, as a sole source identifier), if there are two owners acting independently.¹²⁴ Nevertheless, where the individuals are contributing to the same codebase the risk is minimal because there is only one product.

Where individuals are acting in concert, they may, in fact, be considered a common law partnership or unincorporated voluntary association. Neither type of legal entity requires any filing or formal act to come into existence;¹²⁵ instead, they will exist because the law imposes legal structure on concerted acts.

122. Model Trademark Guidelines, <http://modeltrademarkguidelines.org> (last visited Sept. 27, 2013).

123. See *supra* note 59 and accompanying text.

124. 2 McCarthy, *supra* note 1, § 16:40 n.2.30 (disfavoring joint ownership).

125. See *supra* note 60.

Informal legal organization is not uncommon. Courts have had to deal with trademark disputes with many kinds of volunteer organizations, like church groups, charities, and clubs. The typical scenario is that a group of individuals will come together to work on a common project or interest, have a falling out, and each then claim to own the name¹²⁶—a scenario that can easily arise with a FOSS project.¹²⁷

With FOSS projects, however, because there generally is some thought about project governance and perhaps documentation of it, the project may be better off than other types of organizations when a court is trying to identify the owner. A “benevolent dictator” model may mean that the so-called dictator owns the trademark because he or she is the ultimate decision-maker about the finished product.¹²⁸ A meritocracy model may indicate that it is a partnership or voluntary association that owns the mark.

But there is risk in leaving the question of who owns the mark for a court to sort out. If a FOSS project was challenged, an adjudicator may indeed find that the project (whether it is an individual, partnership, or unincorporated association) is the owner of the project trademark and prohibit the challenger from using the mark. If a FOSS project was unlucky, though, after a falling out it may find that there is a stalemate and no one will be allowed to use the name going forward.¹²⁹

It is therefore best to remove as much ambiguity as possible about who owns the trademark, while still ensuring that the owner in name is acting like the owner in fact. In practical terms, this

126. *See, e.g.*, *Gemmer v. Surrey Services for Seniors, Inc.*, No. 10–810, 2010 WL 5129241, at *20 (E.D. Pa. Dec. 13, 2010) (adopting magistrate’s report and recommendation holding that senior center, not the volunteer who thought of the name for and organized a charitable event, owned the trademark for the event); *St. Denis Parish v. Van Straten*, Cancellation No. 92051378, 2011 WL 5014036, at *4 (T.T.A.B. Sept. 28, 2011) (same); *100 Blacks in Law Enforcement Who Care, Inc. v. 100 Blacks in Law Enforcement Who Care, Inc.*, Opposition No. 91190175, 2011 WL 1576733, at *4 (T.T.A.B. Apr. 12, 2011) (deciding which of two factions of an organization was the owner of the trademark).

127. For example, Tim Fox created the Vert.x project while at VMware. When he departed VMware for Red Hat, VMware demanded he turn over the Vert.x Github project, the Vert.x Google Group, the domain vertx.io, and the Vert.x blog. Google Groups, An Important Announcement to the Vert.x Community (2013), <https://groups.google.com/forum/#!msg/vertx/gnpGSxX7PzI/BGhj2PqScY8J> (last visited June 5, 2013). Ultimately everyone agreed to move the project to an independent owner, the Eclipse Foundation. Google Groups, Community: Please Make Any Objections Known! (2013), <https://groups.google.com/d/msg/vertx/WIuY5M6RluM/gAvWftxSegUJ> (last visited June 5, 2013).

128. *See supra* note 31.

129. *See, e.g.*, *LunaTrex, LLC v. Cafasso*, 674 F. Supp. 2d 1060, 1062 (S.D. Ind. 2009) (finding that, in the absence of an agreement, the trademark was developed and used by a de facto partnership or joint venture, that all members of the partnership or joint venture were equally entitled to use the mark, and that none would be allowed to use it over the objections of the others; author cited); *Liebowitz v. Elsevier Sci. Ltd.*, 927 F. Supp. 688, 696 (S.D.N.Y. 1996) (noting that if the source is not uniquely plaintiffs or defendants, but some combination of their joint efforts, then the public would be confused by either party’s independent production of journals without the other’s input).

means that the project should publicly state who owns the mark, make it clear who may act on behalf of the trademark owner, and allow only the owner to enter into agreements regarding the marks. For example, trademark guidelines should name the owner and provide contact information for how to reach someone with authority to permit use of the mark.¹³⁰

Another risk in a highly collaborative environment can be the lack of clarity about who is in the legal position of trademark owner and who is in the legal position of licensee. FOSS project trademark guidelines typically do not differentiate between a licensed use—which is the kind of use that puts the trademark at risk—and a referential use, or “nominative fair use,”¹³¹ which does not. Further, many project participants have a sense of ownership of the project; such a participant behaves as if he or she is the trademark owner, by setting up independent websites or making promotional goods. Where many different people are behaving like the trademark owner, a court may find that the many uses are not inuring to the project’s benefit but rather are evidence of naked licensing. Ensuring that the trademark guidelines are clear about uses that are pursuant to a license¹³² and ensuring that such uses are described with enough detail that they will be considered controlled uses¹³³ will increase the odds that a court will see the relationship between the project and trademark users as licensor-licensees rather than uses by “legal strangers”¹³⁴ that invalidate the trademark.

130. See, e.g., Gnome Foundation, Legal and Trademarks, <https://www.gnome.org/foundation/legal-and-trademarks/> (last visited June 2, 2013) (stating “One of the functions that the GNOME Foundation provides is to act as the legal owner for such GNOME project assets as the GNOME name and the GNOME foot. We must protect these trademarks in order to keep them. Therefore, we have some guidelines for their use and a standard agreement for user groups. These cover many common situations; if you need permission to use the GNOME trademarks in other ways or have other questions, please contact licensing@gnome.org.”).

131. “Nominative fair use” is where the defendant has used the plaintiff’s mark to describe the plaintiff’s product for the purpose of, for example, comparison to the defendant’s product. This is contrasted with “classic fair use,” where the defendant has used the plaintiff’s mark to describe the defendant’s own product. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002).

132. The Model Trademark Guidelines, cited *supra* in note 122, take this approach.

133. See *supra* notes 102-116 and accompanying text.

134. *Midwest Fur Producers Ass’n v. Mutation Mink Breeders Ass’n*, 127 F. Supp. 217, 229 (W.D. Wis. 1954) (“Said defendant has over a substantial period of time consented to the use of such names by many who were legally strangers to it, and has and is, in effect, offering to license and licensing anyone to use said names upon the payment to said defendant of a stipulated royalty or fee. Such practice is an unlawful and improper use of a trade-mark or claimed trade-mark, and amounts to an abandonment of any trade-mark rights that might otherwise exist in any names so used, and creates an estoppel against the assertion of trade-mark rights.”)

2. Changes in Organizational Structure

Like any other kind of business, the answer to the question “who owns the mark” may not be the same over time as a project evolves. Throughout the project’s growth and during any transitions, such as forming a corporation or adopting a formalized governance model, the project should be reevaluating the factors a court will consider in deciding who owns the trademark and act accordingly. For example, if the project transitions from a situation where the person who started the project approves all the commits to a more distributed commit authority, or a formal legal entity is created,¹³⁵ the project should reevaluate who owns the trademark and ensure that succession is clear, preferably through formal written assignment, whether or not the trademark is registered.

However, just because an organization is formed does not necessitate a change of ownership of the trademark. The new organization must be the one now taking the actions of a trademark owner and exercising true oversight of the software product and related promotional products and services.

VI. CONCLUSION

A trademark may be a FOSS project’s most valuable asset, protecting the reputation and goodwill of the project and ensuring that users get the features and functions they desire. Courts already struggle with the proper legal framework to be used to identify the trademark owner. The business model for FOSS projects increases the potential for a legal decision against the project’s favor because it is nontraditional and unfamiliar and has an express grant of the right to make new copies of the product.¹³⁶

But a few fairly simple steps outlined above—registering the trademark, adopting trademark guidelines, and presenting a consistent appearance as the trademark owner—will reduce the likelihood of a challenge and a loss of rights.

135. See, e.g., *Third Educ. Group, Inc. v. Phelps*, 675 F. Supp. 2d 916, 922 (E.D. Wis. 2009) (holding that under state law, because the parties intended the corporation to be a successor to the voluntary association, the association’s property, including the trademark, passed to the corporation).

136. For an explanation of why a FOSS copyright license is not a trademark license, see Pamela S. Chestek, *The Uneasy Role of Trademarks in Free and Open Source Software: You Can Share My Code, But You Can’t Share My Brand*, 102 TMR 1028, 1034-37 (2012).