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## Hacking Trademark Law for Collaborative Communities

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### Cover Page Footnote

The views expressed in this Article do not necessarily reflect the views of our employers or any other organization. We would like to thank Shaila Nathu and Jessica Tam for their excellent research assistance. We also would like to thank BJ Ard, Thomas Barton, Andrea Rush, Joanna Sax, Luis Villa, participants at the NYU 2nd Thematic Conference on Knowledge Commons, the 2014 Works-In-Progress Intellectual Property Conference at Santa Clara University School of Law, and the staff and affiliates at the Stanford Center for Internet and Society for their feedback on this research. Finally, we would like to thank the Wikimedia community for the inspiration and for their strong commitment to ensuring trademark practices fit collaborative values.

# Hacking Trademark Law for Collaborative Communities

Yana Welinder & Stephen LaPorte\*

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## INTRODUCTION

We are all surrounded by software and content that is developed by collaborative communities.<sup>1</sup> Over a billion people today use Android mobile devices<sup>2</sup> that incorporate the collaboratively developed Linux kernel.<sup>3</sup> Millions of people use the Linux operating system on their desktop computers,<sup>4</sup> often using Ubuntu<sup>5</sup> or Red Hat<sup>6</sup> distributions. Every fourth Internet user accesses the Internet via the collaboratively developed Firefox browser.<sup>7</sup> And even those that don't use an open source browser or device to access the Internet still use open source software online as 55% of all websites run Linux or BSD<sup>8</sup> and 60.4% of all servers for websites run

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<sup>1</sup> See YOCHAI BENKLER, *THE WEALTH OF NETWORKS* 64 (2006), available at [http://www.benkler.org/Benkler\\_Wealth\\_Of\\_Networks.pdf](http://www.benkler.org/Benkler_Wealth_Of_Networks.pdf).

<sup>2</sup> See Justin Kahn, *Google shows off new version of Android, announces 1 billion active monthly users*, TECHSPOT (June 25, 2014, 1:00 PM), <http://www.techspot.com/news/57228-google-shows-off-new-version-of-android-announces-1-billion-active-monthly-users.html>.

<sup>3</sup> See Jerry Hildenbrand, *Ask AC: Is Android Linux?*, ANDROIDCENTRAL (Nov. 8, 2012, 6:57 PM), <http://www.androidcentral.com/ask-ac-android-linux>.

<sup>4</sup> See Joey-Elijah Sneddon, *At \$200 to \$400, Are Ubuntu Phones Priced for Success?*, OMG!UBUNTU (Mar. 12, 2014), <http://www.omgubuntu.co.uk/2014/03/ubuntu-phones-priced-at-200-400-dollars>.

<sup>5</sup> See *id.*

<sup>6</sup> See Drew Robb, *Linux Desktop Comparison: Red Hat, Novell, Ubuntu, Fedora*, DATAMATION (Jan. 14, 2010), <http://www.datamation.com/osrc/article.php/3858611/Linux-Desktop-Comparison-Red-Hat-Novell-Ubuntu-Fedora.htm>.

<sup>7</sup> *Browser Statistics*, W3SCHOOLS.COM, [http://www.w3schools.com/browsers/browsers\\_stats.asp](http://www.w3schools.com/browsers/browsers_stats.asp) (last visited July 27, 2014).

<sup>8</sup> See *Usage Statistics and Market Share of Unix for websites*, W3TECHS, <http://w3techs.com/technologies/details/os-unix/all/all> (last visited Nov. 2, 2014).

Apache.<sup>9</sup> The most widely used Internet platforms, like Google, YouTube, Twitter, Facebook, and Flickr, all rely on the open source database server MySQL.<sup>10</sup> Thirty-two percent of the top 100 blogs on the Internet use the collaboratively developed WordPress software.<sup>11</sup> What's more, the world's largest online encyclopedia, Wikipedia—which regularly ranks in the top search results for a topic—provides articles and photos created by thousands of volunteers around the world and is built on the collaboratively developed MediaWiki software.<sup>12</sup> The MediaWiki software is used by big entities such as Intel<sup>13</sup> and the US government,<sup>14</sup> as well as thousands of individual wikis online.<sup>15</sup>

All of these sites, platforms, and devices to some extent use software or content to which anyone can contribute. Contributors rely on the free licenses of that software or content to create derivative works without asking for permission.<sup>16</sup> Given how freely contributors can share or remix a collaborative project's code or content, one might expect that the name or logo that represents the project can be used just as freely under the same conditions. This can be a point of confusion and controversy in collaborative communities. One example is the dispute that arose between the Mozilla Foundation and the Debian developer community around 2004. The Mozilla Foundation, which led the collaborative development of the Firefox browser, prohibited the use of the "Firefox" mark in

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<sup>9</sup> *Usage of Web Servers for websites*, W3TECHS, <http://w3techs.com/technologies/overview/webserver/all> (last visited Oct. 27, 2014).

<sup>10</sup> *MySQL Customers by Industry*, MYSQL, <http://www.mysql.com/customers/industry/?id=> (last visited Oct. 25, 2014).

<sup>11</sup> *The 8 most successful open source products ever*, PINGDOM (May 29, 2009), <http://royal.pingdom.com/2009/05/29/the-8-most-successful-open-source-products-ever/>.

<sup>12</sup> MEDIAWIKI, <https://www.mediawiki.org/wiki/MediaWiki> (last visited Oct. 25, 2014).

<sup>13</sup> *MediaWiki Testimonials*, MEDIAWIKI, [http://www.mediawiki.org/wiki/MediaWiki\\_testimonials](http://www.mediawiki.org/wiki/MediaWiki_testimonials) (last visited Oct. 25, 2014).

<sup>14</sup> See Steve Vogel, *For Intelligence Officers, A Wiki Way to Connect Dots*, WASH. POST (Aug. 27, 2009), <http://www.washingtonpost.com/wp-dyn/content/article/2009/08/26/AR2009082603606.html>.

<sup>15</sup> See *MediaWiki Testimonials*, *supra* note 13.

<sup>16</sup> See *What is open source?*, OPENSOURCE.COM, <http://opensource.com/resources/what-open-source> (last visited Oct. 25, 2014).

software that had not been approved by the Foundation.<sup>17</sup> The Foundation likely imposed this requirement in an attempt to control the quality of products labeled with the Firefox brand as required by trademark law in order to retain trademark rights in the brand.<sup>18</sup> Mozilla's trademark allowed the Foundation to protect users from confusing products such as malicious code disguised as a Firefox browser and provided a unique identifier for the Mozilla developer community to organize around the Firefox project.<sup>19</sup> But Debian developers claimed that the Mozilla restriction was incompatible with Debian's Free Software Guidelines, and that Firefox could therefore not be included in the Debian operating system.<sup>20</sup> After an unsuccessful attempt to reconcile their differences with a trademark license, Debian created an alternative to Firefox based on the Firefox codebase, which they antagonistically named "Iceweasel."<sup>21</sup> This was a lose-lose situation for both collaborative communities: Mozilla did not benefit from Debian users' recognition of the Firefox branding, while Debian provided its users with what appeared to be an obscure web browser. As a result, users had to differentiate between two browsers that were functionally equivalent.<sup>22</sup>

The Firefox-Icweasel dispute illustrates an important source of controversy within collaborative communities—members of a collaborative community tend to hold their logos and branding very dearly, and they want the mark to be protected from misuse by others who do not share the same ideals or goals. Trademark law can

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<sup>17</sup> See *Firefox Branding*, MOZILLA, <https://www.mozilla.org/en-US/styleguide/identity/firefoxos/branding/> (last visited Oct. 25, 2014).

<sup>18</sup> See 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 3:10 (4th ed. 2014) (explaining that failure to control quality by licensees can result in a finding of abandonment of a mark).

<sup>19</sup> See *id.*; *New Round of Releases Extends Mozilla Projects Standards Based Open Source Offerings*, MOZILLA (Feb. 9, 2004) available at <http://www-archive.mozilla.org/press/mozilla-2004-02-09.html>.

<sup>20</sup> *Mozilla Corporation software rebranded by the Debian project*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Mozilla\\_Corporation\\_software\\_rebranded\\_by\\_the\\_Debian\\_project](http://en.wikipedia.org/wiki/Mozilla_Corporation_software_rebranded_by_the_Debian_project) (last visited Feb. 6, 2015).

<sup>21</sup> See *id.*

<sup>22</sup> E-mail from Roberto C. Sanchez, Developer, The Debian Project, to Debian Developers (Oct. 15, 2006, 10:11:08 EST) available at <https://lists.debian.org/debian-devel/2006/10/msg00665.html> ("Beyond [the minor differences], they will be basically identical.").

offer protection for logos and brandings, but it imposes duties on the trademark's owner.<sup>23</sup> These duties may be inconsistent with the practices of most collaborative communities, which depend on a sharing ethos, decentralized decision-making, and a sense of joint ownership over the project.<sup>24</sup> Over the years, collaborative communities have come up with different solutions to reconcile the conflict between trademark law and collaborative culture, but these solutions have been developed on an ad hoc basis, sometimes without a thorough analysis of existing solutions or an examination of other possibilities offered by trademark law.<sup>25</sup>

This Article seeks to clarify the problem of applying trademark law to the work of collaborative communities and offers a taxonomy of solutions that collaborative communities have developed to address this problem. Part I begins by discussing the requirements under trademark law and exploring the problems caused by the requirements for centralized control and licensing standards. It then uses Yochai Benkler's model of commons-based peer production to introduce collaborative communities, their governance and structure, and their values. It examines why collaborative communities need trademark law for their operations and poses the conflict between the legal requirement for quality control and the values of decentralization and non-hierarchical structure held by collaborative communities.

Part II looks at different solutions that have been developed by collaborative communities over the years and categorizes these solutions into a taxonomy. We refer to these solutions as "hacks" to the trademark system,<sup>26</sup> analogizing to the process of writing pieces of software to fill a gap or add a functionality to an existing program. The first category of hacks focuses on how trademarks are held for a collaborative community under trademark law, which does not recognize the community as a legal holder of a mark. The second category of hacks discusses the types of trademarks that can

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<sup>23</sup> See 87 C.J.S. *Trademarks, Etc.* § 256 (2010).

<sup>24</sup> See *infra* Part I.B.1.

<sup>25</sup> See *infra* Part II.

<sup>26</sup> As explained in Part II, we call these solutions "hacks" because rather than seeking to amend trademark law, collaborative communities have used existing trademark principles in creative ways to serve projects that are very different from the traditional business models trademark law was intended to address.



be held on behalf of a community. The third category discusses what restrictions are appropriate for marks that represent the work of collaborative communities. The hacks in the final category deal with designing trademark restrictions in a community-friendly manner. This category includes developing a public trademark licensing model and a proposed policy, which is illustrated with the Collaborative Mark Policy (CollabMark) in the Appendix.

Finally, Part III introduces an assessment of the different solutions. It identifies a number of elements that may be important to consider when deciding whether or not to adopt any of the solutions for any particular collaborative community. Broadly, this Article seeks to map out an application of trademark law that has been largely unexplored in academic writing. The taxonomy is intended to provide a foundation for continued debate on how to best protect the work of collaborative communities, particularly as collaborative work is gaining more significance in our information economy. Some of these hacks may not actually resolve the conflict between trademark law and collaborative culture. Some may only offer limited help when combined with other hacks and only for a subset of collaborative communities. Most of them have never been tried in court and so may hold some legal risk. As with many other types of hacks, the trademark hacks outlined in this Article may ultimately need to be replaced by code that provides a more holistic patch to the identified “bug”<sup>27</sup> in the trademark system. The holistic solution may be legal reform or some sort of technology that provides the desired brand recognition without unnecessarily burdening contributors who want to promote the projects on which they work.<sup>28</sup>

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<sup>27</sup> A “bug” is a term for a software or hardware defect. In the jargon of software engineers, a “hack” is a temporary solution for a “bug.” See *generally* *Software bug*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Software\\_bug](https://en.wikipedia.org/wiki/Software_bug) (last visited Aug. 21, 2014).

<sup>28</sup> Lawrence Lessig has eloquently articulated the idea of technical regulation or “West Coast Code,” which refers to code written by engineers in Silicon Valley, in contrast to legal code or “East Coast Code” written by lawmakers in Washington, D.C. See LAWRENCE LESSIG, *CODE AND OTHER LAWS OF CYBERSPACE* 53–54 (1999).

## I. WHY TRADEMARK LAW IS PROBLEMATIC FOR COLLABORATION

Trademark law protects the relationship between a brand and a consumer's expectations about the origin of the good or service that accompanies that brand.<sup>29</sup> In enabling this protection, trademark law imposes certain duties on trademark holders, such as the duty to control the quality of the good or service that carries the brand.<sup>30</sup> This Part of the Article will begin with an overview of the requirements for trademark protection, the naked licensing doctrine, and the risk of a mark becoming too generic for protection. Next, this Part will continue with an introduction to collaborative communities and describe their common characteristics. This discussion will focus on open source and free culture communities, their governance, and the terms of their copyright licenses. Finally, this Part will explain why trademark protection is important for collaborative communities, and why collaborative communities may find a fundamental conflict between their trademark duties and their core values.

### A. *The Requirements of Trademark Protection*

Historically, the purpose of trademark law in the United States was to allow consumers to rely on marks to signify the origin of a good or service.<sup>31</sup> Trademark law is rooted in the law of consumer protection, and the trademark itself is a mechanism that allows consumers to identify and distinguish a good's or service's source of origin.<sup>32</sup> There is a fundamental connection between the trademark and the consumer's expectations.<sup>33</sup> Trademark protection is therefore not an intellectual property right that can be established or sold separately from the work that it represents.<sup>34</sup> It is nowhere near as restrictive as copyright or patent protection.<sup>35</sup> As we discuss below, those latter two areas of law have pressured collaborative communities to adopt public license approaches—such as the

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<sup>29</sup> 87 C.J.S., *supra* note 23, § 321.

<sup>30</sup> *See id.* § 256.

<sup>31</sup> *See id.* § 2.

<sup>32</sup> *Id.* § 4.

<sup>33</sup> *See id.* § 12.

<sup>34</sup> *Id.*

<sup>35</sup> *See infra* Part II.D.

Creative Commons licenses and the GNU General Public License—to make the law better serve their missions.<sup>36</sup> But, there is no equivalent public trademark license for collaborative work.

Over time, trademark rights have come to represent a valuable asset for their owners, even among collaborative communities. Trademark law allows an owner to protect the goodwill associated with its mark, and the goodwill may provide a significant source of a product's value.<sup>37</sup> Modern trademark law largely treats trademarks as property rights and specifically recognizes the owner's investment in developing the brand.<sup>38</sup> In particular, the introduction of the trademark dilution doctrine in the Federal Trademark Dilution Act in 1996 marked a shift towards compensating a trademark holder for the holder's investment in the brand, rather than simply protecting consumers from confusion.<sup>39</sup> This newer direction of trademark law is particularly inconsistent with the values of collaborative communities as we discuss in Part I.B.

Words or symbols that represent a good or service can be eligible for trademark protection.<sup>40</sup> The strength of trademark protection depends on a mark's distinctiveness.<sup>41</sup> When a fanciful or arbitrary mark such as "XKCD"<sup>42</sup> represents a product or a service, it receives the strongest protection under the law.<sup>43</sup> Descriptive marks, such as "COMPUTERLAND"<sup>44</sup> only receive protection when they acquire a secondary meaning in the mind of consumers.<sup>45</sup> On the other hand, a generic mark, such as "THE COMPUTER STORE,"<sup>46</sup> may be completely ineligible for trade-

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<sup>36</sup> See *infra* Part II.D.

<sup>37</sup> See 87 C.J.S., *supra* note 23, § 4.

<sup>38</sup> See *id.* § 8.

<sup>39</sup> See 4 MCCARTHY, *supra* note 18, § 24:93.

<sup>40</sup> 87 C.J.S., *supra* note 23, § 8.

<sup>41</sup> See *id.* § 46.

<sup>42</sup> See *About*, XKCD.COM, <http://xkcd.com/about> (last visited Oct. 25, 2014) (stating that the creator of the XKCD comic chose this name for his comic specifically because it lacked meaning and was unpronounceable).

<sup>43</sup> See 87 C.J.S., *supra* note 23, § 49.

<sup>44</sup> 2 MCCARTHY, *supra* note 18, § 11:24 (including "COMPUTERLAND" in "Illustrative list of marks held descriptive").

<sup>45</sup> See 87 C.J.S., *supra* note 23, § 46.

<sup>46</sup> 2 MCCARTHY, *supra* note 18, § 12:18 (including "THE COMPUTER STORE" in "Illustrative list of terms held generic").

mark protection. Collaborative communities are unlikely to perform formal trademark clearance to determine whether the name or logo for their projects will be eligible for trademark protection. In fact, they have a history of choosing playfully difficult project names, like GNU (which is a recursive acronym<sup>47</sup> for “GNU’s Not Unix!”) with little regard for brand protection.<sup>48</sup>

Under the Lanham Act, which is the main trademark statute in the United States, a mark may be eligible for registration after it has been used in commerce, which means that an applicant’s use, or intent to use,<sup>49</sup> is a precondition for registration.<sup>50</sup> By contrast, a work may be eligible and appropriate for patent or copyright protection before it is even released to the public.<sup>51</sup> For the purpose of trademark protection, a good or service is used “in commerce” when it is transported in commerce in a manner that can be regulated by Congress.<sup>52</sup> Although collaborative communities may produce software that is not necessarily sold commercially, it will often involve software with a potential economic impact that could easily fall within this definition of “commerce” for trademark purposes.<sup>53</sup>

In the United States, a trademark can be legally protected regardless of whether it is registered.<sup>54</sup> Federal trademark law under

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<sup>47</sup> See *Recursive acronym*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Recursive\\_acronym](https://en.wikipedia.org/wiki/Recursive_acronym) (last visited Aug. 24, 2014).

<sup>48</sup> See *GNU*, WIKIPEDIA, <https://en.wikipedia.org/wiki/GNU> (last visited Feb. 6, 2015).

<sup>49</sup> In practice, someone may register a trademark before it is actually used in connection with a good or service as long as his or her intent-to-use application is made in good faith. See 15 U.S.C. § 1051(b)(1) (2012). This sort of proactive precautionary strategy may be difficult for a collaborative community, which develops both the product and branding through decentralized continuous iteration.

<sup>50</sup> See 15 U.S.C. § 1051(a)(1) (2012).

<sup>51</sup> In contrast to trademark law’s requirement for usage in commerce, copyright protection may begin as soon as a work is affixed in a tangible medium. See 17 U.S.C. § 102(a) (2012).

<sup>52</sup> See 15 U.S.C. § 1127 (2012).

<sup>53</sup> There is a popular misconception that freely licensed software is not sold commercially. In fact, freely licensed software and content is regularly sold in commerce. The word “free” in “free software” refers to freedom, not price. See *What is Free Software?*, GNU FOUNDATION, <http://www.gnu.org> (last visited Oct. 25, 2014) (“Thus, ‘free software’ is a matter of liberty, not price. To understand the concept, you should think of ‘free’ as in ‘free speech,’ not as in ‘free beer.’”).

<sup>54</sup> See 87 C.J.S., *supra* note 23, § 191.

the Lanham Act sets the standard for protection, while state common law and statutes can provide additional protection for unregistered marks.<sup>55</sup> When a mark is used in commerce in connection with a good or service, it is eligible for trademark registration.<sup>56</sup> A registered trademark receives additional benefits, such as evidence of ownership and nationwide notice.<sup>57</sup> An unregistered trademark still receives protection. Under the Lanham Act, registered and unregistered marks are held in equal esteem.<sup>58</sup> A mark that effectively represents a collaboratively developed product may therefore acquire common law trademark protection, but it is not clear which community member would hold the actual trademark right.<sup>59</sup> Only a mark's owner may file for federal trademark registration, although multiple owners of a mark may file a joint application in some narrow circumstances.<sup>60</sup> Joint ownership of a trademark is generally disfavored, since the notion of multiple independent owners is inconsistent with trademark's role in indicating a single origin for a good or service and a single entity to provide consistent quality.<sup>61</sup> A mark's owner, for the purpose of registration, must be a natural person or "juristic person," such as a corporation or association, but may not be an undefined group.<sup>62</sup> When a mark is registered, it is assigned a specific classification, such as a trademark, a service mark, a certification mark, a collective trademark, or a collective membership mark.<sup>63</sup> Trademark registrations can

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<sup>55</sup> See 3 MCCARTHY, *supra* note 18, § 22:1.50 (commenting on the relationship between federal and state protection).

<sup>56</sup> 87 C.J.S., *supra* note 23, § 200. Also, the registrant must be entitled to its exclusive use. *Id.*

<sup>57</sup> See 15 U.S.C. § 1072 (2012).

<sup>58</sup> See *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1383 (Fed. Cir. 2002).

<sup>59</sup> See, e.g., *Meem-Haskins Coal Corp. v. Cent. Fuel Corp.*, 137 F.2d 242, 246 (C.C.P.A. 1943) ("[M]ore than one may use a trade-mark, but only one can have ownership of it in a trade-mark registration sense.").

<sup>60</sup> *In re Wella A.G.*, 787 F.2d 1549, 1554 (Fed. Cir. 1986) ("Under section 1 of the Lanham Act, only the *owner* of a mark is entitled to apply for registration.") (emphasis in original).

<sup>61</sup> See 2 MCCARTHY, *supra* note 18, § 16:40–45 (discussing the problems of joint and fragmented ownership). Additionally, a joint ownership arrangement may be a practical difficulty for a project with a large number of joint owners.

<sup>62</sup> See Lanham Act § 45, 15 U.S.C. § 1127 (2012).

<sup>63</sup> See 15 U.S.C. § 1053–54; see also 3 MCCARTHY, *supra* note 18, § 19:101 (explaining that a collective membership mark, a subset of collective trademarks, is used to indicate

continue as long as the mark is valid, but a trademark owner must make occasional filings to maintain strong protection of the mark.<sup>64</sup>

Finally, it is significant that trademark rights do not expire, unlike copyrights or patent rights.<sup>65</sup> Although other intellectual property rights are granted for a limited term, a trademark right's term may extend for as long as consumers recognize that mark as an indicator of a good or service's origin.<sup>66</sup> This means that trademark rights may grow to be significantly valuable, especially for a successful product.<sup>67</sup> And the protection will remain for the life of the product or service—which, in the case of a collaborative community, may be a significantly long time.<sup>68</sup> As collaborative communities get older and become more widely known, issues concerning trademark protection may become more significant. Today, some of the older collaborative projects like the GNU project or Linux have only existed a few decades.<sup>69</sup> They are still very young compared with old famous marks like Cambridge University Press from 1534.<sup>70</sup>

### 1. The Naked Licensing Doctrine

When trademark holders allow others to use their marks, they need to do so under a trademark license and maintain some degree of control over how their marks are used to ensure consistent quality.<sup>71</sup> Historically, trademark common law focused on the role of a

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membership in a group). In Part II, we discuss how collective membership marks may be particularly suited as a potential solution for collaborative communities.

<sup>64</sup> These filings include an affidavit after the initial five years and additional renewals each ten years. 3 MCCARTHY, *supra* note 18, § 19:134. As discussed in Part II, the registration and maintenance procedures with the Patent and Trademark Office can require the diligent attention of an expert.

<sup>65</sup> See 1 MCCARTHY, *supra* note 18, § 6:6.

<sup>66</sup> See *id.*

<sup>67</sup> See, e.g., HEATHER J. MEEKER, THE OPEN SOURCE ALTERNATIVE: UNDERSTANDING RISKS AND LEVERAGING OPPORTUNITIES 111–14 (2008).

<sup>68</sup> See 1 MCCARTHY, *supra* note 18, § 6:6.

<sup>69</sup> See *GNU Project*, WIKIPEDIA, [https://en.wikipedia.org/wiki/GNU\\_Project](https://en.wikipedia.org/wiki/GNU_Project) (last visited Feb. 6, 2015); *Linux*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Linux> (last visited Feb. 6, 2015).

<sup>70</sup> See *Cambridge University Press*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Cambridge\\_University\\_Press](https://en.wikipedia.org/wiki/Cambridge_University_Press) (last visited Feb. 6, 2015).

<sup>71</sup> See 3 MCCARTHY, *supra* note 18, § 18:42.

mark as an indicator of the source or origin of a good.<sup>72</sup> Licensing or assigning a mark required transferring business property, such as manufacturing equipment, to ensure that the mark continued to serve its purpose as a source indicator.<sup>73</sup> Courts gradually became more tolerant of licensing a mark by itself, and began recognizing that a trademark served as an indicator of quality as well as source.<sup>74</sup> The passage of the Lanham Act in 1946 validated the modern view that a trademark may serve as a quality indicator.<sup>75</sup>

A trademark holder has a duty to control the quality of goods that carry the mark.<sup>76</sup> Quality control practices may include sampling the goods before they are released to the public, relying on the licensee's skill and reputation to guarantee consistent quality, or relying on a long-lasting and close relationship with the licensee.<sup>77</sup> For the purpose of trademark law, quality control depends on whether the mark will meet consumer expectations created by the mark.<sup>78</sup> To determine if a person has maintained proper quality control when allowing another to use the mark, the Ninth Circuit has examined: (1) whether the trademark holder retained contractual rights over the quality of the use of the trademark, (2) whether the trademark holder actually controlled the quality of the trademark's use in practice, and (3) whether the trademark holder could have reasonably relied on the licensee to maintain quality.<sup>79</sup>

If a trademark holder does not properly maintain the mark, they may have abandoned the mark and lose trademark protection.<sup>80</sup> Courts have adopted a doctrine wherein naked licensing is a form of involuntary abandonment: if a trademark holder allows others to use their mark without adequate oversight, a court may find that they have abandoned their right to protect the mark.<sup>81</sup> Under the

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<sup>72</sup> See *id.* § 18:39.

<sup>73</sup> See *Macmahan Pharmacal Co. v. Denver Chem. Mfg. Co.*, 113 F. 468, 474–75 (8th Cir. 1901).

<sup>74</sup> See 3 MCCARTHY, *supra* note 18, § 18:39.

<sup>75</sup> See *id.*

<sup>76</sup> See *id.* § 18:42.

<sup>77</sup> See, e.g., *Barcamerica Int'l USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 596–98 (9th Cir. 2002).

<sup>78</sup> See 3 MCCARTHY, *supra* note 18, § 18:42.

<sup>79</sup> See *Barcamerica*, 289 F.3d at 596–98.

<sup>80</sup> See 3 MCCARTHY, *supra* note 18, § 7:5.

<sup>81</sup> See *Barcamerica*, 289 F.3d at 596.

Lanham Act, a mark is considered abandoned if the trademark holder discontinues use with intent to abandon the mark or if the trademark holder allows the mark to be used in a manner that causes the mark to lose its significance as a mark.<sup>82</sup> The Ninth Circuit classifies naked licensing as the latter form of involuntary abandonment because an uncontrolled mark is “inherently deceptive” to consumers who rely on the mark as an indicator of consistent quality.<sup>83</sup> In contrast, other circuits have interpreted the naked licensing doctrine to be one component of abandonment, but still imposed a high burden of proof and required a showing of loss of significance as a result of naked licensing.<sup>84</sup>

In *FreecycleSunnyvale v. The Freecycle Network*, the Ninth Circuit found that a nonprofit group had lost its trademark rights because they had failed to provide adequate quality control.<sup>85</sup> The Freecycle Network (TFN) was a nonprofit organization that coordinated locally focused online groups where members traded free goods and services, usually through Yahoo! discussion groups.<sup>86</sup> TFN operated on principles of reciprocal altruism, with thousands of local groups around the world.<sup>87</sup> It provided local groups with general instructions to “Keep it Free, Legal & Appropriate for All Ages.”<sup>88</sup> The interpretation and implementation of this rule was left up to the various local groups.

After an obscure dispute with a Freecycle Group in Sunnyvale (FreecycleSunnyvale, or FS), TFN demanded that FS cease operating under the Freecycle name.<sup>89</sup> In response, FS sought a decla-

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<sup>82</sup> 15 U.S.C. § 1127 (2006) (noting that abandonment may include “acts of omission as well as commission” that cause a loss in significance).

<sup>83</sup> *Barcamerica*, 289 F.3d at 597–98 (quoting *First Interstate Bancorp v. Stenquist*, 1990 WL 300321, at \*3 (N.D. Cal. July 13, 1990)).

<sup>84</sup> See *Creative Gifts, Inc. v. UFO*, 235 F.3d 540, 548 (10th Cir. 2010) (describing the high burden of proof necessary to find abandonment); see also *U.S. Jaycees v. Phila. Jaycees*, 639 F.2d 134, 140 (3d Cir. 1981) (noting the high burden of proof to find abandonment, and holding that a high degree of tolerance among licensees did not result in a loss of significance); see also *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1080 (5th Cir. 1997) (holding that naked licensing is significant to show the lack of strength of a mark, but abandonment requires showing a loss of trade significance).

<sup>85</sup> See *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 512 (9th Cir. 2010).

<sup>86</sup> See *id.*

<sup>87</sup> THE FREECYCLE NETWORK, <https://www.freecycle.org/> (last visited Oct. 26, 2014).

<sup>88</sup> *FreecycleSunnyvale*, 626 F.3d at 513.

<sup>89</sup> See *id.* at 513–14.



ratory judgment that TFN had abandoned control of the Freecycle name through naked licensing.<sup>90</sup> The court examined the nature of TFN's control, including their legal restrictions and the controls in practice.<sup>91</sup> TFN only had one informal email and phone conversation with FS before providing them a logo to use.<sup>92</sup> FS had not signed a formal trademark license with TFN.<sup>93</sup> The court found that TFN's simple rules and the general Yahoo! Terms of Use did not provide adequate quality control mechanisms for the use of the name Freecycle.<sup>94</sup> The court concluded that TFN had abandoned its control over the Freecycle name by allowing FS to use the mark with inadequate quality control measures.<sup>95</sup>

*Freecycle* was a wakeup call for many collaborative communities, particularly in the open source world.<sup>96</sup> The case provided a disconcerting example of how easily a decentralized and uncoordinated online community could lose its trademark protection. The Freecycle community looks very similar to many collaborative communities.<sup>97</sup> Freecycle members organized informally online under general rules in decentralized communication systems, such as online discussion forums or email correspondence, and generally worked toward a shared goal guided by a set of common values.<sup>98</sup> Freecycle was formal enough to be supported by a nonprofit organization that coordinated activities among decentralized international groups of volunteer members.<sup>99</sup> In some ways, the Freecycle community was more formalized than many highly productive open source projects. Despite the informal appearance of many collaborative communities, they manage to coordinate the production

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<sup>90</sup> *Id.* at 514.

<sup>91</sup> *See id.* at 516–19.

<sup>92</sup> *See id.* at 513.

<sup>93</sup> *Id.* at 516.

<sup>94</sup> *See id.* at 517.

<sup>95</sup> *See id.* at 520.

<sup>96</sup> *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*, 7 J. INTELL. PROP. L. & PRAC. 126, 126 (2012).

<sup>97</sup> *See* BENKLER, *supra* note 1, at 80 (describing a collaborative community that uses loose norms, mailing lists, and online bulletin boards to coordinate activity, similar to Freecycle); *see also* Chestek, *infra* note 237 (noting the similarities between Freecycle and open source communities).

<sup>98</sup> *See FreecycleSunnyvale*, 626 F.3d at 512.

<sup>99</sup> *See* FREECYCLE, <https://www.freecycle.org/> (last visited Nov. 2, 2014).

of significant goods and services, which are purchased, used, and recognized by consumers around the world via highly visible and recognizable names and logos.<sup>100</sup> If a collaborative community loses trademark protection for their name or logo, they may lose not only consumers' trust but also their ability to recruit new contributors to their projects.

Despite the harsh consequence in *Freecycle*, collaborative communities may escape Freecycle's fate due to several distinguishing arguments. First, many collaborative communities have formalized—although idiosyncratically—governance structures as described below in Section B(1).<sup>101</sup> TFN only had a tenuous relationship with their community, and allowed individual groups to broadly interpret the rules for free trading services offered under the “Freecycle” name.<sup>102</sup> Collaborative communities, on the other hand, coordinate work with technical tools, governance roles and institutions, and social norms.<sup>103</sup> All of these points of coordination can collectively provide effective quality control that is consistent with a collaborative community's values. While this argument has not yet been tried before a court, a collaborative community may be able to argue that their project governance provides a form of quality control in practice.

Second, as a matter of law, the *Freecycle* case did not clarify the Ninth Circuit's perspective on whether a loss of significance is necessary to find abandonment.<sup>104</sup> This is a key point for evaluating the risk and consequences of naked licensing. Collaborative communities, particularly those that enjoy famous brands, may be in a better position to challenge a claim of abandonment through naked licensing that is not accompanied by strong evidence of loss of brand significance.<sup>105</sup> However, naked licensing and a failure to

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<sup>100</sup> See Smolka & Hienerth, *supra* note 97.

<sup>101</sup> See *infra* Part I.B.1.

<sup>102</sup> See *FreecycleSunnyvale*, 626 F.3d at 513.

<sup>103</sup> See Chris Jensen & Walt Scacchi, *Governance in Open Source Software Development Projects*, INSTITUTE FOR SOFTWARE RESEARCH, UNIVERSITY OF CALIFORNIA, IRVINE, available at <http://www.ics.uci.edu/~wscacchi/Papers/New/Jensen-Scacchi-OSS10.pdf>.

<sup>104</sup> TFN did not raise this question until appeal, and so the Ninth Circuit was unable to consider the issue as a procedural matter. See *FreecycleSunnyvale*, 626 F.3d at 519–20.

<sup>105</sup> See generally Rudolph J. Kuss, *The Naked Licensing Doctrine Exposed: How Courts Interpret the Lanham Act to Require Licensors to Police Their Licensees & Why This*

provide consistent quality may be damaging for a brand, regardless of the technical legal requirements for trademark abandonment.

The effectiveness of these two arguments is not clear. As a result, diligent collaborative communities try to ensure that they provide adequate quality control provisions in all trademark licenses, and operate under a presumption that naked licensing could pose a severe risk to their trademark rights, possibly leading to involuntary abandonment of protection.<sup>106</sup>

These risks may appear to be unique to US trademark law in the Ninth Circuit, but due to the global nature of online projects, it could have widespread impact. Any collaborative project that operates online could find itself engaging in activity in the Ninth Circuit, particularly for software projects with connections to Silicon Valley. Additionally, the situation in *Freecycle* and underlying tension in the naked licensing doctrine illustrates a practical challenge of a distributed project that wishes to collectively manage an identity and reputation attached to a unitary name or logo.

## 2. Distinctiveness and the Risk of Genericide

In addition to the quality control requirements in trademark licensing, trademark holders often wish to police their mark's usage to ensure that the trademark continues to be properly associated with their goods or services. If a mark becomes a generic term for a product, the owner may lose trademark protection through a process known as "genericide."<sup>107</sup> Trademark holders frequently try to preserve the distinctiveness of their brand by insisting that it is used in a stylized or emphasized font, with the appropriate trademark symbols, and accompanied by a trademark notice.<sup>108</sup> Trademark holders often formally require using their marks as ad-

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*Requirement Conflicts with Modern Licensing Realities & the Goals of Trademark Law*, 9 MARQ. INTELL. PROP. L. REV. 361, 363–68 (2005).

<sup>106</sup> See WIKIMEDIA TRADEMARK PRACTICES DISCUSSION, [http://meta.wikimedia.org/wiki/Trademark\\_practices\\_discussion](http://meta.wikimedia.org/wiki/Trademark_practices_discussion) (last modified Sept. 23, 2013).

<sup>107</sup> See 2 MCCARTHY, *supra* note 18, § 12:1 ("Such was the fate under U.S. law of words like 'aspirin,' 'cellophane,' and 'escalator.'").

<sup>108</sup> See 3 MCCARTHY, *supra* note 18, § 7:38.50 (commenting on the importance of uniformity in trademark usage).

jectives, and discourage use as a noun or verb.<sup>109</sup> They may even place these rules as conditions in their trademark licenses, in an attempt to protect their mark from entering the “linguistic commons.”<sup>110</sup> In collaborative projects, community members are often resistant to these types of restrictions because they look like unnecessary bureaucracy and legalese.<sup>111</sup>

However, trademark holders are not to blame if a mark becomes a generic term. Trademark law does not provide a legal right to prevent the public from using a generic word.<sup>112</sup> A trademark owner can be mindful of their use of their mark to avoid genericide and can encourage others to avoid generic use, but to some degree, the generic meaning of a word is outside of a trademark owner’s control.

Collaborative communities need to be careful in order to avoid identifying their projects with a generic term and should use their distinctive mark in a way that discourages genericide. But they may not be mindful or coordinated about how their mark is used, particularly in ways that blur the line between a project and a generic term for that project. In an open and informal group, it may feel natural to use a collaborative community’s name as a common term in language. For example, it is important for the Mozilla community that “Firefox” doesn’t become a term for any open-source browser, and it is important for the Wikimedia movement that “Wikipedia” isn’t understood to be any freely licensed encyclopedia.<sup>113</sup> As collaborative communities examine their trademark policies and practices, they need to consider how to avoid genericide without encroaching on their other values, such as a commitment to openness and free speech.<sup>114</sup>

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<sup>109</sup> See, e.g., 3 MCCARTHY, *supra* note 18, § 12:10 (describing a rule of thumb that generic terms are used as nouns and descriptive terms are used as adjectives).

<sup>110</sup> See, e.g., *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001).

<sup>111</sup> See, e.g., WIKIMEDIA TALK: TRADEMARK POLICY, [https://meta.wikimedia.org/wiki/Talk:Trademark\\_policy#Using\\_trademarks\\_as\\_a\\_verb](https://meta.wikimedia.org/wiki/Talk:Trademark_policy#Using_trademarks_as_a_verb) (last visited Nov. 2, 2014).

<sup>112</sup> See 3 MCCARTHY, *supra* note 18, § 12:28.

<sup>113</sup> See, e.g., MOZILLA FOUNDATION TRADEMARK POLICY, <https://www.mozilla.org/en-US/foundation/trademarks/> (last visited July 28, 2014).

<sup>114</sup> See, e.g., WIKIMEDIA TRADEMARK POLICY – PURPOSE, [http://wikimediafoundation.org/wiki/Trademark\\_policy-purpose](http://wikimediafoundation.org/wiki/Trademark_policy-purpose) (last visited Nov. 2, 2014).

### B. Nature of Collaborative Communities

Collaborative communities are open groups that work together to create freely licensed content or code.<sup>115</sup> They include open source software projects,<sup>116</sup> online wikis, or other similar groups. Many of these communities self-organize around a shared purpose. They may begin as small projects, but their open licenses allow others to join the project and contribute improvements. Through this process, collaborative communities can grow to become large endeavors with sophisticated systems to coordinate their activities. For example, during the month of June 2014, 415 people contributed code to the Firefox browser,<sup>117</sup> 914 people contributed code to the Linux kernel,<sup>118</sup> 121 people contributed code to the Android operating system,<sup>119</sup> and 69,147 contributors made at least five edits to Wikipedia.<sup>120</sup> Each of these projects has been under continuous development for years, and each aims to continue improving its project indefinitely.

Collaborative communities are usually decentralized projects with little hierarchical structure beyond practical necessity. They frequently depend on online communication and software tools to manage contributions from many authors.<sup>121</sup> In some cases, like with the Linux kernel, the open and decentralized nature of a collaborative community was an intentional, ethically driven decision to

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<sup>115</sup> See Kevin J. Boudreau & Karim R. Lakhani, *How to Manage Outside Innovation*, 50 MIT SLOAN MGMT. REV. 68 (2009), available at <http://kevinboudreau.com/PAPER%20Open%20Markets%20or%20Communities.pdf>.

<sup>116</sup> This Article will discuss a variety of open source and free software projects, but will not focus on the differences between these similar groups. This paper will use the term “open source” to refer to software released under an open source license or a free software license. See generally Richard M. Stallman, *Free Software, Free Society: Selected Essays of Richard M. Stallman 57–62* (2007), available at <http://www.gnu.org/philosophy/fsfs/rms-essays.pdf> (describing the differences between the terms “open source” and “free software” from the perspective of a free software advocate).

<sup>117</sup> OPENHUB MOZILLA FIREFOX CONTRIBUTORS, <https://www.openhub.net/p/firefox/contributors/summary> (last visited Oct. 31, 2014).

<sup>118</sup> OPENHUB LINUX KERNEL CONTRIBUTORS, <https://www.openhub.net/p/linux/contributors/summary> (last visited Oct. 31, 2014).

<sup>119</sup> OPENHUB ANDROID CONTRIBUTORS, <https://www.openhub.net/p/android/contributors/summary> (last visited Oct. 31, 2014).

<sup>120</sup> WIKIPEDIA STATISTICS, <http://stats.wikimedia.org/EN/TablesWikipediaZZ.htm> (last visited Nov. 2, 2014).

<sup>121</sup> See BENKLER, *supra* note 1, at 65–67.

ensure that the project is egalitarian or independent.<sup>122</sup> In other cases, which include the Android operating system, collaborative projects may be open and decentralized as a matter of economic efficiency.<sup>123</sup> In many cases, a collaborative community may include a mixture of these motivations.

Collaborative communities have been extensively examined in Yochai Benkler's scholarship, which primarily looks at how technological change has empowered collaborative communities.<sup>124</sup> He has presented an alternative model to describe the production of information goods in a networked system.<sup>125</sup> In the traditional model, goods are created through extrinsically motivated participants under the coordination of a centralized firm.<sup>126</sup> In contrast, Benkler introduced a model that explains an emerging phenomenon in the networked production of information goods: a commons-based peer production model.<sup>127</sup> This model focuses on individual creators, who self-select and work in a decentralized and non-hierarchical fashion, to produce goods that are available for common use.<sup>128</sup> The peer-production model explains how collaborative communities, such as open source software groups, are able to coordinate production without a centralized managerial structure. Benkler also stated that firms like IBM and Hewlett-Packard are incorporating open source code into their products and therefore supporting open source development both financially and through advocacy.<sup>129</sup> Other collaborative communities are starting to see similar development with collaboratively developed content, such as Google's Knowledge Graph, which was built using Wikipedia content.<sup>130</sup> Similarly, numerous commercial applications rely

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<sup>122</sup> See Richard Stallman, *Why Open Source Misses the Point of Free Software*, GNU OPERATING SYSTEM, <https://www.gnu.org/philosophy/open-source-misses-the-point.html> (last visited Nov. 2, 2014).

<sup>123</sup> See THE ANDROID SOURCE CODE, <https://source.android.com/source/index.html> (last visited Nov. 2, 2014).

<sup>124</sup> BENKLER, *supra* note 1, at 2.

<sup>125</sup> See *id.* at 52–56.

<sup>126</sup> See *id.* at 51–52.

<sup>127</sup> See *id.* at 52–56.

<sup>128</sup> See *id.* at 60.

<sup>129</sup> See *id.* at 46–47.

<sup>130</sup> See Amit Singhal, *Introducing the Knowledge Graph*, GOOGLE OFFICIAL BLOG (May 16, 2012), <http://googleblog.blogspot.co.uk/2012/05/introducing-knowledge-graph-things-not.html>.

on information culled from various Wikimedia projects to provide different types of services to their customers.

Peer production systems allow decentralized and self-selected groups to collaborate and build through aggregated contributions, without relying on typical hierarchy and control structures.<sup>131</sup> This presents a problem for collaborative communities: how does the commons-based peer production system fit into the requirements for trademark protection? Before discussing a taxonomy of solutions to this problem in Part II *infra*, we will outline some common characteristics collaborative communities possess, review the copyright licenses that collaborative communities depend on, and examine why trademark protection is important for collaborative communities.

### 1. Introduction to Collaborative Communities

Collaborative communities share a number of common characteristics. One key characteristic is that they allow their works to be reproduced and modified. By adopting an open source or free culture license, collaborative communities turn their work into a common good by granting a license to the public to reproduce, modify, and use the works they create under certain minimal conditions.<sup>132</sup> As a result, collaborative communities have a general aversion to intellectual property, although copyrights are acceptable when “hacked” through open source or open culture licenses.<sup>133</sup> Other forms of intellectual property, such as patent and trademark rights, are frequently met with suspicion.<sup>134</sup> In some open source licenses, downstream modifications or additions to the code must be licensed under the same open source license.<sup>135</sup> This requirement, known as a “viral” or “copyleft” clause, uses copyright protection to require that a project remains free from any additional

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<sup>131</sup> BENKLER, *supra* note 1, at 62.

<sup>132</sup> *See id.* at 59–63.

<sup>133</sup> *See* Natasha T. Horne, *Open Source Software Licensing: Using Copyright Law to Encourage Free Use*, 17 GA. ST. U. L. REV. 863, 872 (2001).

<sup>134</sup> This Article will not discuss patent rights in collaborative communities in any detail, but it should be noted that the high transaction costs and historical misuses of patents make them difficult for collaborative communities to utilize. *See generally* Stallman, *supra* note 122, at 97–113.

<sup>135</sup> Examples of copyleft licenses include the GNU, GPL, and the Creative Commons ShareAlike licenses. *See* Horne, *supra* note 133, at 877–88.

restrictions.<sup>136</sup> These clauses enable collaboration by allowing people to share and remix their contributions, but also go a step further in requiring that downstream adaptations of a project continue to be released under an open source license.<sup>137</sup> Open source and free culture licenses create common goods, by allowing many uncoordinated individuals to use their work.<sup>138</sup> Collaborative communities share some characteristics and challenges with other forms of commons-based groups.<sup>139</sup> These characteristics include a distributed conflict resolution mechanisms, such as Wikipedia's arbitration and mediation systems, and collective decision-making systems that aim to preserve individual choice and shared leadership, such as a general preference among open source groups for non-hierarchical structures.<sup>140</sup>

Another key characteristic of collaborative communities is the decentralized peer-organized nature of the group. When a work is freely licensed, anyone is free to make modifications and contribute to the work.<sup>141</sup> Contributors may not have entered into an agreement before contributing to the community,<sup>142</sup> and they may be

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<sup>136</sup> FREE SOFTWARE FOUND., INC. ET AL., *Copyleft and the GNU General Public License: A Comprehensive Tutorial* 12 (2014), available at <http://static.fsf.org/nosvn/cle/cle-2014-kuhn.pdf> (last visited Nov. 2, 2014).

<sup>137</sup> See *id.*

<sup>138</sup> See generally *What is Copyleft?*, GNU OPERATING SYSTEM, <https://www.gnu.org/copyleft/> (last updated Apr. 12, 2014, 12:39 PM).

<sup>139</sup> Elinor Ostrom studied how some small local communities successfully managed natural resource systems without relying on market or state institutions. She identified design principles to address internal challenges for managing common resources, such as free-riding, conflict resolution, and the difficulties of collective action. See ELINOR OSTROM, *GOVERNING THE COMMONS: THE EVOLUTION OF INSTITUTIONS FOR COLLECTIVE ACTION* 2-7 (1st ed., Cambridge Univ. Press 1990).

<sup>140</sup> See *id.* at 88-102 (explaining design principles for governing common pool resources).

<sup>141</sup> See Stallman, *supra* note 122.

<sup>142</sup> Although individual agreements are not commonly part of a collaborative community, there are two forms of regular agreements: (1) terms of service (TOSs), for websites, and (2) contributor license agreements (CLAs) for open source projects. TOSs have a wide potential for variation. TOSs may cover trademark restrictions, but do not usually provide a trademark license. The most common template CLAs do not provide any form of trademark license or restriction. See APACHE SOFTWARE FOUNDATION, *INDIVIDUAL CONTRIBUTOR LICENSE AGREEMENT V2.0*, available at <http://www.apache.org/licenses/icla.txt> (last visited Sept. 28, 2014).



physically located anywhere around the world.<sup>143</sup> Instead of following standard development practices, community members are able to contribute content or software with minimal or informal connections to the others in the group. Unlike firms that rely on centralized control to structure their work, collaborative communities rely on a decentralized non-hierarchical system and new social norms, which empower individuals to choose how they will participate.<sup>144</sup>

One common component of collaborative communities is “planned modularization,” which allows communities to divide work into portions that can be conducted in parallel.<sup>145</sup> Parallelization allows groups to work on big projects while preserving individual choice and avoiding potential conflicts among contributors.<sup>146</sup>

Although collaborative communities are decentralized, they are often far from anarchist. Communities use a wide variety of quality control mechanisms, such as technical tools, assigned governance roles, and social norms, to coordinate their projects.<sup>147</sup> They use these governance structures to ensure that they are working productively towards their project’s goal.<sup>148</sup> For example, Wikipedia community members aim to write neutral and reliable encyclopedia articles, and Linux community members aim to release a stable and fast operating system kernel.<sup>149</sup> A collaborative community’s go-

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<sup>143</sup> Some collaborative communities use a CLA, for copyright reasons, but even such a minimal legal agreement is controversial and difficult to reconcile with free software ideals. *See id.*

<sup>144</sup> BENKLER, *supra* note 1, at 60.

<sup>145</sup> *Id.* at 102–03.

<sup>146</sup> Parallelization is the principal that multiple people can independently contribute to a collaborative project without a significant amount of ongoing coordination by a central committee. At a basic level, many open source projects enable parallelization through tools such as distributed version control systems. Clay Shirky explains that transparency was a key component in the parallelization that allowed the quick growth of the web. Clay Shirky, *View Source... Lessons from the Web’s massively parallel development*, CLAY SHIRKY’S WRITINGS ABOUT THE INTERNET (Apr. 1998), [http://www.shirky.com/writings/hercomeseverybody/view\\_source.html](http://www.shirky.com/writings/hercomeseverybody/view_source.html).

<sup>147</sup> *See generally* ERIC S. RAYMOND, *THE CATHEDRAL & THE BAZAAR: MUSINGS ON LINUX AND OPEN SOURCE BY AN ACCIDENTAL REVOLUTIONARY* (2001).

<sup>148</sup> *See id.*

<sup>149</sup> *See Wikipedia:Conflicts of interest*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Wikipedia:Conflict\\_of\\_interest](http://en.wikipedia.org/wiki/Wikipedia:Conflict_of_interest) (last visited Nov. 9, 2014).

vernance structures provide opportunities for collective choice in major development decisions and mechanisms to resolve conflicts when they arise.<sup>150</sup> Collaborative communities rely on a meritocracy built through peer review.<sup>151</sup> Peers within a community can transparently evaluate each contribution to determine whether it meets the quality standards for the community.<sup>152</sup> For example, if there is a flaw in an open source software project, the open code-base allows anybody to identify the precise origin of the problem and develop a solution.<sup>153</sup> A large and open community means that a project has many people who can identify problems and develop solutions. This principle is often paraphrased as Linus's Law: "Given enough eyeballs, all bugs are shallow."<sup>154</sup>

Identity is important to collaborative communities. Under a group identity, a community is able to find common principles, goals, and values. As a group with a common identity, collaborative communities aim to form collective arrangements that allow them to work towards their shared goal. The identity is important to members that are part of a community, as well attracting, uniting, and motivating new contributors.<sup>155</sup> Collaborative communities may depend on the recruitment of new contributors to ensure that their project will last into perpetuity.<sup>156</sup> New contributors, like customers, need to be able to identify the software's origin if they wish to join the community. A famous name may serve as a rallying

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<sup>150</sup> See generally Siobhán O'Mahony & Fabrizio Ferraro, *The Emergence of Governance in an Open Source Community*, 50 ACAD. OF MGMT. J. 1079 (2007).

<sup>151</sup> BENKLER, *supra* note 1, at 104.

<sup>152</sup> See Kim Osman, *The role of conflict in determining consensus on quality in Wikipedia articles*, WikiSym '13 (2013), available at <http://opensym.org/wsos2013/proceedings/p0206-osman.pdf> (last visited Aug. 1, 2014) (discussing conflict as generative friction that improves quality on Wikipedia articles).

<sup>153</sup> See Jeff Walpole, *Open Source vs. Vendor-Provided Software: Comparing Them Side by Side*, IDEALWARE (Nov. 2008), <http://www.idealware.org/articles/open-source-vs-vendor-provided-software>.

<sup>154</sup> RAYMOND, *supra* note 147, at 30.

<sup>155</sup> See Karim R. Lakhani & Robert G. Wolf, *Why Hackers Do What They Do: Understanding Motivation and Effort in Free/Open Source Software Projects*, in PERSPECTIVES ON FREE AND OPEN SOURCE SOFTWARE (J. Feller et al. eds., 2005) (identifying a heterogeneous mixture of motivations to contribute to open source, including a "normative belief that code should be open").

<sup>156</sup> See generally Kevin Crowston, Nicolas Jullien & Felipe Ortega, *Sustainability of Open Collaborative Communities: Analyzing Recruitment Efficiency*, 3 TECH. INNOVATION MGMT. REV. 20 (2013)

point or a proxy for a community's values. A project name and logo or mascot is usually important to provide the community with social authority and cohesiveness.

The cohesiveness within a collaborative community is not iron-clad. When collaborative communities face internal conflicts among community members, one possible result is that the project will divide into a new separate project, known as a “fork.”<sup>157</sup> Although a fork is legally acceptable under an open source license, many collaborative communities fear the practical consequence of dividing their community's efforts among multiple paths.<sup>158</sup> In some cases, a fork is an effective method of conflict resolution or expanding a project's scope.<sup>159</sup> In the case of a fork, a collaborative community must determine which branch gets to keep using the project's name, logo, and accompanying reputation.<sup>160</sup> If a fork is successful, the result may be a variety of new projects that may use

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<sup>157</sup> In software development, a “fork” is when a piece of software is split into two branches or variations of development, with the intention of developing these branches in independent directions. See Anil Dash, *Forking is a Feature*, ANIL DASH: A BLOG ABOUT MAKING CULTURE (Sept. 10, 2010), <http://dashes.com/anil/2010/09/forking-is-a-feature.html>.

<sup>158</sup> ERIC S. RAYMOND, THE JARGON FILE, VERSION 4.4.8 (2004), available at <http://www.catb.org/jargon/html/> (“Forking is considered a Bad Thing—not merely because it implies a lot of wasted effort in the future, but because forks tend to be accompanied by a great deal of strife and acrimony between the successor groups over issues of legitimacy, succession, and design direction.”).

Additionally, numerous wikis have written in parallel about the problems caused by a proliferation of forks and numerous parallel projects. See *Community:Wikilandia*, WIKILANDIA, <http://www.communitywiki.org/cw-de/WikiLandia>; *Wikintegrationism*, WIKIMEDIA, <https://meta.wikimedia.org/wiki/Wikintegrationism>.

<sup>159</sup> Ruben Van Wendel De Joode, *Managing Conflicts in Open Source Communities*, 14(2) ELECTRONIC MARKETS 110 (2004).

<sup>160</sup> See generally Rick Moen, *Fear of Forking* (2007), available at [http://linuxmafia.com/faq/Licensing\\_and\\_Law/forking.html](http://linuxmafia.com/faq/Licensing_and_Law/forking.html) (last visited July 28, 2014) (listing famous software forks); see also various Wikipedia authors, *Wikipedia:Send in the clones*, available at [https://en.wikipedia.org/wiki/Wikipedia:Send\\_in\\_the\\_clones](https://en.wikipedia.org/wiki/Wikipedia:Send_in_the_clones) (last visited July 28, 2014) (for a discussion of the search engine problems caused by competing against forks).

a slight variation on the original project's name.<sup>161</sup> Forks can be particularly problematic from a trademark perspective.<sup>162</sup>

Collaborative communities often feel a strong sense of attachment to their logos and project names, since they volunteer to create the content or software that these marks represent.<sup>163</sup> Regardless of who technically owns the trademark, each member of a collaborative community may feel that the logo represents their personal contribution to or involvement in a project.<sup>164</sup> This strong sense of ownership, combined with a characteristic love for decentralization and a general distrust of authority, is a recipe for a tumultuous relationship between a collaborative community and its mark. In some collaborative communities, even their logo is built through a collaborative and democratic process.<sup>165</sup> For example, the Debian logo was written by a volunteer and selected by the Debian community via a vote of Debian developers in 1991.<sup>166</sup> The Wikipedia logo was developed through a similar process, which involved community-selected iterations created by volunteers starting in 2001.<sup>167</sup>

These common characteristics of collaborative communities show that there is a strong connection between a collaborative community's sharing ethos enabled through public copyright licenses, their decentralized structure, and the identity that

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<sup>161</sup> The BSD operating system, initially released in 1977, includes a number of successfully forked projects, such as NetBSD (forked in 1993), FreeBSD (forked in 1994), and OpenBSD (forked in 1995). See generally *Comparison of BSD operating systems*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Comparison\\_of\\_BSD\\_operating\\_systems](http://en.wikipedia.org/wiki/Comparison_of_BSD_operating_systems) (last visited Sept. 18, 2014).

<sup>162</sup> Trademark protection only attaches to the name that actually becomes representative of the underlying work in the eyes of users. The slight variations on that name could diminish the strength of the connection between the names and the work, and could even make the trademarked name generic if it is understood to be a common term or a category of software or content originally from different projects.

<sup>163</sup> See *New Logo Proposal 004*, DEBIAN (May 3, 1999), [https://www.debian.org/vote/1999/vote\\_0004](https://www.debian.org/vote/1999/vote_0004).

<sup>164</sup> See *id.*

<sup>165</sup> See *International logo contest/Ballot*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/International\\_logo\\_contest/Ballot](http://meta.wikimedia.org/wiki/International_logo_contest/Ballot) (last modified Apr. 27, 2013, 14:25 UTC).

<sup>166</sup> See *DebianLogo*, DEBIAN, <https://wiki.debian.org/DebianLogo> (last modified Oct. 10, 2011, 01:57 UTC).

<sup>167</sup> See *Wikipedia: Wikipedia Logos*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Wikipedia:Wikipedia\\_logos](https://en.wikipedia.org/wiki/Wikipedia:Wikipedia_logos) (last visited Oct. 27, 2014).

represents the community's shared goal and values. These features are embodied in both the works that the communities create, as well as the institutions that govern the community. Next, we will examine the particular structures that enable open source communities and free culture communities.

#### a) Open Source Communities

Open source and free software communities write software and release it under public open source licenses.<sup>168</sup> Popular open source licenses include the GPL, BSD, Apache, and MIT licenses.<sup>169</sup> These are public licenses that provide copyright permissions for anyone to reproduce, modify, and use the software with minimal requirements, such as preserving attribution and copyright notices. Open source licenses specifically address the needs of software development, which may be distributed as compiled object code or human-readable source code.

Open source communities usually identify the core of the project with a name and logo, under a wide range of social structures and policies that may define their community's culture. Software developers often volunteer to contribute to an open source project, although many contributors may be working on open source software as part of a paid position.<sup>170</sup> Some businesses may use open source licenses to distribute centrally developed code.<sup>171</sup> Usually, an open source project is decentralized and open to anyone, but still governed by a set of policies, social structures, and common practices.<sup>172</sup> Open source projects use source control software, such as GIT or SVN, to consolidate and organize the efforts of a project's decentralized contributors.<sup>173</sup> Some contributors

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<sup>168</sup> See *Frequently Asked Questions*, OPEN SOURCE INITIATIVE, <http://opensource.org/faq> (last visited Nov. 9, 2014).

<sup>169</sup> See Horne, *supra* note 133, at 877-88.

<sup>170</sup> See Joris Evers, *Offering a bounty for security bugs*, CNET (July 25, 2005), [http://news.cnet.com/2100-7350\\_3-5802411.html](http://news.cnet.com/2100-7350_3-5802411.html).

<sup>171</sup> *General FAQ*, PENTAHO, <http://community.pentaho.com/faq/general.php>.

<sup>172</sup> See generally RAYMOND, *supra* note 147, at 67-111 (explaining some common structures and taboos in open source projects).

<sup>173</sup> See Brian de Alwis & Jonathan Sillito, *Why Are Software Projects Moving From Centralized to Decentralized Version Control Systems?*, in CHASE '09 PROCEEDINGS OF THE 2009 ICSE WORKSHOP ON COOPERATIVE AND HUMAN ASPECTS ON SOFTWARE ENGINEERING (IEEE Computer Society ed., 2009).

may have privileges within a project, such as determining what software contributions are accepted in the project's official repository.<sup>174</sup>

Although the production and design of open source software may be non-traditional, the software is usually released and distributed through similar means as proprietary software.<sup>175</sup> Open source projects—like any software project—have concerns about quality assurance, security, compatibility, and general reputation. When open source projects release an official version of their software, they may rely on digital signatures to validate whether a file is identical to the official version.<sup>176</sup> A digital signature is an algorithm that allows someone to verify a file after it is received, to confirm that it is authentic, actually sent, and delivered without alteration.<sup>177</sup> This provides a technical ability to determine that a given file is identical to the official version.

One of the most prominent open source projects, and perhaps one of the largest software development projects,<sup>178</sup> is the Linux operating system. The Linux project is maintained by thousands of individual and corporate contributors,<sup>179</sup> and is used to run everything from supercomputers<sup>180</sup> to small-embedded devices.<sup>181</sup> The

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<sup>174</sup> For example, aspects of the Linux project are overseen by maintainers, who are responsible for reviewing contributions before they enter the main branch of code. *See generally List of maintainers and how to submit kernel changes*, KERNEL.ORG, <https://www.kernel.org/doc/linux/MAINTAINERS> (last visited Aug. 5, 2014).

<sup>175</sup> *See Frequently Asked Questions*, *supra* note 168.

<sup>176</sup> 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 TRADEMARK REP. 1028, 1038–39 (2012) (explaining how digital signatures may provide quality control verification, similar to a Universal Product Code).

<sup>177</sup> For example, the Ubuntu project, like most open source projects, provides SHA1 sums for their officially released packages, allowing users to verify their authenticity and providing some degree of assurance that a particular file is the same as the file released by the Ubuntu community. *See generally How to SHA256SUM*, UBUNTU, <https://help.ubuntu.com/community/HowToSHA256SUM> (last modified Sept. 17, 2011, 21:50:03 UTC).

<sup>178</sup> *See* Jake Edge, *LinuxCon Japan: Making kernel developers less grumpy*, LINUX WORLD NEWS (June 6, 2012), <https://lwn.net/Articles/500443/>.

<sup>179</sup> *See* Jonathan Corbet, *3.14 development statistics*, LINUX WORLD NEWS (Mar. 12, 2014), <http://lwn.net/Articles/590354/>.

<sup>180</sup> For example, top supercomputers such as the Tainhe-2 (China), Titan (United States), and K computer (Japan), use Linux varieties as their operating system. *See Top*

Linux community includes kernel developers, who work on the operating system's core components, as well as a wide variety of distributions, such as Debian, Fedora, and Android, which pair the Linux kernel with other open source software packages to provide a fully functional operating system.<sup>182</sup> The Linux kernel is maintained by Linus Torvalds, who oversees a number of other maintainers in a “benevolent dictator” model of governance.<sup>183</sup> The Linux Foundation sponsors Torvald's work on Linux.<sup>184</sup> The Linux Foundation is a non-profit organization that started in 2008 to oversee some financial, legal, and organizational aspects of Linux development.<sup>185</sup> Other Linux distributions have a diverse range of organizational structures.

#### b) Free Culture Communities

Similar to open source communities, free culture communities use public copyright licenses, like the Creative Commons suite, to enable their works to be distributed and remixed.<sup>186</sup> These licenses may apply to text, photographs, or any other copyrighted material, although they are not specifically designed for the needs of software source code.

Free culture communities use a peer production model to create cultural works. For example, on Wikipedia, its community of volunteers' shared goal is to collaboratively write, design, illustrate, and distribute a comprehensive encyclopedia in every hu-

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500 Supercomputers, June 2014, TOP 500 SUPERCOMPUTER SITES (June 2014), <http://www.top500.org/lists/2014/06/> (last visited Aug. 1, 2014).

<sup>181</sup> For example, Linux is used on wireless routers and cell phones. See *Linux on embedded systems*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Linux\\_on\\_embedded\\_systems](https://en.wikipedia.org/wiki/Linux_on_embedded_systems) (last visited Aug. 1, 2014).

<sup>182</sup> See *What is Linux: An Overview of the Linux Operating System*, LINUX (Apr. 3, 2009), <https://www.linux.com/learn/new-user-guides/376-linux-is-everywhere-an-overview-of-the-linux-operating-system>.

<sup>183</sup> See Eric S. Raymond, *Homesteading the Noosphere*, available at <http://www.catb.org/esr/writings/homesteading/homesteading/ar01s16.html> (last visited Aug. 1, 2014) (describing a “benevolent dictator” style of project governance and ownership).

<sup>184</sup> See *generally About Us*, THE LINUX FOUNDATION, <http://www.linuxfoundation.org/about> (last visited Nov. 9, 2014).

<sup>185</sup> See *id.*

<sup>186</sup> See *Free Culture Definition*, FREE CULTURE FOUNDATION [http://wiki.freeculture.org/Free\\_Culture\\_Definition](http://wiki.freeculture.org/Free_Culture_Definition).

man language using wiki software.<sup>187</sup> The wiki software allows anyone to contribute to Wikipedia's knowledge base, with a set of loose consensus-driven policies that enable users to agree on encyclopedic issues such as the importance of representing diverse viewpoints, determining which topics should be covered by the projects, evaluating quality of articles and their sources, resolving disputes among users, and many other questions.<sup>188</sup> Similar to open source communities, free culture communities follow the idea of collective-choice arrangements to select the project's leadership. Notably, Wikipedia does not have an "editorial board" that makes substantive decisions about the quality of articles—policy development and enforcement happens through the same collaborative and consensus-driven process that creates article content.<sup>189</sup> Under these policies, certain users are elected to receive technical tools, such as the ability to block abusive users, temporarily lock pages from editing, or mediate disputes over content.<sup>190</sup> When disputes happen on Wikipedia, users may impose graduated sanctions to stop abusive behavior, ranging from warnings to temporary blocks that prevent a user from editing the site.<sup>191</sup> While the community is decentralized and non-hierarchical, the servers and infrastructure are maintained by the Wikimedia Foundation, a non-profit organization formed in 2003.<sup>192</sup> Wikipedia runs MediaWiki, which is open source software used for other Wikimedia projects and many other wikis.<sup>193</sup>

The OpenStreetMap project is another example of a free culture community. This community is assembling a detailed map of Earth using open source software that allows users to contribute

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<sup>187</sup> See generally *Wikipedia:Purpose*, WIKIPEDIA, <http://en.wikipedia.org/wiki/Wikipedia:Purpose> (last visited Nov. 9, 2014).

<sup>188</sup> See generally JOSEPH M. REAGLE, *GOOD FAITH COLLABORATION: THE CULTURE OF WIKIPEDIA* (MIT Press ed., 1st ed. 2010).

<sup>189</sup> See *Wikipedia:Editorial oversight and control*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Wikipedia:Editorial\\_oversight\\_and\\_control](http://en.wikipedia.org/wiki/Wikipedia:Editorial_oversight_and_control) (last visited Nov. 9, 2014).

<sup>190</sup> See *id.*

<sup>191</sup> See *id.*

<sup>192</sup> See *Frequently Asked Questions*, WIKIMEDIA FOUNDATION, <https://wikimediafoundation.org/wiki/FAQ/en> (last visited Nov. 9, 2014).

<sup>193</sup> See MEDIA WIKI, <https://www.mediawiki.org/wiki/MediaWiki> (last visited Nov. 2, 2014).



geospatial data to a freely licensed database.<sup>194</sup> The OpenStreetMap community collects geospatial data, including terrain features, roads, political regions, and landmarks, using freely licensed government data and maps, as well as original observations from GPS devices.<sup>195</sup> Community members may use open source software tools to create vector-graphic map tiles to illustrate the geospatial data, and it is all freely licensed and available online.<sup>196</sup> The OpenStreetMap Foundation, founded in 2006 as a non-profit membership organization to support the project, hosts the main repository of OpenStreetMap data.<sup>197</sup> OpenStreetMap data is built into commercial products, such as Craigslist and Foursquare, and the open source nature of the project enables it to be more deeply customized than proprietary mapping services.<sup>198</sup>

Free culture communities may identify using a domain name, logo, and name for a centrally hosted repository. These projects are usually governed by open and egalitarian policies that explain what sort of contributions are acceptable in this repository and how to resolve conflicts within the community.<sup>199</sup> They aim to provide high-quality reference data, such as an encyclopedia or a map, and manage to achieve this quality through a peer review system that is open to anyone. Specific software tools allow users to communicate and share their contributions with others.

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<sup>194</sup> See *About*, OPENSTREETMAP, <http://www.openstreetmap.org/about> (last visited Nov. 4, 2014).

<sup>195</sup> See *id.*

<sup>196</sup> See *Rendering*, OPENSTREETMAP WIKI, <http://wiki.openstreetmap.org/wiki/Rendering> (last visited Nov. 4, 2014).

<sup>197</sup> See PAUL A. LONGLEY ET AL., *GEOGRAPHIC INFORMATION SYSTEMS AND SCIENCE* 470 (Ryan Flahive et al. eds., 3d ed. 2011).

<sup>198</sup> See Brooke Marchewka, *Community Mapping Just Got A Whole Lot Easier*, 26(3) *WORLDVIEW* 30 (Erica Burman ed. 2013), available at [http://issuu.com/peacecorpsconnect/docs/worldview\\_fall\\_2013](http://issuu.com/peacecorpsconnect/docs/worldview_fall_2013).

<sup>199</sup> See *Legal FAQ*, OPENSTREETMAP WIKI, [http://wiki.openstreetmap.org/wiki/Legal\\_FAQ#2.\\_Contributing](http://wiki.openstreetmap.org/wiki/Legal_FAQ#2._Contributing) (last visited Nov. 4, 2014); see generally *Conflict Resolution*, LEARN OSM, <http://learnosm.org/en/editing/conflict-resolution/> (last visited Nov. 4, 2014) (discussing conflict resolution policies).

## 2. Trademarks in Open Source and Open Culture Licenses

Open source and open culture licenses are designed to provide copyright permissions. These licenses frequently require the licensee to preserve authorship information, but otherwise do not mention trademarks. For example, the GNU General Public License, version 2 or 3, does not mention any trademark rights,<sup>200</sup> and the Apache 2.0 license explicitly disclaims providing any trademark permissions.<sup>201</sup> Similarly, as Creative Commons licenses generally explain, “trademark rights are not licensed under this Public License.”<sup>202</sup> Free culture and open source licenses do not usually provide standard terms found in a trademark license, such as requirements on the appropriate use of marks or provisions on quality control.<sup>203</sup>

One common component of an open source or open culture license is providing credit or attribution to the original authors of a work.<sup>204</sup> The attribution requirements vary according to each license. At the very least, licenses usually require preserving header data and copyright notice information.<sup>205</sup> This information may potentially contain trademark information.

Controversially, the original version of the BSD license written for UC Berkeley contained a clause that required licensees to display an acknowledgment to UC Berkeley in any advertising material that mentioned any feature of the licensed software.<sup>206</sup> This

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<sup>200</sup> See *GNU General Public License, Version 2*, OPEN SOURCE INITIATIVE (June 1991), available at <http://opensource.org/licenses/GPL-2.0>; see also *GNU General Public License, Version 3*, OPEN SOURCE INITIATIVE (June 2007), available at <http://opensource.org/licenses/GPL-3.0>.

<sup>201</sup> See *Apache License, Version 2.0*, OPEN SOURCE INITIATIVE (Jan. 2004), available at <http://opensource.org/licenses/Apache-2.0>.

<sup>202</sup> *Creative Commons Legal Code*, CREATIVE COMMONS ATTRIBUTION 4.0 INTERNATIONAL 4, <https://creativecommons.org/licenses/by/4.0/legalcode> (last visited Nov. 4, 2014).

<sup>203</sup> ALAN S. GUTTERMAN, BUSINESS TRANSACTIONS SOLUTIONS § 198:26 (2014).

<sup>204</sup> MIKKI VALIMAKI, THE RISE OF OPEN SOURCE LICENSING: A CHALLENGE TO THE USE OF INTELLECTUAL PROPERTY IN THE SOFTWARE INDUSTRY 28 (2005).

<sup>205</sup> Kevin M. Gard & Jen Salyers, *Open Source – Friend or Foe?*, 18 DCBA BRIEF 22, 23 (2006).

<sup>206</sup> See Letter from William Hoskins, Dir., Office of Technology Licensing, Univ. Cal., Berkeley, to All Licensees, Distributors of Any Version of BSD (July 22, 1999), available

clause imposed a usage restriction that was inconsistent with other open source licenses, and it was rescinded in 1999.<sup>207</sup> Now, the BSD “3-clause” license only covers trademarks indirectly with a disclaimer, stating that a licensee cannot use the upstream author’s name for promotion or endorsement without the upstream author’s permission.<sup>208</sup>

### 3. Trademark Protection for Collaborative Communities

Traditionally, trademark protection serves a dual purpose of protecting the public from confusion and protecting the trademark owner’s investment in their brand.<sup>209</sup> Collaborative communities usually operate under names and logos that could benefit from protections in both ways. Specifically, collaborative communities rely on their name and logo to protect the community and its values, recruit new contributors, and reliably identify their products to the public.<sup>210</sup>

#### a) Protecting the Community

Collaborative communities are frequently built around strong ethical and practical values. The community’s name and logo may serve as a proxy for these values, which enables community members to develop a general reputation. In some projects, the community believes that free licenses are an ethical imperative.<sup>211</sup> In other projects, open licenses are seen as a practical tool to make the

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at <ftp://ftp.cs.berkeley.edu/pub/4bsd/README.Impt.License.Change> (last visited Sept. 26, 2014).

<sup>207</sup> See *id.*

<sup>208</sup> See *The BSD 3-Clause License*, OPEN SOURCE INITIATIVE 2, <http://opensource.org/licenses/BSD-3-Clause> (last visited July 27, 2014). The two-clause version of the BSD license, sometimes known as the “simplified BSD license,” does not mention trademarks, promotion, or endorsement in any way. See also *BSD 2-Clause License*, OPEN SOURCE INITIATIVE, <http://opensource.org/licenses/BSD-2-Clause> (last visited Nov. 5, 2014).

<sup>209</sup> 1 MCCARTHY, *supra* note 18, § 2:2.

<sup>210</sup> See *An Important Question on the Open Source Hardware Mark*, OSHWA.ORG (Aug. 2, 2012), <http://www.oshwa.org/2012/08/02/an-important-question-on-the-open-source-hardware-mark/>.

<sup>211</sup> See generally *Philosophy of the GNU Project*, GNU OPERATING SYSTEM, <https://www.gnu.org/philosophy/> (last visited Sept. 27, 2014).

project more robust, inclusive, or long-lasting.<sup>212</sup> In most cases, collaborative communities have core values that are essential for their continued operation, such as the belief that copyright licenses should allow sharing and modification.<sup>213</sup> If a project is unable to protect its name and logo from misuse by others, particularly when the misuse is inconsistent with their values, the cohesiveness and productivity of the community can be challenged.

The Debian community only allows software that meets a complex series of rules to evaluate the ethical and practical limitations of the code.<sup>214</sup> The Debian Free Software Guidelines are part of the Debian Social Contract, and the Debian community diligently evaluates whether software is appropriate to include within the Debian System.<sup>215</sup> The Debian community's ethical opinion on information freedom is a notable part of their project's identity.<sup>216</sup> The community maintains a strict review of all of the software packages that Debian distributes, aiming to provide software that is functional, stable, and not subject to onerous copyright restrictions.<sup>217</sup> If someone were to misleadingly use the Debian identity in a manner inconsistent with the group's copyright ethics, then the Debian community's reputation and mission could be compromised.

The Wikipedia community reviews articles against rigorous inclusion and quality standards that include ensuring the neutrality of each article.<sup>218</sup> Wikipedia's openness and transparency allow contributors to continuously review the project for accuracy<sup>219</sup> and

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<sup>212</sup> See David A. Wheeler, *Why Open Source Software / Free Software (OSS/FS, FLOSS, or FOSS)? Look at the Numbers!*, (May 8, 2014), [http://www.dwheeler.com/oss\\_fs\\_why.html](http://www.dwheeler.com/oss_fs_why.html).

<sup>213</sup> See *History of OSI*, OPEN SOURCE INITIATIVE, <http://opensource.org/history> (last modified Sept. 2012).

<sup>214</sup> See *generally Debian Social Contract*, DEBIAN.ORG, (Apr. 26, 2004), [https://www.debian.org/social\\_contract.html#guidelines](https://www.debian.org/social_contract.html#guidelines).

<sup>215</sup> See *id.*

<sup>216</sup> See E. Gabriella Coleman & Benjamin Hill, *THE SOCIAL PRODUCTION OF ETHICS IN DEBIAN AND FREE SOFTWARE COMMUNITIES* 279–82 (2005).

<sup>217</sup> See *DEBIAN POLICY MANUAL*, <https://www.debian.org/doc/debian-policy/ch-archive.html> (last visited Nov. 2, 2014).

<sup>218</sup> Ken S. Myers, *Wikimmunity: Fitting the Communications Decency Act to Wikipedia*, 20 HARV. J.L. & TECH. 163, 169 (2006).

<sup>219</sup> See Jim Giles, *Internet encyclopedias go head to head*, NATURE.COM (Dec. 15, 2005), <http://www.nature.com/nature/journal/v438/n7070/full/438900a.html>. The study found Wikipedia articles to be almost as accurate as a traditional encyclopedia.

neutral point of view.<sup>220</sup> If someone were to use Wikipedia's trademarks to design a site that looks just like Wikipedia but contains information inconsistent with the Wikipedia community's editorial standards and not open for Wikipedia community review, that may erode the reputation earned through the hard work of Wikipedia's volunteers.

Open source projects may face overt threats if they fail to protect their trademark rights. In 1995, William R. Della Croce Jr. registered the "LINUX" word mark<sup>221</sup> and then demanded a royalty from Linux users.<sup>222</sup> This came as a surprise to the Linux community, which petitioned to have the mark cancelled on the grounds that the name was used "generically to describe all the variants of the operating system developed by Petitioner Linus Torvalds."<sup>223</sup> Without a trademark registration, a collaborative community has the burden of fighting specious claims like this, and does not have the advantage of the registration's practical notice of trademark ownership.

#### b) Recruiting New Members

A collaborative community's name and logo may also serve a valuable role in recruiting new members. Some collaborative communities rely on paid contributions, but volunteer efforts continue to play an important part in a project's growth.<sup>224</sup> Some of the attractive characteristics for volunteer contributors to open source projects include a guarantee that a project will last in perpetuity, commitment to the project's ethical values, and opportunity to be

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<sup>220</sup> See Joseph M. Reagle Jr., *Is the Wikipedia Neutral?*, <http://reagle.org/joseph/2005/06/neutral.html> (2005).

<sup>221</sup> LINUX, Registration No. 1,916,230.

<sup>222</sup> Compare Richard Hillesley, *Asterix, the Gall - The Strange History of Linux and Trademarks*, LUXDELUXE.ORG (Mar. 27, 2007), <http://tuxdeluxe.org/node/107>, with *Linux Users Ask PTO to Cancel Registration of 'Linux' Mark in Re Trademark Registration No. 1,916,230*, ANDREWS COMP. & ONLINE LITIG. REV. 23474 (1997). Note that there are contradicting reports of the exact amount of royalty that Della Croce demanded.

<sup>223</sup> See *id.*

<sup>224</sup> See Wheeler, *supra* note 212 (describing surveys that show an increase of the number of contributors who are paid to contribute to open source projects, such as Linux and Firefox).

part of a widely known endeavor.<sup>225</sup> For engineers, affiliation with a well-known open source project may provide new career opportunities and build self-reputation.<sup>226</sup> New recruits to a collaborative project need to be able to identify an open source project that they wish to contribute to, so trademarks may serve its standard role of protection against confusion.<sup>227</sup> Since collaborative communities depend upon motivated community members, the reputation of a project associated with the project's name or logo is an important characteristic of a collaborative project's logo and name. In this sense, the trademark may be essential for a collaborative community's long-term survival.

### c) Protecting the Public

Many consumers may not be aware or care that their goods are produced by collaborative communities. Goods or services from collaborative communities enter commerce just like any other goods or services and need a mark for consumer identification. From a consumer's perspective, they expect that a brand will indicate whether they have received an authentic version of some software, regardless of whether it was built by a collaborative community. Brand identification is important to evaluate compatibility, find solutions to technical problems, and ensure that systems are secure.<sup>228</sup> Similarly, the brand of collaboratively created content may represent to readers that the content is neutral and written without monetary self-interest of particular companies.

Goods on the Internet face a number of common threats: counterfeit products may be unsafe, phish for a user's private credentials, or carry malware, spyware, or other malicious or unexpected

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<sup>225</sup> See Donald A. Carpenter, *Open Source Software Volunteerism vs. Motivating Potential of Primary Employment: Suggestions for a Research Agenda*, Proceedings of the Conference on Information Systems Applied Research (2012), available at <http://proc.conisar.org/2012/pdf/2221.pdf> (last visited Sept. 26, 2014).

<sup>226</sup> See *id.*

<sup>227</sup> 1 MCCARTHY, *supra* note 18, § 2:2.

<sup>228</sup> Tiki Dare & Harvey Anderson, *Passport Without A Visa: Open Source Software Licensing and Trademarks*, 1 INT'L FREE & OPEN SOURCE SOFTWARE L. REV. 99 (2009), available at <http://www.ifosslr.org/ifosslr/article/view/11/37>.

code.<sup>229</sup> Open source and free culture projects, like any information distributed over the Internet, are susceptible to these threats. A recognized domain name and consistent brand identity allow consumers to develop trust in a project, and a collaborative community may need to rely on trademark rights when a third party improperly interferes with that trust. A trademark holder may need to protect domains and social media accounts from cybersquatters, or avoid unsafe activity online.<sup>230</sup> If an open source project does not have trademark rights, it is less prepared to protect its users and fight those who confuse the public with a similar domain name, account, or appearance.

## II. TAXONOMY OF TRADEMARK HACKS

It has now been over a decade since Yochai Benkler argued that collaborative communities can be as productive as centralized companies, pointing to examples such as Linux and the early development of Wikipedia.<sup>231</sup> Over the years, work developed by collaborative communities has indeed become an important part of the economy. To create their work, collaborative communities have in many ways challenged traditional intellectual property rights by developing alternative solutions through open source and free content licenses.

Given that these communities have been around for some time now, why is the tension between trademark law and the communities still an issue? As it turns out, many communities have developed a number of ad hoc solutions to deal with this problem. We call these solutions “hacks”<sup>232</sup> because, rather than seeking to

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<sup>229</sup> See Matthew Bierlein & Gregory Smith, *Privacy Year in Review: Growing Problems with Spyware and Phishing, Judicial and Legislative Developments in Internet Governance, and the Impacts on Privacy*, 11/S: J.L. & POL'Y FOR INFO. SOC'Y 279, 280 (2005).

<sup>230</sup> 4 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES § 22:38 (4th ed.).

<sup>231</sup> See Yochai Benkler, *Coase's Penguin, or, Linux and The Nature of the Firm*, 112 YALE L.J. 369 (2002).

<sup>232</sup> We use the word “hack” here to analogize to the process of writing pieces of software to fill a gap or add to the functionality of an existing program. The trademark solutions discussed in this part are hacks because, rather than seeking to amend trademark law, they are using existing trademark principles in creative ways to serve

amend trademark law, collaborative communities have used existing trademark principles in creative ways to serve projects that are very different from the traditional business models that trademark law was intended to address.<sup>233</sup> These hacks are found scattered across trademark policies, mailing lists, wikis, blogs, and other publications. Some of them have evolved while drawing lessons from other projects. For example, the Drupal trademark policy is modeled after the Ubuntu trademark policy.<sup>234</sup> Similarly, the Mozilla trademark policy served as a model for the Linux Foundation and the previous version of the Wikimedia trademark policy.<sup>235</sup> Still, there has often been some element of reinventing the wheel in developing these trademark hacks. This part of the Article seeks to develop a taxonomy to catalog the hacks. We structure the hacks into four main categories: (1) designating a trademark holder; (2) designating trademark protection for particular marks; (3) establishing trademark restrictions that respect community uses; and (4) designing the restrictions in a community-friendly manner. Not all of the hacks discussed in this part are appropriate for all types of trademarks and communities. Some of the hacks only work in combination with other hacks. None of them have been tried in court and so may not ultimately provide communities with the protection they intended. This part concludes with a discussion of how particular hacks fit into the approaches of different communities.

#### A. *Who Holds the Trademark?*

Trademark law does not recognize large decentralized communities as trademark holders.<sup>236</sup> Communities therefore had to develop trademark hacks that would allow them to take advantage of the protections of trademark law. A common strategy has been to identify one entity, association, or individual to be the legal

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projects that are very different from the traditional business models trademark law was intended to address.

<sup>233</sup> See *Trademark policy-purpose*, WIKIMEDIA FOUNDATION.ORG, [http://wikimediafoundation.org/wiki/Trademark\\_policy-purpose](http://wikimediafoundation.org/wiki/Trademark_policy-purpose) (last modified Feb. 18, 2014).

<sup>234</sup> Dries Buytaert, *Drupal trademark policy forthcoming*, BUYTAERT.NET (Nov. 22, 2007), <http://buytaert.net/drupal-trademark-policy-forthcoming>.

<sup>235</sup> *Trademark Policy (2009-2014)*, WIKIMEDIA FOUNDATION, [http://wikimediafoundation.org/wiki/Trademark\\_policy\\_\(2009-2014\)](http://wikimediafoundation.org/wiki/Trademark_policy_(2009-2014)) (last visited July 27, 2014).

<sup>236</sup> See *supra* note 61 and accompanying text.



holder of the mark.<sup>237</sup> This allows the entity to proceed with trademark registration and to be able to assert a common law trademark right in court. The entity can also carry out other important functions of a trademark holder, such as license the mark to third parties, enforce the mark against trademark abuse, and set up a community's trademark policy.<sup>238</sup> As a practical matter, managing a trademark portfolio involves a lot of day-to-day work that requires legal expertise. It would therefore be difficult to coordinate entirely through open collaboration.

Throughout this Article, we will refer to the entity that holds the trademarks on behalf of the community as a "steward." The steward may be a non-profit organization, which is asked by its community to hold the trademark rights on behalf of the community, or it may be a for-profit corporation that owns the community's mark in a more traditional sense. The trademark really represents the goodwill created by the community based on their work on the project. An organization can therefore be considered a steward regardless of its relationship with the community if the trademark's goodwill is generated through a collaborative effort. For example, we refer to Google as a steward of the Android wordmark on behalf of the community of developers who work on the Android operating system.

The category of hacks that establish a steward allows the marks of the collaborative communities to be trademarked. But this hack is not enough. On its own, it does not resolve the tension between collaborative communities and trademark law. Identifying one individual or entity to be the holder of the marks on behalf of the community has frequently resulted in conflict between the trademark holder and the other community members.<sup>239</sup> To be successful, the hacks in this category therefore need to be complemented by the hacks discussed in the other categories below.

While this hack on its own doesn't legitimize the restrictions imposed by trademark law in the eyes of community members, it is

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<sup>237</sup> See Pamela Chestek, *Who Owns the Open Source Project Name?*, 103 TRADEMARK REP. 1240, 1264-65 (2013), available at [http://home.comcast.net/~pchestek/Blog/103\\_TMR\\_1240.pdf](http://home.comcast.net/~pchestek/Blog/103_TMR_1240.pdf) (last visited Feb. 5, 2015).

<sup>238</sup> See, e.g., *id.*

<sup>239</sup> See, e.g., *infra* note 301 and accompanying text.

really effective with respect to the legal system. While a community can never collectively hold a trademark right, a steward may allow it to enjoy the fullest protection of trademark law. Though this solution has not been tested in court, a court would likely recognize the steward's trademark rights but not on behalf of a community. The community therefore needs to arrange a stewardship model that requires the steward to act in the interest of the community. Such a model naturally occurs if the steward is an organization that is only tasked with protecting and promoting the project, given that the community is able to fork the project under its free license if the steward didn't act in the best interest of the community.<sup>240</sup>

### 1. Community Member Steward

The first option is for one member of the community to act on behalf of the community and obtain a trademark registration. This approach may appear deceptively simple to those who are unfamiliar with the process of maintaining a trademark. Collaborative communities regularly allow individuals to register and maintain domain names, so it seems logical to believe that trademarks can be maintained in a similar manner. However, trademark registrations can be costly and difficult to administer.<sup>241</sup> If someone seeks to register a trademark without relevant expertise, they may not accurately describe or classify the work of the community when registering it or they may fail to properly maintain the registration. Additionally, they may risk upsetting other members of their community who have not agreed to a trademark registration.

In 2011, Mt.Gox, an online trading platform that specialized in Bitcoin, unilaterally decided to register the "BITCOIN" trademark in Japan and in some European jurisdictions.<sup>242</sup> Bitcoin is an open source cryptography-based currency that was launched in 2009.<sup>243</sup> The Bitcoin community consisted of a variety of passionate people who supported the currency's strong philosophy of

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<sup>240</sup> See *supra* notes 157–58 and accompanying text.

<sup>241</sup> See generally 84 AM. JUR. 3D *Proof of Facts* § 371 (2005).

<sup>242</sup> See Steven Shanafelt, *Mr. Gox parent company Tibanne to sell off "bitcoin" trademark and Bitcoins.com domain*, BITCOINX.COM (May 28, 2014), <http://www.bitcoinx.com/mt-gox-parent-company-tibanne-to-sell-off-bitcoin-trademark-and-bitcoins-com-domain/>.

<sup>243</sup> Maria Bustillos, *The Bitcoin Boom*, NEWYORKER.COM (Apr. 1, 2013), <http://www.newyorker.com/tech/elements/the-bitcoin-boom>.

anonymity and decentralization.<sup>244</sup> Even Bitcoin's creator remained cloaked in mystery.<sup>245</sup> The community lacked a central organization to oversee the currency's rapidly growing publicity and attention.<sup>246</sup> Community members were concerned that Mt.Gox would hold all legal rights over the name. To alleviate those concerns, Mt.Gox assured the public that the Bitcoin trademark would remain "freely available to anyone to use for whatever purpose whatsoever, whether that be for non-profit or commercial endeavors."<sup>247</sup> Unfortunately, Mt.Gox then faced legal and financial trouble in 2013 after its founder lost more than \$470 million USD worth of Bitcoin.<sup>248</sup> Mt.Gox declared bankruptcy, and then sold the Bitcoin trademark and domain name.<sup>249</sup> This case highlights the risks that a community could face by allowing individual community members to use a trademark without oversight. It could result in scandals that damage the brand's goodwill, or even in the potential transfer of the trademarks outside of the community due to unforeseeable circumstances.

Conceptually, the solution involving a community member steward is problematic because it eliminates the peer review that makes collaborative communities work. Unlike in a firm, where the contributors have been selected through a structured recruitment process, anyone can join a collaborative community.<sup>250</sup> Open collaboration works because there is extensive peer review of communi-

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<sup>244</sup> Unlike other currencies, Bitcoin is not backed by the credit of a government or the value of a precious resource. Instead, Bitcoin relies on cryptographic algorithms and a decentralized peer network to determine a coin's value.

<sup>245</sup> See Bustillos, *supra* note 243.

<sup>246</sup> It was not until September 2012 that members of the Bitcoin community started the Bitcoin Foundation as an umbrella organization, similar to the Linux Foundation, to support some of the Bitcoin community's work. See Jon Matonis, *Bitcoin Foundation Launches To Drive Bitcoin's Advancement*, FORBES (Sept. 27, 2012) available at <http://www.forbes.com/sites/jonmatonis/2012/09/27/bitcoin-foundation-launches-to-drive-bitcoins-advancement/>.

<sup>247</sup> See 'Bitcoin' Trade Mark Goes on Sale, SH&P (July 7, 2014), <http://www.shandp.com/bitcoin-trade-mark-goes-sale/>.

<sup>248</sup> See Robin Sidel et al., *Almost Half a Billion Worth of Bitcoins Vanish*, WALL ST. J. (Feb. 28, 2014), <http://online.wsj.com/articles/SB10001424052702303801304579410010379087576>.

<sup>249</sup> See Takashi Mochizuki, *Mt. Gox Operator Looks to Sell Bitcoin Trademarks*, WALL ST. J. (May 28, 2014), <http://blogs.wsj.com/japanrealtime/2014/05/28/mt-gox-operator-looks-to-sell-bitcoin-trademarks>.

<sup>250</sup> See BENKLER, *supra* note 1, at 60.

ty members' contribution. It is therefore problematic to delegate significant power over the trademarks to one individual, if they are not selected through a rigorous process. The selected individual may not be competent or loyal enough to carry out this task, and may not be checked by the peer review process that usually enables the company to work.

## 2. Umbrella Organizational Steward

There are a number of non-profit organizations that offer umbrella support and assistance to collaborative communities.<sup>251</sup> Part of their work is to provide assistance with trademark issues, such as community policy drafting, licensing, and enforcement.<sup>252</sup> Collaborative communities may not have an organized or formalized center that is capable of holding trademark registrations, so these communities may turn to an umbrella steward to fill this role.

A number of organizations may act as an umbrella steward, such as the Apache Foundation,<sup>253</sup> the Free Software Foundation,<sup>254</sup> Software in the Public Interest,<sup>255</sup> and the Software Freedom Conservancy.<sup>256</sup> The Software Freedom Conservancy,<sup>257</sup> for example, holds numerous trademarks for collaborative communities, such as Git<sup>258</sup> (an open source licensed source management tool, designed for Linux kernel development), Inkscape<sup>259</sup> (open

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<sup>251</sup> See e.g., SOFTWARE FREEDOM LAW CENTER, A LEGAL ISSUES PRIMER FOR OPEN SOURCE AND FREE SOFTWARE PROJECTS 19 (Richard Fontana et al. eds., 2008), available at <https://www.softwarefreedom.org/resources/2008/foss-primer.pdf>.

<sup>252</sup> See *id.*

<sup>253</sup> See APACHE SOFTWARE FOUNDATION, <http://www.apache.org/> (last visited Oct. 31, 2014).

<sup>254</sup> See FREE SOFTWARE FOUNDATION, <https://www.fsf.org/> (last visited Oct. 31, 2014).

<sup>255</sup> See SOFTWARE IN THE PUBLIC INTEREST, <http://www.spi-inc.org/> (last visited Oct. 31, 2014).

<sup>256</sup> See SOFTWARE FREEDOM LAW CENTER, *supra* note 251, at 20.

<sup>257</sup> See *Member Project Services*, SOFTWARE FREEDOM CONSERVANCY, <https://sfconservancy.org/members/services/> (last visited July 31, 2014).

<sup>258</sup> See *Git Trademark Policy*, GIT, <http://git-scm.com/trademark> (last visited Aug. 5, 2014).

<sup>259</sup> See *Inkscape Trademark Usage Policy*, INKSCAPE, <https://inkscape.org/en/about/trademark-policy/> (last visited Aug. 5, 2014).

source licensed vector graphics software), and Wine<sup>260</sup> (an open source licensed compatibility layer for Windows software). Software in the Public Interest<sup>261</sup> provides a similar service for Debian<sup>262</sup> (a Linux distribution) and OpenWrt<sup>263</sup> (a Linux distribution for embedded devices), whereas Software in the Public Interest will hold trademark registrations and allow the collaborative projects to manage their own trademark policies, practices, and enforcement.<sup>264</sup>

### 3. Internal Organizational Steward

Some larger collaborative communities have established specialized non-profit organizations, which usually play a role in the community's governance, finances, and assets, including trademarks.<sup>265</sup> Unlike the preceding umbrella organizational stewards or community member stewards, these are institutional members of their communities that are often involved in their projects at a deeper level. These organizations may not have strict control over a community and their activities, but they may act as stewards for the community's trademarks.

These internal organizational stewards include non-profit corporations, unincorporated associations, or similar organizations that were established by a community to support their projects.<sup>266</sup> They often have staff to take care of legal issues and help coordinate the projects. Examples include the Wikimedia Foundation,<sup>267</sup> the Mozilla Foundation,<sup>268</sup> and the Linux Foundation,<sup>269</sup> which are

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<sup>260</sup> See *Governance of Wine with Respect to the Software Freedom Conservancy*, WINE, <http://www.winehq.org/pipermail/wine-devel/2011-October/092707.html> (last visited Oct. 6, 2011).

<sup>261</sup> See *SPI Trademarks*, SOFTWARE IN THE PUBLIC INTEREST, <http://www.spi-inc.org/corporate/trademarks/> (last visited Jan. 29, 2011).

<sup>262</sup> See *About Debian*, DEBIAN, <https://www.debian.org/intro/about> (last visited Oct. 29, 2014).

<sup>263</sup> See *What is OpenWrt?*, OPENWRT, <https://openwrt.org/> (last visited Oct. 29, 2014).

<sup>264</sup> See *SPI Trademarks*, *supra* note 261.

<sup>265</sup> See SOFTWARE FREEDOM LAW CENTER, *supra* note 251, at 18–27.

<sup>266</sup> See *id.* at 17.

<sup>267</sup> See WIKIMEDIA FOUNDATION, INC. <https://wikimediafoundation.org/wiki/Home> (last visited Oct. 29, 2014).

<sup>268</sup> See THE MOZILLA FOUNDATION, <https://www.mozilla.org/en-US/foundation/> (last visited Oct. 29, 2014).

all non-profit organizations that support a decentralized group of contributors that work on collaborative projects. These organizations have various amounts of control over their projects. For example, the Mozilla Foundation has far more control over Firefox than the Linux Foundation has over the Linux kernel. An internal organizational steward may still depend on the other strategies outlined in this taxonomy to balance their control over their marks with the decentralized nature of their community.

### B. *What Type of Trademark?*

Despite the rigidity of trademark law, stewards have some flexibility in structuring their trademark portfolio when establishing a trademark right. As discussed in Part I, under U.S. law, a person can establish a trademark right in a name or a logo without registering it with the United States Patent and Trademark Office.<sup>270</sup> However, registration sometimes allows the rights holder more flexibility in designing an appropriate trademark right. It also provides better protection by putting others on notice of the right and creating an evidentiary presumption of the right. This category of hack to some extent relies on trademark registration to allow stewards to design special types of trademark rights.

#### 1. Distinct Community Trademark

Perhaps the most documented trademark hack is the development of two different trademarks to represent the community and the software or end product.<sup>271</sup> The most prominent example of this bifurcation is Red Hat Enterprise Linux and Fedora. Red Hat distributes open source code under the Red Hat trademark in the Red Hat Enterprise Linux distribution.<sup>272</sup> But it also sponsors a community project under a separate trademark—The Fedora Project—which is not controlled as tightly as the Red Hat trade-

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<sup>269</sup> See *About Us*, LINUX FOUNDATION, <http://www.linuxfoundation.org/about> (last visited Oct. 29, 2014).

<sup>270</sup> See *supra* Part I.

<sup>271</sup> See Dare & Anderson, *supra* note 228, at 107–08.

<sup>272</sup> See *Red Hat Trademark Guidelines*, RED HAT, [http://www.redhat.com/f/pdf/corp/RH-3573\\_284204\\_TM\\_Gd.pdf](http://www.redhat.com/f/pdf/corp/RH-3573_284204_TM_Gd.pdf) (last visited July 28, 2014).

mark.<sup>273</sup> The code developed in the Fedora project is incorporated into releases of Red Hat Enterprise Linux.<sup>274</sup> It allows developers to freely use the Fedora trademark without a trademark license or centralized control without the risk of losing the Red Hat trademark or confusing the consumers of Red Hat products.<sup>275</sup> There is also a symbolic connection between the two marks as the Red Hat “Shadowman” logo wears a fedora hat.<sup>276</sup>

While this bifurcation solves the problem of protecting the Red Hat mark, this hack does not offer sufficient protection to the Fedora mark. The Fedora mark itself is valuable because it is used for the Fedora community’s distributions of Linux, which are free and not validated by Red Hat.<sup>277</sup> The mark is also important to the Fedora contributors who identify the project by this mark. Losing this mark through naked licensing would therefore be detrimental to the Fedora Project even if the Red Hat logo remained protected.

A bigger problem with the bifurcation hack is that it weakens the connection between the brand and the project, which hurts the brand of the project and the legal protection of the project’s marks. The distinctiveness of a brand is important for recruiting new members to the project and for distributing the project to users. If a project is represented by two different logos, both logos will likely be less universally recognizable than if the project was focused under one recognizable mark. Dividing the goodwill among multiple marks will not only hurt the brand of the project, but may limit the trademark protection for both logos.<sup>278</sup> This is because trademark

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<sup>273</sup> See *Legal: Trademark Guidelines*, FEDORA PROJECT, [https://fedoraproject.org/wiki/Legal:Trademark\\_guidelines?rd=Legal/TrademarkGuidelines#Use\\_by\\_Red\\_Hat](https://fedoraproject.org/wiki/Legal:Trademark_guidelines?rd=Legal/TrademarkGuidelines#Use_by_Red_Hat) (last visited July 28, 2014).

<sup>274</sup> See *Red Hat Enterprise Linux*, FEDORA PROJECT WIKI, [http://fedoraproject.org/wiki/Red\\_Hat\\_Enterprise\\_Linux](http://fedoraproject.org/wiki/Red_Hat_Enterprise_Linux) (last visited Aug. 5, 2014) (explaining that Fedora is a distinct upstream release related to Red Hat Enterprise Linux).

<sup>275</sup> See *id.*

<sup>276</sup> See RED HAT, <http://www.redhat.com/en> (last visited Oct. 29, 2014).

<sup>277</sup> See generally *Legal: Trademark Guidelines*, *supra* note 273.

<sup>278</sup> When a mark or trade dress consists of a wide range of different packaging and promotional images for a number of different products, it is more difficult to provide that there is a common denominator among those various images which identifies plaintiff as the source. In that event, the ability to succeed in trademark infringement claims and to enforce the trademark would be attenuated to some extent which can never be accurately known or measured. 1 MCCARTHY, *supra* note 18, § 7:38:50.

law only protects marks that have come to represent a certain product or service.<sup>279</sup> So if the connection between the mark and the project is weak, its legal protection may also be shaky if challenged in a legal action. Creating multiple marks also creates a number of practical problems, since it provides more opportunities for inconsistencies in the project's visual identity.

## 2. Unregistered Mascots

Another prevalent trademark hack in collaborative projects is the development of a mascot that is not intended to be a registered trademark, often accompanied with a registered wordmark for the project. Examples of this hack include the Linux Tux mascot,<sup>280</sup> the Wikimedia Community logo,<sup>281</sup> the Android robot,<sup>282</sup> and the Java Duke mascot.<sup>283</sup> Because a steward does not claim a trademark right in the unregistered mascot on behalf of the community, the mascot can be used freely by the community without a trademark license.<sup>284</sup> The steward does not risk losing a trademark right in the mascot through naked licensing, as he or she doesn't claim that right in the first place. At the same time, it is a trademark hack because, although the community does not file a trademark registration for the mascot, it could arguably still rely on a common law trademark right in the mascot if it were abused.<sup>285</sup> However, protecting an unregistered mark is expensive because you need to actively look for others trying to register the mark so that they do not acquire a stronger right in the mark. This sort of ongoing management and research is particularly crucial in jurisdictions that prioritize early registrants of a mark rather than long-term users of a mark—so called “first-to-file countries.”<sup>286</sup> In reality, most collaborative communities will not have resources to defend an unregistered mascot if it is abused. At the same time, it is important to

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<sup>279</sup> *See id.*

<sup>280</sup> *See infra* Part II.B.2.a.

<sup>281</sup> *See infra* Part II.B.2.b.

<sup>282</sup> *See infra* Part II.B.2.c.

<sup>283</sup> *See infra* Part II.B.2.d.

<sup>284</sup> *See* Dare & Anderson, *supra* note 228, at 108.

<sup>285</sup> *See* 1 MCCARTHY, *supra* note 18, § 16:1 (defining common law trademark rights).

<sup>286</sup> *See id.* § 16:18 (explaining that the United States follows a first-to-use rule rather than a first-to-file rule for trademark ownership).



point out that a steward may technically retain a common law trademark right, despite leaving a mark unregistered.

Most stewards use the unregistered mascot to complement their registered trademark, which they control more tightly.<sup>287</sup> The idea is that if community members can use one mark without any restrictions, they will not care about the restrictions put in place on the other marks. In practice, however, the availability of a mascot may not make community members comfortable with registrations in other marks. It may cause the other marks for the same project to be less recognizable. Similar to the bifurcation hack discussed in the previous Section, this may weaken the symbolic connection between the registered trademark and the project, which in turn may weaken their legal protection and pose practical problems for consistency.

The value of having an unregistered mascot representing a collaborative community is that such a mascot can be used freely without requiring a trademark license and is thus more aligned with the collaborative community's values. But this solution is a calculated risk and is likely best suited for organizations that have decided it is more important to keep the community vibrant than maintain full legal control. With the exception of companies that have the resources to monitor for infringement and proactively defend unregistered mascots, such mascots represents a cost-benefit analysis in which it is cheaper to get a new logo if things go south than to deter community members from contributing to the project from the start.<sup>288</sup>

#### a) Linux's Tux Mascot

The Linux wordmark is a registered trademark held by the Linux Foundation.<sup>289</sup> It was registered following a trademark dispute between William R. Della Croce, Jr. and various individuals in the

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<sup>287</sup> See, e.g., *infra* Part II.B.2.a (Linux uses Tux as the company mascot and the Linux wordmark).

<sup>288</sup> See SOFTWARE FREEDOM LAW CENTER, *supra* note 251, at 44–48, 50 (discussing the difference between registered and unregistered marks and the general necessity of trademark rules).

<sup>289</sup> See *Sublicense More Information*, LINUX FOUNDATION, <http://www.linuxfoundation.org/programs/legal/trademark/sublicense-more> (last visited Oct. 30, 2014).

Linux community.<sup>290</sup> Della Croce had registered the mark a few months after the first Linux source code release and tried to use it to demand royalties from companies that released Linux distributions.<sup>291</sup> Given that Della Croce did not himself work on Linux, his demands were that of a “trademark troll.”<sup>292</sup> The legal dispute was ultimately resolved when Della Croce assigned his trademark registration to Torvalds, who in turn transferred it to the Linux Foundation.<sup>293</sup>

Unlike with the Linux wordmark, the Linux Foundation does not have a registered trademark in the Linux Tux mascot.<sup>294</sup> The mascot is, in the words of Torvalds, a “lovable, cuddly, stuffed penguin sitting down after having gorged itself on herring.”<sup>295</sup> It was designed by Larry Ewing based on a 1996 mailing list conversation between Torvalds and the Linux community.<sup>296</sup> Ewing created his own copyright license for the logo when releasing it with the following statement: “Permission to use and/or modify this image is granted provided you acknowledge me . . . and The GIMP (an open-source drawing program) if someone asks.”<sup>297</sup> But the copyright permission did not determine the trademark status of the mascot, which arises out of its use in association with Linux code.<sup>298</sup> So when another Linux community member started a software company called “Tux” and filed a trademark application for the Linux Tux mascot in Switzerland in 2004, his application was not rejected, as there was no pre-existing trademark applica-

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<sup>290</sup> See Hillesley, *supra* note 222.

<sup>291</sup> See *id.* As explained above, there are contradicting reports on the exact amount of royalties that Della Croce demanded.

<sup>292</sup> See *Trademark Troll*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Trademark\\_troll](http://en.wikipedia.org/wiki/Trademark_troll) (last visited May 19, 2014) (defining and explaining the term “trademark troll”).

<sup>293</sup> See Hillesley, *supra* note 222.

<sup>294</sup> See Tonya Gisselberg, *The Trademark History of Linux, the Operating System*, available at <http://www.gisselberglawfirm.com/downloads/linux.pdf>.

<sup>295</sup> See *History of Tux the Linux Penguin*, WIKIID, [http://www.sjbaker.org/wiki/index.php?title=The\\_History\\_of\\_Tux\\_the\\_Linux\\_Penguin](http://www.sjbaker.org/wiki/index.php?title=The_History_of_Tux_the_Linux_Penguin) (last modified Oct. 25, 2007, 19:25 GMT).

<sup>296</sup> See *id.*

<sup>297</sup> See Larry Ewing, LINUX 2.0 PENGUINS, <http://www.isc.tamu.edu/~lewing/linux/> (last visited Oct. 27, 2014).

<sup>298</sup> See *License for Pic of Tux*, JUST LINUX, <http://forums.justlinux.com/showthread.php?134693-license-for-pic-of-tux> (last visited Nov. 5, 2014).

tion for the mascot.<sup>299</sup> The community member wanted to protect the mascot from Microsoft and the Santa Cruz Operation, which around that time were initiating legal actions against various Linux distributors.<sup>300</sup> He planned to set up a trademark policy for the Tux mascot to allow community members to continue to use the mascot freely, but other Linux community members were unhappy with his initiative.<sup>301</sup> There were heated discussions on community mailing lists and the Swiss Linux User Group, which held the Linux trademark in Switzerland, threatened to prevent the Tux registrant from using the wordmark Linux if he continued to restrict use of the Tux mascot.<sup>302</sup> Ultimately, the Tux registrant allowed the application to lapse and the Tux mascot remained unregistered.<sup>303</sup>

While the Linux Foundation does not have a registered trademark right in the Tux mascot, it may still be able to claim a common law trademark right in it if someone outside the Linux community were to try to register it or use it in a way that made it difficult for the Linux community to use Tux as its mascot. But claiming such a right would be legally challenging, even in countries where common law trademarks are recognized, because of the minimal control that communities usually have over their mascot. Given that the mascot has now been used by many different groups in vastly different contexts without a trademark license, it would be difficult to refute arguments that the mark has been lost through naked licensing. Perhaps more importantly, a common law trademark claim would likely be politically difficult within the community given the history of the mascot.

#### b) Wikimedia's Community Logo

The Wikimedia community has also established an unregistered logo to represent the community through a similarly messy process. Wikimedia has around 35 different logos, most of which

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<sup>299</sup> See *id.*; see also U.S. Trademark Application Serial No. 78,460,364 (filed Aug. 2, 2004).

<sup>300</sup> See generally *SCO Registers UNIX(R) Copyrights and Offers UNIX License*, THE SCO GROUP (July 21, 2003), <http://www.prnewswire.com/news-releases/sco-registers-unix-copyrights-and-offers-unix-license-70806027.html>.

<sup>301</sup> See *License for Pic of Tux*, *supra* note 298.

<sup>302</sup> See *id.*

<sup>303</sup> See U.S. Trademark Application Serial No. 78,460,364 (filed Aug 2, 2004).

represent its different projects.<sup>304</sup> In 2006, Wikimedia user WarX designed a “Community logo” and uploaded it with a public domain license to Wikimedia Commons, a repository of freely licensed and public domain media.<sup>305</sup> Two years later, Wikimedia community members voted to use this logo as the main logo for the Wikimedia Meta-Wiki site, where community members from different Wikimedia projects discuss and coordinate their work.<sup>306</sup> By 2012, this logo had become a recognizable symbol for the Meta-Wiki site.<sup>307</sup> The Wikimedia Foundation—which hosts the Wikimedia sites—then filed a trademark registration for the Community logo along with the other logos that represent the different sites and were by then still unregistered.<sup>308</sup> This caused a controversy in the Wikimedia community, when community members discovered the registration years later.<sup>309</sup> WarX wrote an email to his local Wikimedia community stating that he had intended the logo to be “completely free” so that people would be able to freely use it to identify themselves as Wikimedians.<sup>310</sup> Four community members, including WarX, initiated a vote to “reclaim the logo” and filed a legal opposition to the Wikimedia Foundation’s registration of the logo in Europe.<sup>311</sup> In response, the Wikimedia Foundation set up a community consultation to determine the fate of the logo.<sup>312</sup> After a 75-day consultation, with extensive discussion by the community, the consensus was to withdraw the global trademark registration

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<sup>304</sup> See *Wikimedia Trademarks*, WIKIMEDIA FOUNDATION, [http://wikimediafoundation.org/wiki/Wikimedia\\_official\\_marks](http://wikimediafoundation.org/wiki/Wikimedia_official_marks) (last modified June 2, 2014, 19:11 GMT).

<sup>305</sup> See *Wikimedia Community Logo*, WIKIMEDIA COMMONS, [https://commons.wikimedia.org/w/index.php?title=File:Wikimedia\\_Community\\_Logo.svg&oldid=3874313](https://commons.wikimedia.org/w/index.php?title=File:Wikimedia_Community_Logo.svg&oldid=3874313) (last modified Dec. 25, 2006, 11:19 GMT).

<sup>306</sup> See *Meta:Babel/Metawiki Logo Poll*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/Meta:Babel/Metawiki\\_logo\\_poll](http://meta.wikimedia.org/wiki/Meta:Babel/Metawiki_logo_poll) (last visited Sept. 7, 2008).

<sup>307</sup> See generally *Wikimedia Community Logo*, *supra* note 305 (showing that more than 100 pages link to the community logo).

<sup>308</sup> See U.S. Trademark Application Serial No. 85,671,072 (filed July 7, 2012).

<sup>309</sup> See *Community Logo: Reclaim the Logo*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/Community\\_Logo/Reclaim\\_the\\_Logo](http://meta.wikimedia.org/wiki/Community_Logo/Reclaim_the_Logo) (last modified July 28, 2014, 7:57 UTC).

<sup>310</sup> See E-mail from Arthur Fijałkowski, Community Logo Creator, to Wikimedia Community (Mar. 11, 2013, 1:03:30 PM UTC), available at <http://lists.wikimedia.org/pipermail/wikipl-l/2013-March/036566.html>.

<sup>311</sup> See *Community Logo: Reclaim the Logo*, *supra* note 309.

<sup>312</sup> See *Community Logo/Request for Consultation*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/Community\\_Logo/Request\\_for\\_consultation](http://meta.wikimedia.org/wiki/Community_Logo/Request_for_consultation) (last modified May 14, 2014, 14:29 GMT).

for the logo and leave it as an unregistered mascot so that community members could freely use it to identify themselves.<sup>313</sup>

### c) Android's Robot Logo

Rather uncharacteristically for unregistered mascots, the Android robot logo was created without much community drama. Google chose to not file a trademark application for the Android robot logo, despite having filed over 300 trademark applications for other marks with the United States Patent and Trademark Office (and likely many more globally).<sup>314</sup> Commentators have argued that Google strategically decided not to register the logo to build greater recognition around a brand that may not otherwise receive trademark protection.<sup>315</sup> Indeed, Google's registration for the Android wordmark was suspended in 2008 because of a likelihood of confusion with a previous registration for the wordmark "Android Data," and the application is still pending as of 2014.<sup>316</sup> On the other hand, the Android robot logo alone has come to stand for the Android phone without the wordmark, which is quite unusual for logos.<sup>317</sup>

It is possible that Google, by maintaining the Android robot logo unregistered, was trying to facilitate viral use in order to make the logo more recognizable and thus ultimately attain trademark rights over the Android brand.<sup>318</sup> The more likely reason is that Google was trying to create a freely usable logo to attract more open source developers to the Android operating system.<sup>319</sup> As a for-profit company trying to benefit from open source development, it is important for Google to make a point of nurturing its community of developers. In that sense, Google's position is dif-

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<sup>313</sup> See *id.*

<sup>314</sup> See *Android: Building a Brand Around an Open-Source Trade Mark*, IPKAT (Oct. 15, 2013), <http://ipkitten.blogspot.com/2013/10/android-building-brand-around-open.html>.

<sup>315</sup> See *id.*

<sup>316</sup> See *id.*; see also U.S. Trademark Application Serial No. 77,318,565 (filed Oct. 31, 2007).

<sup>317</sup> See IPKAT, *supra* note 314.

<sup>318</sup> See *id.*

<sup>319</sup> See Pagan Kennedy, *Who Made That Android Logo?*, N.Y. TIMES, Oct. 11, 2013, [http://www.nytimes.com/2013/10/13/magazine/who-made-that-android-logo.html?\\_r=0](http://www.nytimes.com/2013/10/13/magazine/who-made-that-android-logo.html?_r=0) ("[The creators of the logo] agreed that the logo, like the software, should be open-sourced.").

ferent from that of an organizational steward set up to serve its collaborative community with a mission that is completely aligned with its community.

Interestingly, while Google decided to not register the Android robot logo, the Android trademark policy still states that others “may not file trademark applications incorporating the Android logo.”<sup>320</sup> So, it seems that Google is trying to reserve its common law trademark right in the logo, which it may invoke if anyone attempts to register the logo. Here again, Google is in a different position than most other projects with unregistered mascots. With an army of hundreds of lawyers and a big budget, Google can afford to monitor and oppose trademark registrations all over the world based on this common law right, whereas the typical open source community would probably just have to let it go.

#### d) Java’s Duke Mascot

Duke is another example of an unregistered mascot established by a for-profit company.<sup>321</sup> It was launched by Sun Microsystems to represent the community of Java developers.<sup>322</sup> Sun, which introduced the Java programming language, also established an official trademark for Java in the “coffee cup” logo.<sup>323</sup> Duke—a black and white cartoon character with a big red nose—was originally designed by Joe Palrang to be a user interface assistant for the handheld home entertainment controller Star7, similar to Clippit in Microsoft Office.<sup>324</sup> Though Sun first appeared to have claimed trademark in Duke, it eventually placed the logo under a BSD “2-clause”<sup>325</sup> license in 2006, at the same time it released Java soft-

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<sup>320</sup> *Brand Guidelines*, ANDROID.COM, <http://developer.android.com/distribute/tools/promote/brand.html> (last visited July 28, 2014).

<sup>321</sup> *See Duke, the Java mascot*, PROJECT KENAI (Jan. 25, 2010), <https://kenai.com/projects/duke/pages/Home>.

<sup>322</sup> *See id.*

<sup>323</sup> U.S. Trademark Registration No. 4099478.

<sup>324</sup> *See A Brief History of the Green Project*, PROJECT KENAI (July 27, 2009), <https://kenai.com/projects/duke/pages/GreenProject>; *see also Duke, the Java Mascot*, JAVA.NET (Aug. 5, 2014), <https://www.java.net/duke-java-mascot>.

<sup>325</sup> *See supra* text accompanying note 208.

ware under an open source license.<sup>326</sup> Although the BSD license does not technically cover any trademark rights, the intention was clearly to allow people to use Duke as a customizable representative of the Java community.<sup>327</sup> Sun provided guidance that anyone could “give Duke a personal touch,” with only minimal restrictions,<sup>328</sup> and provided a gallery of the community’s customized Duke mascots.<sup>329</sup> After Sun was acquired by Oracle in 2010, Oracle continued to protect the Java programming language’s trademarked name and logo while maintaining Duke more freely usable by the Java community.<sup>330</sup> But similar to the Android robot logo, some sources suggest that Oracle may want to claim a common law trademark right in Duke.<sup>331</sup>

Curiously, the Java community did not find the Duke mascot to be sufficiently free.<sup>332</sup> They set up another mascot for Java users and user groups called Juggy.<sup>333</sup> The purpose of this mascot was “to let all JUGs use Juggy and be creative on top of it, instead of deriving from a trademarked logo or mascot.”<sup>334</sup> However, they chose to license the mascot under a Creative Commons Attribution-NonCommercial-ShareAlike 2.5 License,<sup>335</sup> which is not considered to be free by some collaborative communities because it does not allow reuse for commercial purposes.<sup>336</sup>

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<sup>326</sup> See Bruno Souza, *JUGs, Trademarks, Copyright, and Open Source*, LIFE, THE UNIVERSE AND EVERYTHING . . . (Jan. 20, 2011), <http://java.mn/2011/01/20/jugs-trademarks-copyrights-and-open-source/>.

<sup>327</sup> See *supra* text accompanying note 208.

<sup>328</sup> See *License for Pic of Tux*, *supra* note 298 (“All we ask is that you treat Duke with the same respect that Sun has.”).

<sup>329</sup> See *Duke Images*, <https://duke.kenai.com/> (last visited Nov. 10, 2014).

<sup>330</sup> See *Duke, the Java Mascot*, ORACLE, <http://www.oracle.com/us/technologies/java/duke-424174.html> (last visited Nov. 10, 2014).

<sup>331</sup> See *Juggy, the Java Finch*, JAVA.NET, <https://thejavafinch.java.net/> (last visited Nov. 10, 2014) (“Juggy is a member of a strong and numerous family of Java users, and also a distant relative of Duke[tm].”).

<sup>332</sup> See Souza, *supra* note 326.

<sup>333</sup> See *Juggy, the Java Finch*, *supra* note 331.

<sup>334</sup> See *id.*

<sup>335</sup> See *id.*

<sup>336</sup> See *Definition of Free Cultural Works*, <http://freedomdefined.org/Definition> (last modified Dec. 1, 2008).

### 3. Collective Membership Mark

Unlike the other hacks in this taxonomy, the collective membership mark<sup>337</sup> has not actually been used by collaborative communities or their stewards. It is a solution developed by the authors of this Article and proposed to the Wikimedia community in an online consultation.<sup>338</sup> As we discuss below, this solution was ultimately rejected despite strong support from many community members, primarily due to the complicated history of the logo for which we suggested the collective membership mark. Additionally, there was concern that defining the membership, no matter how inclusive the definition, was inconsistent with the community's value of openness. Although the collective membership mark was not used for that logo, we still believe it provides the best balance between free community use and control against abuse. The collective membership mark has been used by organizations like the American Bar Association, Rotary International, Toastmasters, fraternities, and motorcycle clubs.<sup>339</sup> Most significantly, the Freecycle community adopted the collective membership mark in 2012 to avoid its naked licensing problems.<sup>340</sup> Although it has not previously been used by free culture and open source communities, the characteristics of the collective membership mark lend themselves to solving the tension between decentralized collaboration and centralized trademark requirements.

Unlike an ordinary trademark or a collective trademark, a collective membership mark does not necessarily represent a product or a service.<sup>341</sup> Instead, it represents that individuals using the mark are members of a club of sorts under established criteria. The

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<sup>337</sup> TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1302 (4th ed. 2005).

<sup>338</sup> See *Talk:Community Logo/Request for consultation*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/Talk:Community\\_Logo/Request\\_for\\_consultation](http://meta.wikimedia.org/wiki/Talk:Community_Logo/Request_for_consultation) (last modified Dec. 16, 2013). This solution was inspired by an industry publication that advised non-profits to consider the collective membership mark as a solution to naked licensing. This solution turned out to be even more applicable to collaborative communities that may or may not have a non-profit as the holder of their trademarks. See Andrew D. Price, *Nonprofits: Don't Get Caught Naked (Licensing)*, ASSOCIATION TRENDS (Mar. 10, 2011), <http://www.venable.com/nonprofits—dont-get-caught-naked-licensing-03-01-2011/>.

<sup>339</sup> See, e.g., AMERICAN BAR ASSOCIATION, Registration No. 0745593.

<sup>340</sup> See *Freecycle.org Terms of Service*, FREECYCLE, <https://www.freecycle.org/tos> (last visited Nov. 10, 2014).

<sup>341</sup> TRADEMARK MANUAL OF EXAMINING PROCEDURE §1304.01 (4th ed. 2005).



members can therefore use the mark without a license and without the risk of naked licensing. But the trademark can still be used to prevent unauthorized uses of the mark. It can also optionally represent a product in addition to representing the members. The problem with the collective membership mark is that you need to establish criteria to determine who qualifies as a community member.<sup>342</sup> But given that most collaborative communities organize around contributions to a project, a steward should be able to condition the use of the collective membership mark on a minimal amount of contribution to the project. For an open source community, for example, this could be a few lines of code. Projects that do not involve software could instead focus on the number of edits community members contribute to projects.

It should be noted that the effect of using a collective membership mark for collaborative communities cannot be achieved absolutely with a collective trademark or a certification mark, both of which are commonly confused with the collective membership mark. A collective trademark is used by members of an organization to identify and distinguish their goods or services.<sup>343</sup> It requires the organization to identify its members' goods or services when registering the mark.<sup>344</sup> The organization that holds the collective trademark would not normally offer any goods or services itself.<sup>345</sup> It is therefore not applicable to a collaborative community where an organization usually hosts the product of the collaborative community and releases it for public consumption. The organization may also not know what material community members will want to place the mark on ahead of time and would therefore not be able to file for a collective trademark. The collective trademark is often confused with the collective membership mark because the Lanham Act does not expressly distinguish between the two.<sup>346</sup>

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<sup>342</sup> This requirement was rather controversial for the Wikimedia community, where members have very different ideas as to what characterizes membership in the movement. But even for the Wikimedia community, this is not an impossible problem, given that the community has previously accepted certain standards for particular privileges, such as voting to elect members to the Wikimedia Board of Trustees.

<sup>343</sup> See 15 U.S.C. § 1127 (2006); see also 3 MCCARTHY, *supra* note 18, § 19:99.

<sup>344</sup> See TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1303 (4th ed. 2005).

<sup>345</sup> See 3 MCCARTHY, *supra* note 18, § 19:100.

<sup>346</sup> See *id.* § 19:98.

A certification mark<sup>347</sup> is similarly not appropriate for a collaborative community as it is used to certify goods that meet a certain standard.<sup>348</sup> The Open Source Initiative, which certifies that projects comply with its definition of open source, has registered a certification mark.<sup>349</sup> But a certification mark cannot be used by a separate open source project or another type of collaborative community because it requires a level of centralized control that is inconsistent with their values.

### C. *What Trademark Restrictions?*

Websites with popular brands often include a legal policy explaining their trademark and brand usage guidelines.<sup>350</sup> These documents include trademark provisions, including restrictions on certain types of uses and instructions on acceptable forms of uses. Websites may be eager to have their brands used by others, as a way to build recognition and traffic on the Internet. A trademark policy document is one mechanism whereby collaborative communities can establish their trademark restrictions.

After deciding whether and how to register a mark, a steward has a choice of which restrictions to impose on the use of the mark. Given the collaborative nature of these types of communities, they will usually benefit from imposing few restrictions to allow more people to promote the project and recruit new contributors. But they cannot just decide that anyone can use the marks for whatever purpose, as that could result in loss of legal protection for the marks. Instead, they can leverage the fair use doctrine under trademark law and the policy behind trademark protection to establish very limited restrictions.

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<sup>347</sup> See 15 U.S.C. § 1127 (2012).

<sup>348</sup> See *What is a certification mark?*, USPTO, [http://www.uspto.gov/faq/trademarks.jsp#\\_Toc275426676](http://www.uspto.gov/faq/trademarks.jsp#_Toc275426676) (last modified Apr. 23, 2013).

<sup>349</sup> OPEN SOURCE INITIATIVE, Registration No. 3514190.

<sup>350</sup> See *Twitter's Brand Usage Guidelines*, TWITTER, <https://about.twitter.com/press/twitter-brand-policy> (last visited Nov. 11, 2014); *Google's Trademark Rules*, GOOGLE, <http://www.google.com/permissions/trademark/rules.html> (last visited Nov. 11, 2014).

### 1. Built-in Fair Use<sup>351</sup>

While US trademark law imposes many restrictions on how rights holders can allow others to use the mark, it also leaves a lot of room for speech-related activities.<sup>352</sup> The unique fair use doctrine under trademark law allows any use of a wordmark in a non-trademark sense (i.e., when the word could mean something other than the trademark).<sup>353</sup> Trademark law also has a “nominative use” doctrine.<sup>354</sup> This doctrine allows free uses of a mark to refer to the item branded with that name.<sup>355</sup> Finally, trademark law also embraces the use of marks in art and political speech.<sup>356</sup> The spectrum of free uses of a trademark distinguishes this body of law from intellectual property rights like copyright and patent.

Take the registered trademark “Red Hat” — which is owned by an open-source software distributor—to illustrate how these speech-protecting doctrines work in practice.<sup>357</sup> Under trademark law generally, others are not barred from using “Red Hat” to name a good or service distinct from open source distribution, such as a restaurant or a bed & breakfast.<sup>358</sup> Under the trademark fair use doctrine, a person can naturally use the words “red hat” to mean “a red head covering.” Under the nominative use doctrine, a person can further identify the specific software company correctly as “Red Hat” in a magazine, provided she takes reasonable measures to ensure that there is no confusion between Red Hat and the magazine. Under trademark law’s broadest speech protection, the exact Red Hat logo can also be used as part of a work of art such as a collage or in a parody to make a political statement.

A steward can leverage the broad speech protection under US law to enable community members to use its marks without a

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<sup>351</sup> This section largely uses text that we previously prepared for the Wikimedia trademark policy.

<sup>352</sup> See *Trademark policy*, WIKIMEDIA FOUNDATION, [http://wikimediafoundation.org/wiki/Trademark\\_policy](http://wikimediafoundation.org/wiki/Trademark_policy) (last visited Nov. 6, 2014).

<sup>353</sup> See *id.*

<sup>354</sup> See *id.*

<sup>355</sup> See *id.*

<sup>356</sup> See *id.*

<sup>357</sup> See *A Brief History of Red Hat Linux*, TECHOTOPIA, [http://www.techotopia.com/index.php/A\\_Brief\\_History\\_of\\_Red\\_Hat\\_Linux](http://www.techotopia.com/index.php/A_Brief_History_of_Red_Hat_Linux) (last modified Dec. 15, 2010).

<sup>358</sup> See, e.g., THE RED HAT BED & BREAKFAST, <http://www.theredhat.com/> (last visited Nov. 11, 2014).

trademark license, without running the risk of naked licensing. For example, in the Firefox–Iceweasel dispute discussed in the Introduction, the Mozilla Foundation could have clarified that community members may distribute modifications of Firefox without the Foundation’s approval and that the Firefox trademark could be used nominatively by community members to clarify that they are distributing a “Debian modification of Firefox.” This would technically be a fork of Firefox, and collaborative communities usually have a lot of anxiety about their project getting forked. But sometimes making it clear that forking is an option and clarifying how it can be done brings the community closer because community members feel like they have the freedom to take action if they don’t like how the project evolves.

The problem is that many community members are not aware of the limits of trademark law and therefore have a hard time distinguishing between activities that require a trademark license and those that do not. In the Wikimedia trademark policy consultation, community members expressed doubt about whether they could use the marks in news reports,<sup>359</sup> personal blogs and social media,<sup>360</sup> slides for presentations,<sup>361</sup> and other material. A user-friendly trademark policy can include special provisions for different types of fair use to make it easier for community members to know when they have a legal right to use the marks. It can further include explanations in a Frequently Asked Questions (FAQ) format to address specific situations that community members express confusion over.<sup>362</sup> As a document external to the actual text of the trademark policy, the FAQ can be expanded to cover additional

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<sup>359</sup> See *What is the policy about use in News reports*, WIKIMEDIA, [https://meta.wikimedia.org/wiki/Talk:Trademark\\_practices\\_discussion#What\\_is\\_the\\_policy\\_about\\_use\\_in\\_News\\_reports](https://meta.wikimedia.org/wiki/Talk:Trademark_practices_discussion#What_is_the_policy_about_use_in_News_reports) (last modified Nov. 19, 2013).

<sup>360</sup> See *What is the policy on use in personal blogs, facebook pages etc?*, WIKIMEDIA, [https://meta.wikimedia.org/wiki/Talk:Trademark\\_practices\\_discussion#What\\_is\\_the\\_policy\\_on\\_use\\_in\\_personal\\_blogs.2Cfacebook\\_pages\\_etc\\_.3F](https://meta.wikimedia.org/wiki/Talk:Trademark_practices_discussion#What_is_the_policy_on_use_in_personal_blogs.2Cfacebook_pages_etc_.3F) (last modified Nov. 19, 2013).

<sup>361</sup> See *Concerns regarding the current trademark policy and practice*, WIKIMEDIA, [https://meta.wikimedia.org/wiki/Talk:Trademark\\_practices\\_discussion#Concerns\\_regarding\\_the\\_current\\_trademark\\_policy\\_and\\_practice](https://meta.wikimedia.org/wiki/Talk:Trademark_practices_discussion#Concerns_regarding_the_current_trademark_policy_and_practice) (last visited Nov. 11, 2014).

<sup>362</sup> See *Trademark practices discussion*, WIKIMEDIA, [https://meta.wikimedia.org/wiki/Trademark\\_practices\\_discussion#%20](https://meta.wikimedia.org/wiki/Trademark_practices_discussion#%20) (last modified Sept. 27, 2013).

situations based on new questions from community members as they start applying the policy.

A steward can further broadly interpret fair use to facilitate even greater use by community members. Fair use doctrines generally do not provide very bright line rules. Courts frequently apply an “I know it when I see it” approach to fair use.<sup>363</sup> As a practical matter, trademark holders have a lot of discretion whether or not to prosecute cases that are in the grey area. A trademark policy can therefore deem borderline cases to be fair use and provide greater predictability for community members who want to use the marks for those purposes.<sup>364</sup> In particular, it could state that it will apply a broad interpretation of fair use under US trademark law and do so globally, so that community members in other countries do not have to worry about infringement when using a trademark to advance the project without entering into a trademark license with the steward.<sup>365</sup> Embracing a broad interpretation of fair use is consistent with the ethos of collaborative communities. And if the steward is clear about its view that certain uses are fair use, a court is unlikely to later find that it was actually a use that required a trademark license and therefore would have exposed the mark to naked licensing.

## 2. Focusing on Public-Facing Risk

The broad interpretation of fair use can further be supplemented by trademark permissions based on a careful interpretation of the policy rationale behind the control requirement in the naked licensing doctrine. As discussed *supra* in Part I.A.1, the reason trademark law deprives a trademark holder of her trademark rights through naked licensing when she does not exercise sufficient quality control is to protect the users of the products that carry the marks.<sup>366</sup> This doctrine wants users to be able to rely on a consistent quality of products that carry the same identifying marks. A trademark holder that fails to ensure consistent quality is consi-

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<sup>363</sup> See, e.g., *Cariou v. Prince*, 714 F.3d 694, 705 (2d Cir. 2013).

<sup>364</sup> *Talk:Trademark policy - “Fair use” is a U.S. concept not worldwide*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/Talk:Trademark\\_policy#.22Fair\\_use.22\\_is\\_a\\_U.S.\\_concept.2C\\_not\\_worldwide](http://meta.wikimedia.org/wiki/Talk:Trademark_policy#.22Fair_use.22_is_a_U.S._concept.2C_not_worldwide) (last visited Nov. 11, 2014).

<sup>365</sup> See *id.*

<sup>366</sup> See *supra* Part I.A.1.

dered to confuse users. It follows then that a court is less likely to find naked licensing in situations where users are less likely to be confused because of the context in which the mark is presented.

Based on this policy rationale, community members should be able to use the marks without a trademark license when they plan to show the marks to other community members. This allows a steward to eliminate restrictions for trademark uses that may interfere with the community's work. Those trademark uses are often in a context where it is reasonably clear how the marks relate to the projects and is therefore not likely to confuse users.

Collaborative communities, through their steward, may have adopted trademark practices that are consistent with trademark law, but for reasons that are not related to a trademark risk analysis. Stewards may have intuitively developed trademark policies that exempt uses with low likelihood of consumer confusion from the license requirement for a practical reason: those uses are important for promotion of their projects. For example, the Python trademark policy allows non-commercial uses of the mark to promote the Python programming language.<sup>367</sup> The Fedora trademark policy allows community members to place Fedora trademarks on a personal web site or blog to support Fedora.<sup>368</sup> The Wikimedia trademark policy allows many different community uses without a license, like the use of marks on the Wikimedia sites, for events intended to be attended primarily by community members, and for outreach activities to recruit new community members.<sup>369</sup> The Canonical trademark policy goes one step further and grants a general license to the community for all non-commercial uses.<sup>370</sup> Many other collaborative projects have similar terms in their policies.<sup>371</sup>

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<sup>367</sup> See *PSF Trademark Usage Policy*, PYTHON SOFTWARE FOUNDATION, <https://www.python.org/psf/trademarks/> (last visited Nov. 5, 2014).

<sup>368</sup> See *Legal: Trademark guidelines*, FEDORA PROJECT, [https://fedoraproject.org/wiki/Legal:Trademark\\_guidelines?rd=Legal/TrademarkGuidelines#Usage\\_That\\_Does\\_Not\\_Require\\_Permission%20](https://fedoraproject.org/wiki/Legal:Trademark_guidelines?rd=Legal/TrademarkGuidelines#Usage_That_Does_Not_Require_Permission%20) (last visited Nov. 5, 2014).

<sup>369</sup> See *Wikimedia Trademark policy*, WIKIMEDIA FOUNDATION, [http://wikimediafoundation.org/wiki/Trademark\\_policy](http://wikimediafoundation.org/wiki/Trademark_policy) (last modified July 8, 2014).

<sup>370</sup> See Amanda Brock, *Introduction*, in Dare & Anderson, *supra* note 228.

<sup>371</sup> Some collaborative communities have contemplated the value of making it easier for community members to use marks for community facing uses. For example, Inkscape's trademark policy allows communities to use its marks in the context of their use of the Inkscape software. See *Inkscape Trademark Usage Policy*, INKSCAPE, <http://>

### 3. Prohibiting Damaging Uses

While it is possible to allow for many uses through a liberal interpretation of fair use and the policy rationale behind trademark licensing requirements, it is still important to clearly identify uses that may harm a collaborative community's project. A trademark policy should prohibit harmful uses in a clear way so that community members are notified of such boundaries to their use of a trademark. In reality, community members would rarely use a mark in a manner that is prohibited because such uses are contrary to the mission of their project. Clearly identifying prohibited uses in a trademark policy also lends legitimacy to the policy, as community members get to see examples of harmful uses that can be prevented with trademark protection.

One example of clearly identified prohibited uses can be found in the Apache Software Foundation's trademark policy, which expressly prohibits using its marks to disparage the Apache Software Foundation, its projects, members, or communities.<sup>372</sup> Similarly, the trademark policy governing the use of Mozilla Foundation's marks, including Mozilla Firefox and Mozilla Thunderbird, bans confusing and disparaging uses that intend to defame or sully the reputation of the Mozilla Foundation.<sup>373</sup> The trademark policy of the Debian Project, among others, not only prohibits disparaging uses but also uses that are false and misleading.<sup>374</sup> A steward may also want to clearly identify harmful uses in language that is specif-

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[www.inkscape.org/en/about/trademark-policy/](http://www.inkscape.org/en/about/trademark-policy/) (last visited Oct. 26, 2014) ("When referring to communities of users in the context of their use of the Inkscape software, e.g., virtual communities, community-moderated online forums, consortia of organizational users, etc., provided that the Marks are not used to suggest endorsement of any user community by the Inkscape Project."). Similarly, the Gentoo Foundation has granted Gentoo community sites the right to use the Gentoo wordmark in a project name and domain name subject to certain qualifications. See *Gentoo Name and Logo Usage Guidelines*, GENTOO, <http://www.gentoo.org/main/en/name-logo.xml> (last visited Oct. 26, 2014). In addition, jQuery allows users to use its logo to promote jQuery meetups. See *jQuery Brand Guidelines*, JQUERY, <http://brand.jquery.org/logos/> (last visited Oct. 26, 2014).

<sup>372</sup> See *Apache Trademark Policy*, APACHE TRADEMARK FOUNDATION, <http://www.apache.org/foundation/marks/> (last visited Oct. 26, 2014).

<sup>373</sup> See *Mozilla Foundation Trademark Policy*, MOZILLA FOUNDATION, <https://www.mozilla.org/en-US/foundation/trademarks/policy/> (last visited Oct. 26, 2014).

<sup>374</sup> See *Debian Trademarks*, DEBIAN, <https://www.debian.org/trademark> (last visited Oct. 26, 2014).

ic to its projects. For example, Wikimedia's trademark policy states that misleading mirrors and mimicking sites (those that mimic the "look and feel" of a Wikimedia site) are particularly harmful to the value created by community members and are thus deemed prohibited without permission.<sup>375</sup>

Broadly speaking, prohibitions on damaging uses of marks found in the trademark policies of collaborative projects focus on banning uses that are intended to mislead or confuse the consumer and are thus intended to protect the value and integrity created by the community and its projects.<sup>376</sup> Though community members are unlikely to use marks in a disparaging fashion, articulating prohibited uses in a trademark policy is a useful way of clarifying what uses may be deemed harmful and forbidden outside of fair use. Further, since making those using trademarks aware of prohibited damaging uses saves them worry and protects value created by the community, a steward may want to place its clear identification of such uses towards the beginning of its policy.

#### *D. How Are Trademark Restrictions Designed?*

Trademark restrictions can be designed in a manner that makes them feel less limiting. One way to do this is by designing the restrictions through a collaborative process that is more aligned with the ethos of collaborative communities. If community members come together to set up the restrictions, they will likely design them in a manner that is less burdensome for their work. Community members may also feel that the restrictions are more legitimate if they are decided through consensus. Designing restrictions through a collaborative process may also make it easier and faster for community members to comply with the restrictions. This could be by making the restrictions more obvious or by reducing trademark licensing to what is strictly necessary. Some of these techniques can actually benefit companies as well as collaborative communities. But they are more important for members of collaborative communities because they have a natural sense of ownership over the project brand and will naturally feel that any restriction on their use of that brand is unduly burdensome.

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<sup>375</sup> See *Wikimedia Trademark policy*, *supra* note 369.

<sup>376</sup> See, e.g., *id.*



### 1. Decentralized Development

A steward's centralized decision-making over trademarks is naturally at odds with the decentralized decision-making that made the collaborative project successful in the first place. As discussed *supra* in Part I.B, decentralization is a core characteristic for collaborative communities. One way to ease this tension is by establishing guidelines for trademark use in a decentralized manner and inviting entire communities to participate in this process. The idea is that the community collaborates in establishing rules for how the trademarks may be used and delegates the power to the steward to administer the guidelines.

Several free software groups have developed trademark policies by discussing them on a public mailing list. For example, in the summer of 2012, the Debian Project Leader posted a draft trademark policy on a Debian mailing list for discussion among developers.<sup>377</sup> The policy was prepared by a few key people within the project and reviewed by lawyers at the Software Freedom Law Center, which provides pro bono representation to free software projects.<sup>378</sup> Some twenty developers discussed the draft via email, suggesting revisions, and the draft was adopted six months later and posted on the Debian project site.<sup>379</sup> The Evergreen, Inkscape, and Mozilla communities all developed their trademark policies through public mailing lists.<sup>380</sup> Similarly, the Drupal Association solicited comments on its trademark policy through the comments section of its blog post discussing the policy's development.<sup>381</sup>

The Wikimedia Foundation has taken this approach one step further, first inviting the Wikimedia community to suggest changes

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<sup>377</sup> See Stefano Zacchiroli, *trademark policy draft* (July 30, 2012, 4:07:17 PM), <http://thread.gmane.org/gmane.linux.debian.devel.project/20471>.

<sup>378</sup> See Benjamin Mako Hill, *Open Brands* (Sept. 2, 2012), <http://mako.cc/copyrighteous/open-brands>.

<sup>379</sup> See Zacchiroli, *supra* note 377.

<sup>380</sup> See *Open source goes commercial?*, MOZILLAZINE. <http://forums.mozillazine.org/viewtopic.php?t=50907> (last modified Feb. 20, 2004); [*Inkscape-board*] *Fwd: Re:Trademark policy final decisions*, INKSCAPE, <http://sourceforge.net/p/inkscape/mailman/message/29737174/> (last modified Aug. 29, 2012); *Evergreen trademark policy*, <http://permalink.gmane.org/gmane.education.libraries.open-ils.general/7097> (last visited Oct. 26, 2014).

<sup>381</sup> See Dries Buytaert, *New draft of the Drupal Trademark Policy*, DRUPAL GROUPS (Feb. 12, 2009, 8:36 AM), <https://groups.drupal.org/node/19068>.

to its trademark policy and practice in a public consultation on a public wiki.<sup>382</sup> The Wikimedia Foundation's legal team then drafted a policy and posted it on another wiki page, where it was discussed and edited in real time.<sup>383</sup> Over seven months, some 150 community members participated in the discussion and contributed over 500 comments, resulting in hundreds of changes to the draft.<sup>384</sup> It should be noted that while this sounds like a lot of participation and indeed for the team running the consultation (us!) it felt like it, the participants in the consultation made up only about 0.2% of active Wikimedia contributors.<sup>385</sup> The final Wikimedia policy was approved by the Wikimedia Board of Trustees on February 1, 2014.<sup>386</sup>

The collaborative development process has three important implications. First, the trademark policy better reflects the values of the community. Even if the first draft of the Wikimedia policy was written by the Wikimedia Foundation, it was based on an extensive design-thinking analysis of the community members' interest in marks based on their current and potential uses as well as concerns communicated in the first stage of the process.<sup>387</sup>

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<sup>382</sup> See Geoff Brigham & Yana Welinder, *Trademark practices discussion*, WIKIMEDIA, [http://meta.wikimedia.org/wiki/Trademark\\_practices\\_discussion](http://meta.wikimedia.org/wiki/Trademark_practices_discussion) (last modified Sept. 27, 2013).

<sup>383</sup> See *Talk:Trademark policy*, WIKIMEDIA FOUNDATION, [http://meta.wikimedia.org/wiki/Talk:Trademark\\_policy](http://meta.wikimedia.org/wiki/Talk:Trademark_policy) (last updated Jan. 28, 2014). A wiki is a website that anyone can edit, but there are generally rules around editing. Some of these rules are explicit, such as the rules for editing a Wikipedia article. See *Terms of Use*, WIKIMEDIA FOUNDATION, [http://wikimediafoundation.org/wiki/Terms\\_of\\_Use](http://wikimediafoundation.org/wiki/Terms_of_Use) (last visited Oct. 26, 2014). Other rules are more implicit, such as the understanding that community members do not unilaterally edit a policy drafted with legal expertise. Instead, community members are more likely to discuss how they would like to edit the policy on the talk page. However, if there are objective errors to a draft (e.g. grammatical errors or typos), community members will simply edit the wiki directly.

<sup>384</sup> See *Talk: Trademark policy*, *supra* note 383.

<sup>385</sup> There are (as of Oct. 26, 2014) 22,920,516 Wikimedia contributors. See *Wikipedia: Wikipedians*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Wikipedia:Wikipedians#User\\_status](http://en.wikipedia.org/wiki/Wikipedia:Wikipedians#User_status) (last visited Oct. 26, 2014).

<sup>386</sup> See Yana Welinder & Geoff Brigham, *Launching an Unconventional Trademark Policy for Open Collaboration*, WIKIMEDIA (Feb. 12, 2014), <https://blog.wikimedia.org/2014/02/12/launching-an-unconventional-trademark-policy-for-open-collaboration/>.

<sup>387</sup> See Jonathan Morgan, Jessie Wild-Sneller, & Yana Welinder, *Human-Centered Design for Free Knowledge Presentation at Wikimania London* (Aug. 8, 2014), presentation available at [https://commons.wikimedia.org/w/index.php?title=File%3AWikimania2014\\_Human-centered\\_design\\_for\\_free\\_knowledge\\_slides\\_with\\_notes.pdf](https://commons.wikimedia.org/w/index.php?title=File%3AWikimania2014_Human-centered_design_for_free_knowledge_slides_with_notes.pdf);

Through an open discussion process, the Wikimedia community ensured that the trademark policy was more liberal than it would have been if it were drafted by lawyers alone. The final trademark policy eliminated “just in case” restrictions that lawyers may put in to a policy if they do not have to justify why they are restricting a trademark use.

Second, the consensus-driven process means that the participants are more likely to feel that the trademark practices are legitimate.<sup>388</sup> This probably extends to people who did not participate in the process, but may feel that other participants adequately represented their positions. Anecdotally, in the Wikimedia community, there has been a long history of controversy over trademark restrictions. But there have been no complaints about the trademark policy or practice after the current trademark policy was finalized, and community members who previously voiced concern about trademark practices are now participating in our trademark enforcement by helping Wikimedia prevent cybersquatting and reporting trademark violations. However, only time will tell whether the decentralized development process of policies actually lends legitimacy to them as more reliable data filters in over time.

Finally, the collaborative process may also result in a more robust policy. Having the entire community participate ensures that the policy anticipates more potential trademark issues. In essence, if the policy doesn’t cover important uses of our trademarks, it has bugs, and collaborative communities can resolve those bugs using the same peer review process that they use to produce other content.<sup>389</sup>

An extensive trademark policy generated through a decentralized process is likely not a solution for new projects that are still in the early process of developing their software or content and growing the project and do not yet have a steward to hold their trade-

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*see also* An Introduction to Design Thinking Process Guide, HASSO PLATTNER INSTITUTE OF DESIGN (2010), <https://dschool.stanford.edu/sandbox/groups/designresources/wiki/36873/attachments/8a846/ModeGuideBOOTCAMP2010.pdf?sessionID=cfc7ebe54af948d9257198907fd87c02bd93b014>.

<sup>388</sup> *See* Human-Centered Design for Free Knowledge Presentation, *supra* note 387.

<sup>389</sup> *See* Osman, *supra* note 152.

marks.<sup>390</sup> At that point, communities may still need to have some set of principles around how the project name and logo may be represented that are closely tied to advancing the project's mission and preventing activities that may be harmful to the community's work.

## 2. Streamlined Licensing

The process of trademark licensing required to avoid naked licensing under trademark law is inconsistent with collaborative communities for a number of reasons. Centralized control of trademarks is inconsistent with the decentralized nature of the communities' work. The back-and-forth interaction with lawyers and the legalese of the license agreements reminds community members of the intellectual property regimes that they morally oppose. And the process of obtaining a license slows down community members' work, which usually happens in a less-coordinated fashion in their spare time.

While collaborative communities must maintain trademark licenses for some uses of the marks, they can design the licensing process to avoid some of the problems. The new Wikimedia trademark policy introduced some solutions to avoid the burden of licensing. First, the policy introduced a visual overview to quickly communicate to community members whether a trademark policy was required and how they could obtain a policy.<sup>391</sup> Second, it introduced a trademark license application form that allowed applicants to submit all the relevant information in one form and avoid

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<sup>390</sup> Practitioners in this area have proposed sample trademark policies that communities could adopt at an early point of their development without spending time on developing their policy. Some examples of such policies are the Model Trademark Guidelines and Software Freedom's trademark policy. See *Model Trademark Guidelines*, [http://modeltrademarkguidelines.org/index.php?title=Home:\\_Model\\_Trademark\\_Guidelines](http://modeltrademarkguidelines.org/index.php?title=Home:_Model_Trademark_Guidelines) (last modified July 4, 2014); see also Richard Fontana et al., *A Legal Issues Primer for Open Source and Free Software Projects*, 1.5.2 SOFTWARE FREEDOM LAW CENTER, June 4, 2008, 1, 50–51, available at <http://www.softwarefreedom.org/resources/2008/foss-primer.html#x1-700005.6>. The Collaborative Mark Policy, included in the Article as an appendix, can be used in a similar manner. In adopting any of these policies, communities need to avoid blindly imposing excessive trademark restrictions before a project has actually developed brand recognition.

<sup>391</sup> See *Wikimedia Trademark policy*, *supra* note 369.

time-consuming back-and-forth communication.<sup>392</sup> Third, it introduced a new type of “Quick License” to streamline the permission process to allow community members to easily use the marks for purposes that promote the Wikimedia projects.<sup>393</sup> The Quick Licenses can be downloaded from the Wikimedia Foundation website and include only the most essential provisions, with a brief explanatory key of each provision.<sup>394</sup> They allow almost instantaneous use of the marks for special events such as collaboration with galleries, libraries, archives, and museums or photo contests after emailing a completed license to the Wikimedia Foundation.<sup>395</sup> However, in order to avoid losing protection over the marks, the Wikimedia Foundation monitors the submitted licenses and reserves the power to revoke permission if someone tries to use the marks inappropriately.<sup>396</sup> While none of these solutions completely eliminates the trademark restrictions that many community members fundamentally oppose, they do streamline the licensing process as much as possible in an effort to lessen the friction caused by trademark licensing.

### 3. Public Licensing Model

Members of collaborative communities have also spent a significant amount of time thinking about the possibility of an “open trademarks” or a “trademark Creative Commons (CC) license.”<sup>397</sup> CC licenses are public copyright licenses that have been described as a “legal jujitsu” move in copyright law to ensure that content derived from licensed material remains free and accessible by re-

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<sup>392</sup> See *Trademark/Request a license form*, WIKIMEDIA FOUNDATION, [http://meta.wikimedia.org/wiki/Trademark/Request\\_a\\_license\\_form](http://meta.wikimedia.org/wiki/Trademark/Request_a_license_form) (last modified July 17, 2014).

<sup>393</sup> See *Trademark policy/Quick License*, WIKIMEDIA FOUNDATION, [https://meta.wikimedia.org/wiki/Trademark\\_policy/Quick\\_License](https://meta.wikimedia.org/wiki/Trademark_policy/Quick_License) (last modified July 17, 2014).

<sup>394</sup> See, e.g., *Trademark/License/GLAM*, WIKIMEDIA FOUNDATION, [https://meta.wikimedia.org/wiki/Trademark\\_policy/Quick\\_License](https://meta.wikimedia.org/wiki/Trademark_policy/Quick_License) (last modified July 14, 2014). This form is for trademark use by any GLAM organization (gallery, library, archive, museum, botanical or zoological garden).

<sup>395</sup> See *id.*

<sup>396</sup> See *Wikimedia Trademark policy*, *supra* note 369.

<sup>397</sup> See Lionel Maurel, *Open Trademark: des Creative Commons du droit des marques auraient-ils un sens?* [*Open Trademark: Creative Commons trademark law would they make sense?*], S.I.LEX [FLINT] (June 13, 2013), <http://scinfolex.com/2013/06/13/open-trademark-des-creative-commons-du-droit-des-marques-auraient-ils-un-sens/>.

quiring that it be shared alike.<sup>398</sup> A creator can use a public copyright license, such as CC, GPL, BSD, or many others, to allow anyone to freely share, reuse, and build upon his or her work even though the work is still covered by copyright.<sup>399</sup> The freedom to use the work depends on the type of public copyright license that the creator selects. The collaborative communities that generate content, as opposed to code, rely on CC licenses or other similar licenses to collaboratively work on the content.<sup>400</sup> Given that project logos and wordmarks look like the content that the communities generate under the CC licenses, it is natural that community members have questioned why a CC license cannot be used to allow people to freely use trademarks. However, as discussed *supra* in Part I.B, a CC license cannot determine the use of a trademark because free use of a logo for different purposes waters down the association between the logo and the work that it represents, and does not include common trademark provisions like quality control conditions.<sup>401</sup> CC licenses can be used to license the copyright, but not the trademark, because a copyright in a work cannot be lost due to free use of the work in different contexts.

While the underlying idea of CC licenses does not work under trademark law, there are some aspects that stewards can adopt for trademark purposes. Public copyright licenses are designed to notify users with varying levels of understanding what rights the author of the work has selected to grant to the public.<sup>402</sup> Each CC license, for example, is composed of a full agreement spelling out all the legal details, a short pledge summarizing the agreement in a few sentences, and specific icons denoting the rights and limitations of the particular license, similar to the copyright symbol.<sup>403</sup> This de-

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<sup>398</sup> Jonathan Zittrain, *Normative Principles for Evaluating Free and Proprietary Software*, 71 U. CHI. L. REV. 265, 269 (2004).

<sup>399</sup> See Brian W. Carver, *Share and Share Alike: Understanding and Enforcing Open Source and Free Software Licenses*, 20 BERKELEY TECH. L.J., 447–48 (2005).

<sup>400</sup> See Miriam Bitton, *Modernizing Copyright Law*, 20 TEX. INTELL. PROP. L.J. 65, 84, 86 (2011).

<sup>401</sup> See *supra* Part I.B.2.

<sup>402</sup> See *About the Licenses*, CREATIVE COMMONS, <http://creativecommons.org/licenses/> (last visited Oct. 27, 2014).

<sup>403</sup> See, e.g., *Attribution License Legal Code*, CREATIVE COMMONS, <http://creativecommons.org/licenses/by/4.0/legalcode> (last visited Oct. 27, 2014); *Attribution License Deed*, CREATIVE COMMONS, <http://creativecommons.org/licenses/>

sign solves the “transparency paradox” that Helen Nissenbaum identified with respect to privacy policies, which is that a long privacy policy will not be read by users, whereas a short policy will omit pertinent details that make a difference between good and bad privacy practices.<sup>404</sup> By communicating information at different levels of abstraction, CC licenses include sufficient detail to cover most edge cases, while also being understandable at a glance.

A trademark policy can similarly be structured to quickly communicate to the public how a mark may be used, while also providing more details in a more extensive document. The Appendix to this Article includes a sample trademark policy of this sort that is modeled after the new Wikimedia trademark policy.<sup>405</sup> That policy—called the Collaborative Mark Policy or CollabMark—is designed to quickly communicate to users in plain English: (1) how they can use the marks without a license; (2) when they need to get a license or a quick license to use the mark; and (3) particular uses that are always prohibited.<sup>406</sup> It also has a visual overview that summarizes these three types of uses based on the three colors commonly associated with traffic lights, so users can quickly and intuitively understand when they may use the marks freely and when they need to ask permission.<sup>407</sup> It also uses the same color scheme in symbols to different portions of the policy to allow easy navigation, a feature that made some refer to the Wikimedia trademark policy as the closest thing to a “Creative Commons

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by/4.0/ (last visited Oct. 27, 2014); *About the Licenses*, *supra* note 402. Collectively, these portions make up the three referenced components of a Creative Commons license. The first link portrays all of the legal details of the Attribution License. The second link summarizes the Attribution License in a few, short sentences. The third link portrays the specific icons that denote the rights and limitations of the license. While these citations refer to the Attribution License, the website also includes links to various other types of licenses.

<sup>404</sup> See Helen Nissenbaum, *A Contextual Approach to Privacy Online*, 140 DAEDALUS 32, 36 (2011).

<sup>405</sup> See Welinder & LaPorte, *infra* app. A less detailed sample trademark policy for collaborative communities can be found in a legal primer issued by the Software Freedom Law Center. See *A Legal Issues Primer for Open Source and Free Software Projects*, *supra* note 390. However, that sample policy is not designed as a Creative Commons license.

<sup>406</sup> See COLLABMARK, <http://collabmark.org/> (last visited Feb. 6, 2015).

<sup>407</sup> See *id.*

trademark law.”<sup>408</sup> This design addresses the “transparency paradox” by providing an intuitive high-level overview, while also including detailed information about how the marks can be used.<sup>409</sup> It should also make it easier for people to use the marks freely without exposing the marks to naked licensing. Whether the policy indeed has this result remains to be seen, as it is still very new.

### III. ASSESSMENT OF TRADEMARK HACKS

The hacks described in Part II were devised to reconcile the conflict between the legal requirement for quality control and the values of decentralization and non-hierarchical structure of collaborative communities. Arguably, to reconcile the two, the hacks need to legitimize the reliance on the trademark system in the eyes of community members who will tend to be skeptical of trademark protection. This will require a trademark practice that allows liberal use of the marks. But the practice needs to be defensible in court so as to offer the desired trademark protection. This Part discusses how to assess the hacks in our taxonomy based on these two core considerations: (1) a hack’s viability under trademark law; and (2) its legitimacy in the eyes of the community.

#### A. *The Legal Validity of a Hack*

When assessed based on their viability under trademark law, the hacks in our taxonomy fall into three types. Some of the hacks are designed to ensure that marks representing the work of collaborative communities are recognized by trademark law. These hacks clearly play by the rules and are probably most viable under trademark law. Other hacks are also very much focused on trademark law, but rely on a creative legal analysis to avoid compromising on community values. A few of the hacks try to sidestep trademark law altogether in attempt to show commitment to the sharing ethos, decentralized decision-making, and the sense of joint ownership over the project marks that collaborative communities exhibit.

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<sup>408</sup> Lionel Maurel, *Mettre en partage une marque: la Wikimedia Foundation montre que c’est possible* [To Share a brand: the Wikimedia Foundation shows that it is possible], *S.I. LEX [FLINT]* (Feb. 13, 2014), <http://scinfolex.com/2014/02/13/mettre-en-partage-une-marque-la-wikimedia-foundation-montre-que-cest-possible/>.

<sup>409</sup> See Nissenbaum, *supra* note 404.



An example of a hack that unequivocally applies trademark law is the stewardship model, which is designed to allow the work of collaborative communities to enjoy protection under trademark law. To some extent, it has shown to be a viable model because trademark offices around the world have recognized trademark applications by stewards with respect to marks that represent collaborative communities.<sup>410</sup> It is foreseeable that someone may try to challenge a trademark registration held by a steward because the mark represents the work of many unrelated people around the world, rather than the steward. Such an action is unlikely to succeed if the steward not only holds the mark on behalf of the community, but also takes care of other vital functions, such as providing collaboration infrastructure, running servers, or providing the releases of the community's work. However, while the stewardship model presents a very viable hack with respect to trademark law, it does compromise more of community values than some of the other hacks by granting the steward centralized control over the mark. This compromise is inevitable under the current trademark law. But it can be alleviated by combining the hack with some of the other hacks, like a trademark policy developed through a decentralized process or collective membership marks that allow community members to use the mark to indicate their membership without getting a trademark license from the steward.

Examples of the type of hacks that rely on a creative legal analysis to avoid compromising on community values are the hacks that focus on establishing trademark restrictions that respect community uses. A creative analysis is necessary to identify overlap between a broad interpretation of fair use under U.S. trademark law and common uses of marks by community members.<sup>411</sup> An even more creative analysis of the policy rationale behind the control requirement in the naked licensing doctrine allows community members to be able to use the marks without a trademark license when they primarily display the marks to other community members.<sup>412</sup> These hacks rely on careful study of case law on trademark fair use and

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<sup>410</sup> See, e.g., LINUX, Registration No. 1916230.

<sup>411</sup> See generally 15 U.S.C. § 1115(b)(4) (2012).

<sup>412</sup> See Irene Calboli, *The Sunset of "Quality Control" in Modern Trademark Licensing*, 57 AM. U. L. REV. 341, 359 (2007).

naked licensing and formulated in a way that is likely to be upheld if challenged in court.

Finally, there are the hacks that completely sidestep trademark law. An example of this strategy is the establishment of unregistered mascots. Although a community, through a steward, could arguably rely on a common law trademark right in the mascot if it were abused, it would be costly to actively look for others trying to register the mark in first-to-file countries and difficult to establish priority in a mark that was purposefully not trademark protected.<sup>413</sup> We think of this hack as simply sidestepping trademark law to uncompromisingly sustain community values.

#### *B. Consistency with Community's Work*

The hacks described in the previous Part have been used by stewards of different collaborative communities at different times and sometimes in combination with other hacks. But not all the hacks may be appropriate for all collaborative communities. In this part, we have sought to identify a number of elements that may be important to consider when deciding whether or not to adopt any of the hacks.

*Type of project.* For example, it may be easier to define the membership of the community for the purpose of a collective membership mark for a software project than for a community where the collaboratively produced work is not as clearly identifiable. Trying to define the criteria for membership in the latter type of community may be inconsistent with the decentralized nature of that community that is intended to have more fluid membership.

*The development stage of the community.* A new community may want to start with lower protections and greater free use to establish its brand. Imposing the centralized control that is required under trademark law may be particularly damaging to the development of community that is in the early stage of recruiting new members and building a reputation.

*Size of the community and relationship between community members.* A small community may need fewer restrictions because they can control the use of the mark through social norms.

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<sup>413</sup> See generally 22 AM. JUR. 3D *Proof of Facts* § 7 (1993).

*Tolerance for risk.* A collaborative community that feeds into a product provided by a company can afford to take greater risks and deal with legal problems as they come up.

For illustration, we apply this assessment framework to the Wikimedia community. As previously discussed, the Wikimedia Foundation holds the trademarks for the Wikimedia community.<sup>414</sup> The Wikimedia community has a wide range of different types of projects. They include content projects, like Wikipedia; data projects, like Wikidata; and open source software projects, like MediaWiki.<sup>415</sup> Some of the trademark hacks discussed in Part II may be appropriate for MediaWiki, but not for Wikipedia. The Wikimedia community has existed for over a decade and is therefore in a later stage of its development. So while the community needed to be able to use the marks more loosely when it was still young to generate traction, it is now in a stage where certain restrictions will not undermine the community, if they are appropriately designed. The community is massive.<sup>416</sup> It does many different activities, both online and offline. Informal control of the community's trademark use is therefore not feasible given its size. Finally, the Wikimedia community has a little bit more tolerance for risk. It has a foundation with a legal team tasked with defending its trademarks.<sup>417</sup> However, its risk tolerance may not be as great as Google, for example, as the Wikimedia Foundation does not have nearly the same amount of resources.

## CONCLUSION

The work of collaborative communities—which powers much of the Internet and popular devices—challenges the traditional trademark law model. Trademark law imposes centralized control requirements that are inherently inconsistent with the decentralized structure of collaborative communities. This Article shows

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<sup>414</sup> See *Wikimedia Trademark policy*, *supra* note 369.

<sup>415</sup> See *Wikimedia Home*, WIKIMEDIA FOUNDATION, <http://wikimediafoundation.org/wiki/Home> (last modified Sept. 9, 2014).

<sup>416</sup> See *The Wikipedia Community*, WIKIMEDIA FOUNDATION, [http://meta.wikimedia.org/wiki/The\\_Wikipedia\\_Community#Who\\_is\\_the\\_community.3F](http://meta.wikimedia.org/wiki/The_Wikipedia_Community#Who_is_the_community.3F) (last modified Mar. 7, 2014).

<sup>417</sup> See *Wikimedia Trademark policy*, *supra* note 369.

that communities have over the years come up with different hacks to address this challenge. While mostly developed on an ad hoc basis, these hacks share similar features and can therefore be categorized into four main groups. The groups include hacks that focus on: (1) who holds the legal trademark on behalf of the community; (2) the type of trademark that the holder establishes; (3) what restrictions on trademark use the holder puts in place; and (4) how the trademark holder designs the restrictions.

However, the hacks presented in this Article may not completely resolve the risks and obligations posed by trademark law. Collaborative communities may continue to face unprotectable risks to their marks. If the role of trademarks is to protect consumers from confusion, then a collaborative community that risks its marks is jeopardizing its ability to protect the consumers that depend on its products.

Instead of the hacks outlined in this Article, another way to resolve the conflict between collaborative communities and trademark law is to reform trademark law itself to accommodate the non-traditional forms of quality control that are effective in the peer-produced commons-based production model. If open source and other collaborative communities continue to play a prominent role in the marketplace, then a new form of trademark law may be necessary to provide protection that fits the communities' needs. The law could create a new class of mark that accommodates a decentralized production model, or it could recognize that decentralized groups may share rights in the mark based on their contributions. An example of this already exists under Brazilian law.<sup>418</sup>

Collaborative communities may also wish to pursue technical, rather than legal, means to authenticate the origin of goods.<sup>419</sup> Open source software, for example, is routinely distributed with a hash that can be used to validate whether a package is identical to the official version released by the project.<sup>420</sup> Free culture communities may come up with similar technology to validate the

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<sup>418</sup> See *Licença Pública de Marca [Public License Brand]*, PORTAL DO SOFTWARE PÚBLICO BRASILEIRO [BRAZILIAN PUBLIC SOFTWARE PORTAL], <http://softwarepublico.gov.br/lpm> (last visited Oct. 27, 2014).

<sup>419</sup> See LESSIG, *supra* note 28, at 51.

<sup>420</sup> See Chestek, *supra* note 96, at 128.

source or origin of their goods, which could be developed as an alternative to trademark protection.

It should also be noted that the taxonomy offered in this Article does not classify solutions developed for other types of similar communities. For example, an emerging type of community based on application programming interfaces (APIs) for web services raise similar challenges, but in a very different context. Many web services today offer APIs, which allow third-party application developers to integrate a popular service within their application.<sup>421</sup> The relationships among application developers and the relationships between application developers and their API provider are not usually governed by a public license like open source or free culture communities.<sup>422</sup> But the network effects of a shared API service create a community of developers who share a common goal, usually aimed at promoting their API's network.<sup>423</sup> A community of API developers does not participate in peer production or share a common repository per se, but they may need to use the name and logo that identify the API that they use.<sup>424</sup> An application may wish to display the API's name to end-users, since interoperability with a popular service may be a significant feature. For example, many applications and websites wish to offer interactions with Twitter's services through their API.<sup>425</sup> These services may need to identify Twitter's services, and integrate it within their software, in a manner that is unique to their service. Twitter must balance its desire to build a strong and cohesive community around its API with the desire to preserve its trademark rights. Many of the issues faced by API communities may have similarities with collaborative communities. Finding a solution for trademarks with collaborative communities could prevent bigger problems in the future, as peer production takes on new or unexpected forms.

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<sup>421</sup> See *Web API*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Web\\_API](http://en.wikipedia.org/wiki/Web_API) (last modified Oct. 28, 2014).

<sup>422</sup> See *Application programming interface*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Application\\_programming\\_interface#Web\\_APIs](http://en.wikipedia.org/wiki/Application_programming_interface#Web_APIs) (last modified Oct. 28, 2014).

<sup>423</sup> See *id.*

<sup>424</sup> For example, the OpenStack community has developed a precise technical definition of when a software implementation is eligible to use the trademark. See *Governance/Core Definition*, OPENSTACK, <https://wiki.openstack.org/wiki/Governance/CoreDefinition> (last visited Feb. 6, 2015).

<sup>425</sup> See *id.*



## APPENDIX

## Collaborative Mark Policy (CoMP)

### May I use the [*Community*] marks?

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*This summary page is not a legal document.*

### YES please!

You have a fair use right to:

- Truthfully describe a Community project.
- Do accurate news reporting and artistic, literary, and political work.
- Use a wordmark when its meaning is unrelated to the Community projects.
- Link to Community projects.

This policy also allows you to use marks:

1. On the Community projects.
2. Outside the Community projects when you:
  - Organize a community-focused event.
  - Do outreach and recruit new editors.
  - Place marks on t-shirts, cakes, and other things without selling them.

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### YES, but first...

please sign a quick license for [*insert community specific events, contests, and groups that only need to sign quick license to use community's trademarks (e.g. hackathon)*].

**or**

### Get a regular trademark license

- for events and conferences,
- publications, movies, and TV shows,
- for things that you want to sell, and
- other uses.

## Sorry, NO.

Not for [linking to non-community project](#)  
or creating [mimicking](#) websites  
or to otherwise [mislead](#) others.

## Trademark policy



[Scope of policy](#)



[How to use the marks](#)



[Free use](#)



[Use with permission](#)



[Prohibited use](#)



[Report violations](#)



[Revisions  
Translations](#)

The Community marks represent *[insert community's mission or overarching project function]*. [Trademark protection](#) reinforces the connection between the Community marks and the projects that they represent. The protection serves to ensure that the marks are only used for activities that promote our mission.

*[Insert specific purposes of protecting community's trademarks. For example: "When readers see the [puzzle globe mark](#) in the top left corner of a website that looks like Wikipedia, they should be confident that they are looking at neutral, notable, and high quality content that is the result of the rigorous and transparent editing process on Wikipedia. Likewise, people should be able to rely on their impression of the trademark steward's involvement when they see the [Foundation mark](#) or one of the trademark steward's logos on websites or products."]*

The goodwill supporting the Community marks has been generated by a prolific and passionate volunteer community. The community has developed *[insert a description of the project (e.g. software)]*. To preserve the goodwill they have created, we have prepared this policy according to the community's direction. The resulting policy ensures that all uses of the marks are consistent with our mission and promote our movement.



Our mission relies on and encourages free speech. This trademark policy embraces [all free speech protections built into trademark law](#) to the broadest extent possible. The trademark policy also seeks to minimize the hurdles of trademark licensing. We are particularly liberal in approving uses by the community that are closely aligned with our mission.

To further make it easier for community members to use the marks, this policy introduces some creative trademark solutions. For example, it empowers community members to use the Community marks without a trademark license for community-focused events and outreach work. The policy further introduces a “quick license” for other common uses that community members can quickly fill out and email to us.

## 1. What does this policy apply to?

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### 1.1. The “Community marks”

This policy applies to all trademarks of the Community. The trademarks are both registered and unregistered trademarks, including [non-stylized wordmarks](#) and the [trade dress](#) of each Community project. In this policy, we refer to them as the “Community marks” or just “marks.” Here is a non-exclusive list of our trademarks: *[list wordmarks and logos]*.

### 1.2. “Use” of the Community marks

This policy applies whenever you want to use the Community marks. [Section 2](#) of this policy applies to all uses of the marks. Other sections apply only to uses that [do not require separate permission](#), uses that [require a trademark license](#), or uses [under agreements](#) held by *[insert groups/organizations recognized by the community, if any (e.g. user groups)]*. If some term in your trademark license is inconsistent with this policy, you should follow the license terms.

### 1.3. “We” or the “Trademark steward”

This policy regulates the use of marks held by the [organization or individual that holds the marks], who acts as a Trademark steward for the Community marks. Sometimes, this policy simply refers to the Trademark steward as “we.”

### 1.4. “You”

This policy applies to “you” if you want to use the Community marks and explains how you may use them. You may be a member of Community or an unrelated individual or organization.

#### 1.4.1. Community members

The community includes everyone who contributes to a community project in furtherance of our mission. It also includes members and staff of *[groups/organizations recognized by the community (e.g. user groups)]* and the Trademark steward.

The members of the community share a common mission. They are the core of the movement. Accordingly, community members are [free to use all Community marks on the Community projects](#) and for [community-focused events](#), as well as [outreach work](#) without a trademark license. Community members can also easily fill out a quick license for certain other community uses. And we generally give priority to community requests for uses that [require an ordinary trademark license](#).

#### 1.4.2. Chapters, user groups, and thematic organizations

*[Insert titles of groups/organizations recognized by the community (e.g. user groups)]* are called movement organizations. They are independent from the Trademark steward and support and promote the Community projects. These groups enter into agreements with the Trademark steward, which allow them to use certain

Community marks. Any use should primarily further the mission of the Community projects. To use the marks beyond the specified scope of its agreement, an organization can ask for a separate trademark license or simply comply with this policy when the use does not require a license. An organization can, of course, always select its own names, logos, and domain names. It does not have to use our marks.

### 1.4.3. Other organizations or individuals

Community projects are so well known that authors and script writers frequently want to portray them in books and movies. Similarly, other companies may want to reuse content from Community projects in web or mobile applications. In doing so, these individuals and companies may want to display our marks in movies, books, apps, or other media.

As long as users are not confused about the source of those works, this type of use can promote the Community projects and mission by expanding the reach of the Community projects and potentially recruiting new members to the Community. But it's important that the Community marks are not misleadingly used to market others' products because that will confuse Community users. We therefore have to be careful when licensing the marks for these purposes. For example, when licensing the marks to an organization that has its own logo, we need to make sure that it doesn't display any Community mark more prominently than its own logo or name. It's helpful to always have a proper separation between the organization's name and logo and any Community mark. Users should clearly see that the organization's products or services are provided by that other organization rather than the Community. And such use is never allowed without a trademark license.

## 1.5. "Mission"

The Community marks should only be used for activities that promote our *[insert link to community's mission statement]*, which is to *[insert a short description of the*

*mission*].

## 1.6. “Community projects”

The purpose of the marks and this policy is to protect the goodwill created by the community members through their work on collaboratively developed projects.

## 2. How to use the Community marks

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*[Include the following sentence with a link to the guidelines if the Trademark steward has separate visual identity guidelines: "Please follow our visual identity guidelines whenever you use the marks whether [with](#) or [without](#) a trademark license".]* Whenever you use the Community marks, note the following:

### 2.1. Proper form

- 2.1.1. You may use the wordmarks as a proper name (e.g. “Community is great”) or as an adjective (e.g. “the Community projects are awesome”). This includes any of the [official translations and transliterations](#) of the Community marks.
- 2.1.2. You may only use Community wordmarks in their full form and properly capitalized (e.g. “[*insert example of community wordmark*]”). You may not abbreviate them or combine them with other words (e.g. not “[*insert example of abbreviation like "Wiki"*]”). But you can use the marks in any form on the Community projects.
- 2.1.3. You may create [remixes](#) of the Community logos on the Community projects. But [outside the Community](#) projects, the logos should not be modified without separate permission from the Trademark steward. We need to make

sure that the logos remain distinctive from other marks.

## 2.2. Notice or trademark symbol

When reasonable, please include this notice when you use a mark outside of the Community projects:

*“[Wordmark / name of logo as listed [insert link to list of community’s trademarks] is a trademark of the [Trademark steward] and is used with the permission of the [Trademark steward]. We are not endorsed by or affiliated with the [Trademark steward].”*

The notice should appear near the first use of a Community mark. One notice is enough if you display multiple marks, provided the notice refers to all of them.

If the mark will primarily appear on a mobile screen or another medium with limited visual space, you may instead use a trademark symbol (™) with the mark to show that it is a Community trademark. *[If relevant: “For size and location of the trademark symbol, please see the [Visual Identity Guidelines](#).”]* When you use a symbol due to limited space and there are additional pages to your material, please include the notice in the text of a prominent page (e.g. most mobile apps have an “about us” section and may display terms during installation).

Regardless of whether you use a notice or a trademark symbol to identify your use of Community marks, make sure that your use does not suggest endorsement by or affiliation with the Trademark steward.

## 3. When you may use the Community marks without asking us

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- 3.1. Use of trademarks on Community projects**  
You may use and [remix](#) the Community marks on the Community projects as you please.
- 3.2. Community-focused events**  
You may use the trademarks for events that promote our mission and are intended to be predominantly attended by Community community members. These are events like *[insert relevant events attended predominantly by community members]*.
- For example, you can put the *[insert name of community's logo]* on banners and posters at an *[relevant event attended predominantly by community members]* you've organized.
- [Insert important trademark uses that promote the Community projects but are not predominantly visible only to community members]* require a quick license under Section 4.1. This provision also does not allow you to use the marks for fundraising.
- 3.3. Outreach and recruiting new editors**  
You may use the marks consistent with our mission to educate people about the Community projects and to recruit new volunteers, as long as you make it clear that you do not work for the Trademark steward. You can create educational material or banners to decorate a public fair stand or to publicize an *[relevant event]*. But, please don't sell any of them.  
This provision does not allow you to use the marks for fundraising.
- 3.4. Discussing something other than Community projects (fair use)**  
Wordmarks can sometimes have a primary meaning, in addition to representing a brand (like the words "[apple](#)" or "[facebook](#)"). Our wordmarks were not real words before our projects were created. But we will interpret fair

use broadly to include the use of our wordmarks when you really mean to talk about something other than the Community projects.

### 3.5. Refer to Community projects (nominative use)

You can use the non-stylized wordmarks (e.g. ["*Wikipedia*"]) to describe:

- A Community project or another aspect of the movement in a text (e.g. [*"I love reading about new things on Wikipedia"*]).
- Derivative work of a Community project in a way that is not misleading (e.g. [*"the encyclopedic content on this site is derived from Wikipedia"*]).

Here are some specific cases of nominative use:

#### 3.5.1. News reporting

You may use the Community marks to make truthful statements about the Community projects in news reports and commentary.

#### 3.5.2. Personal blogs and social media

You can use the Community marks to make truthful statements about the Community projects in personal blogs and social media. But please don't do it to imply endorsement by or affiliation to the Trademark steward. To avoid confusion, don't use the Community logos in the background, as your profile image, or in the header of your blog. You should also not use the marks in the name of your blog or in your social media username.

#### 3.5.3. Artistic, scientific, literary, political, and other non-commercial uses

You can use the Community marks to discuss the Community projects in artistic, scientific, literary, and political work.

But please send us a request if you want to place a Community mark on the cover of your book, display a Community mark in a movie, or organize an event or presentation that could be interpreted to be endorsed by the Trademark steward. For more information, please see the portion of this policy on “special uses that require permission” ([Section 4](#)).

You may also use the marks in satire or jokes. To avoid confusing users that your work is affiliated with the Community projects, it may be helpful to mark your work as “satire” or “parody.”

### 3.5.4. Links to Community projects

You may use the marks on your own website as a hyperlink to the Community projects. *[If relevant: “The use of logos in hyperlinks should follow the [Visual Identity Guidelines](#). For example, the marks may be resized, but not modified in any other way.”]*

## 3.6. Make your own branded stuff

You may create things with the marks for your own use. These can be [t-shirts](#), caps, desktop wallpapers, and even [cakes](#)! But please don’t sell them. *[If relevant: “Make sure that your design follows the [Visual Identity Guidelines](#).”]* If you want to sell your branded stuff, you can request a license under [Section 4.6](#).

## 4. Special uses that require permission

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All uses that are not allowed under [Section 3 of this policy](#) require a trademark license. This section discusses only the most common uses that require a license.

When you use our marks under a trademark license, you need to comply with its terms as well as with this trademark policy. If some term in your license is inconsistent with this policy, you should follow the license terms. Movement organizations will only need a sepa-



rate license when the use is not already authorized by their organizational agreements with the Trademark steward or this policy.

#### 4.1. Quick license for special community uses

A quick license is a quick trademark license for common community uses, like *[insert trademark uses that only require a quick license like "hackathons"]*. You can start using the marks as stated in the quick license as soon as you email a filled-in quick license to the Trademark steward at *[email address]*. There is no need to wait for any approval.

##### 4.1.1. Hackathons

This provision applies to hackathons where people meet to work on Community projects together. You need permission to advertise such an event with a Community mark. But don't worry, we love hackathons! You can get a quick license for flyers, posters, slide presentations, websites, and social media for a hackathon.

#### 4.2. Domain names

You need permission to register or use a domain name that contains a Community mark in it. Please don't register a domain that looks or sounds similar to a Community mark or includes a misspelled Community mark as that can confuse Community users.

#### 4.3. Events and conferences

You need a trademark license if you plan to host a public event or a conference that uses a Community mark.

*[You should include the following information when requesting a license to use our marks in an event.]*

1. What is the proposed title of the event?
2. Who is hosting, sponsoring, or coordinating the event?
3. Include contact information (and Community username if rele-

vant) for the person organizing the event.

4. Is the event organized for community members?
5. What is the topic of the event?
6. The location, date, and duration of the event.
7. Include handouts, examples, mockups, or other descriptions of the proposed use.

When you get a trademark license, it will only apply to the specific event in your request. You will need to apply for a new license if you want to host another event.

#### 4.4. Publications

You need a trademark license if you want to use a Community mark in a publication in a way that is not [fair](#) or [nominative use](#) under U.S. trademark law or other applicable foreign laws.

*[You should include the following information when requesting a license to use our marks in a publication.]*

1. What is the proposed title of the publication?
2. Contact information (and Community username if relevant) for the applicant.
3. Who is the author, editor, and publisher of the publication?
4. For fiction, what is the storyline?
5. How do you want to use and discuss the mark?
6. Include printouts of the pages in your publication that includes or discusses the mark. (For a book, where in the book will the mark appear?)
7. If your publication will display a screenshot of a Community project, please include that as well.
8. Will the publication be in hard copy, an e-book, or some other type of medium?
9. What is the print run and distribution area for the publication? How many editions will it have?

When you get a trademark license, it will only apply to the specific publication in your request. You will need to apply for a new li-

cense if you want to make another publication.

## 4.5. Movies and TV shows

You need a trademark license if you want to use the Community's logo in a movie, TV show episode, or on-line production.

*[You should include the following information when requesting a license to use our marks in a movie or TV show.]*

1. What is the proposed title of the movie or TV show?
2. Contact information (and Community username if relevant) for the applicant.
3. The names of the screenwriter, director, producer, distributor, actors, and any interviewees (for documentaries).
4. How will the Community mark be displayed or discussed? Include a printout of any Community project that you want to show.
5. Include a script and any footage that has already been created. Unless discussed in the script, specify the location of the film and whether it will advertise a product in conjunction with using the Community marks.
6. Where, when, and how will the movie be distributed?
7. How will it be advertised? Do you intend to display the Community marks on the advertisement?

When you get a trademark license, it will only apply to the specific film, TV show episode, or online production in your request. You will need to apply for a new license if you want to shoot another film or TV show episode.

## 4.6. Commercial merchandise

You may also make merchandise with the Community marks for commercial use, if:

**4.6.1.** You get a [trademark license](#) from the Trademark steward;

**4.6.2.** You follow our Visual Identity Guidelines; and

- 4.6.3.** You truthfully advertise to customers how much of the selling price, if any, will be donated to Community projects.

## 5. Prohibited uses

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### 5.1. **Misleading mirrors and mimicking sites**

Please don't create a website that mimics the 'look and feel' of a Community project. If you have a good reason to create a mimicking site, please contact the Trademark steward at [*email address*].

You don't need to contact us if your mimicking site is clearly a [parody](#).

If you create a mirror, make sure to comply with the relevant licenses for the content. Avoid copying links to legal policies and contact details that are unique for the Community projects. Please don't use the Community marks in a mirror of a Community site.

### 5.2. **Linking to non-Trademark steward sites**

You may use Community marks to link to Community projects only. Please refer to Section 3.5.4 if you want to link to a Community project from your website.

### 5.3. **Misrepresentation**

When you use a Community mark, do not create the impression that your use is in any way endorsed, or sponsored by, or part of the Trademark steward. This section also applies when you are granted a license to use a mark that doesn't permit you to suggest such an endorsement.

## 6. Trademark Abuse

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## 6.1. Reporting abuse

Fighting trademark abuse is very important. We put a [lot of effort](#) into going after cases of trademark infringement because we want to protect the valuable trademark rights the community has created. If you see a mark being used in any way that could be infringing, please tell us! Just send an email to the Trademark steward at [email address]. We really appreciate your help!

## 6.2. Revoking permission for abusive uses

We may revoke the right to use the Community marks under this policy at any time by providing notice in any manner if we determine that a trademark use is inconsistent with our mission or could harm community members, movement organizations, or the Trademark steward.

# 7. Revision and Translation of the trademark policy

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## 7.1 This trademark policy can be revised as follows:

- 7.1.1. We will give notice of proposed revisions on the Community projects and in an email to [relevant community mailing list]. The community can then comment for at least 30 days.
- 7.1.2. For minor changes or changes required by law, when possible we will provide three days' notice to [relevant community mailing list]. Minor changes include language fixes, administrative changes, or corrections of inaccurate statements.

This section does not apply to the user-friendly summary, the FAQs, the purpose statement for the trademark policy, the trademark request form, and the violation reporting form. They are not part of this trademark policy and can always be revised without notice.

## 7.2 ***[If relevant: Translation of the trademark policy]***

*If some term in a translation of this trademark policy is inconsistent with the original English version of this policy, you should follow the original English version.]*

## 7.3 **Questions**

Please don't hesitate to contact us at [email address] if you are not sure whether your use is in compliance with this policy or local trademark laws.

### **License notes**

The *Collaborative Mark Policy* is a derivative of the *Wikimedia Trademark Policy*, by Wikimedia contributors, under the Creative Commons Attribution ShareAlike 3.0 (unported) license (CC BY-SA 3.0).

The *Wikimedia Trademark Policy* is available at [https://wikimediafoundation.org/wiki/Trademark\\_policy](https://wikimediafoundation.org/wiki/Trademark_policy).

The *Sample Trademark Policy for Collaborative Communities* is licensed under the CC BY-SA 3.0 license.

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