Why Licenses Requiring the Use of Trademarks are Non-Free

FOSDEM '14

February 3, 2014

Pamela Chestek
Chestek Legal
Raleigh, North Carolina, USA

Argument

A license that requires the use of a trademark for modified software impairs the right to the modify the functionality and therefore is non-free

(From a branding perspective it's a stupid idea, but I'm not here to talk about that)

Approved licenses

Zimbra Public License, version 1.4

"3.2 - In any copy of the Software or in any Modification you create, **You must retain and reproduce any and all** copyright, patent, **trademark**, and attribution **notices** that are included in the Software in the same form as they appear in the Software. **This includes** the preservation of attribution notices in the form of **trademarks or logos** that exist within a user interface of the Software."

version 1.3 listed by FSF as Free Software license

Approved licenses

Common Public Attribution License 1.0

[T]he Original Developer may include in Exhibit B ("Attribution Information") *a requirement* that each time an Executable and Source Code or a Larger Work is launched or initially run (which includes initiating a session), *a prominent display of the Original Developer's Attribution Information (as defined below) must occur* on the graphic user interface ....

EXHIBIT B. Attribution Information ....
Graphic Image as provided in the Covered Code, if any...."

OSI approved; listed by FSF as Free Software license

And still being requested

Beanbooks Public License

"4.2 - In any copy of the Software or in any Modification you create, **You must retain and reproduce, any and all** copyright, patent, **trademark**, and attribution **notices** that are included in the Software in the same form as they appear in the Software. This includes the preservation of attribution notices in the form of **trademarks or logos** that exist within a user interface of the Software."

License recently submitted to OSI for approval

The FSF's accommodation

<u>GPLv3</u>

7. Additional Terms....

[Y]ou may... supplement the terms of this License with terms:...

b) Requiring preservation of specified reasonable **legal notices or author attributions** in that material or in the **Appropriate Legal Notices** displayed by works containing it...."

"'Appropriate Legal Notices' ... (1) displays an appropriate copyright notice, and (2) tells the user that there is no warranty for the work ..., that licensees may convey the work under this License, and how to view a copy of this License."

What it's come to

NopCommerce is GPLv3 with these "additional terms":

"... (2) **all derivative works and copies of derivative works of the Covered Code in Executable and Source Code form must include** on each user interface screen (i) **the 'powered by nopCommerce' text**. In addition, the 'powered by nopCommerce' text, as appropriate, must be visible to all users, must appear in each user interface screen, and must be in the same position.

nopCommerce copyright removal key

Would you like to remove the "Powered by nopCommerce" link in the bottom of the footer?

According to the terms of the nopCommerce license, you may NOT remove or hide the "Powered by nopCommerce" statement that appears at the bottom of each page within nopCommerce shopping cart.

If you have not purchased a valid "Copyright notice removal license" for nopCommerce, the copyright notice at the footer of your store must remain intact, unedited and clearly visible. Please don't attempt to edit, remove or hide the copyright notice in any way. It does not give you authorization to remove any copyright notices in the script source files nor any other rights. Copyright infringement is illegal - please be advised!

Upon purchase of a "copyright notice removal key" you are permitted to remove the aforementioned proprietary notices. A single key must be used for each store (URL) and may not be used more than once. You may not use a key to remove copyright on unlimited store installs on one website domain.

How did we get here?

False premise that a trademark is an attribution:

"I recall that RMS was convinced that an 'indicator-of-origin logo' was logically equivalent to an author attribution." Richard Fontana, http://lists.debian.org/debian-legal/2011/12/msg00049.html

"The FSF in any case was convinced that a 'powered by' corporate logo could itself be a reasonable author attribution." Richard Fontana, http://lists.debian.org/debian-legal/2011/12/msg00045.html

Attribution ≠ Trademark

"Attribution"

- "Attribution right. A person's right to be credited as a work's author, to have one's name appear in connection with a work, or to forbid the use of one's name in connection with a work that the person did not create." Black's Law Dictionary (9th ed. 2009).

Trademark functions

- A trademark has three functions:

  - as an ***indication of origin**** or ownership

  - as a ***guarantee*** of constancy of the quality or other characteristics of a product or service, and

  - as a medium of ***advertisement***

*In the US, "origin" = manufacture, not authorship
Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003).

Trademark functions

- A trademark has three (or five) functions:
  - as an *indication of origin* or ownership
  - as a *guarantee* of constancy of the quality or other characteristics of a product or service, and
  - as a medium of *advertisement*
  - *communication*
  - *investment*

Trademark functions

"Thus, a trademark guarantees, identifies, and sells the product or service to which it refers."

None of these are related to the interests that attribution protects

What restrictions are ok in a FOSS license?

- Attribution

- Disclaimer of warranty

- Requirement to convey a copy of the license

- License derivative works under the same terms

What restrictions are ok in a FOSS license?

- These are to avoid requiring an illegal act (attribution), allowing the author to avoid liability (warranty), or to protect the license scheme itself

- None of these limit in what ways the code itself may be modified*

  *GPLv3 allows for a requirement that "Legal Notices" must be displayed

So what?

A trademark is not (by any stretch) a "Legal Notice"

A "Legal Notice" would be "Registered in U.S. Patent and Trademark Office" (15 U.S.C. § 1111)

So what?

It is not unlawful to take off a trademark, so it cannot be justified as protecting anyone from legal claims

So what?

But, by requiring that a trademark be retained for modified software, you are forcing a person to choose between two unlawful states:

- subvert the guarantee function of trademark law (because the code is now different);* or

- breach the license

*Although the trademark owner could, of course, never pursue you for the claim

To avoid both of these evils, one would have to **limit the degree to which one modifies the software** so that software displaying the trademark still meets consumer expectations for the trademarked goods.

This is not free

Final thoughts

We need to fix the problem
that they are trying solve

-Matija Šuklje