



INSTITUT FÜR RECHTSFRAGEN DER FREIEN UND OPEN SOURCE SOFTWARE

Berlin, March 25, 2022

Q & A about Forks and Trademarks

Please note that the following Q & A for the Next Generation Internet projects (<https://www.ngi.eu/>) are based on German law and European trademark and copyright law. The legal situation in other countries might be different. For general information about Free an Open Source Software and Trademarks see the FOSSmarks guide.¹

1. What is to consider if you want to fork a software project which is under a FOSS license?

In principle, any open source project may be forked, since all open source licenses allow the reproduction, distribution, modification and making available to the public of the software under copyright law. If the applicable open source license does not contain any special requirements for such a fork, no "credit" must be given or special reference made to the original project (as it is the case for most popular FOSS licenses). It is only a question of good style that the subsequent users are made transparent which project was forked.

However, all license obligations of the applicable open source license must be complied with. Since the forked software is mostly made publicly available and further developed in another repository, the obligations for a distribution of the modified software in source code must be complied with.

Some licenses (such as the MPL-2.0, Apache-2.0, GPL-2.0, GPL-3.0, AGPL-3.0, LGPL-3.0, and LGPL-2.1) require that modified source code files contain a modification notice. This ensures that no programming by subsequent developers is attributed to the original author. A typical example is sec. 4 b) Apache-2.0:

¹ <https://fossmarks.org/>.

"You must cause any modified files to carry prominent notices stating that You changed the files."

Nowadays, these modification notes are often no longer made in the source code itself, but are recorded by the "history" of the version control system (e.g. Git) and made traceable for third parties. If a program is now forked, the history should be included, because otherwise the corresponding change notes are missing. In addition, some open source licenses prohibit the removal of copyright and license notices.

Special requirements apply if the name of a software program is protected by trademark law. Trademarks serve to inform the market about the origin of a product or service (function of origin, see recital 11 of Regulation (EU) 2017/1001 on the European Union trade mark).² Accordingly, the person who forks a program may not use the name of the program, which is protected by trademark law, and must rename it. Since there are both word marks and figurative marks, this can also affect logos.

The same may apply if the name of a program is not protected by a registered trademark, but only as a title. Hence, a fork should be renamed as a default.

For further details of the right to use the trademark or a name by third parties, see 5. below.

If the forked project wants to use a trademark policy for their own trademark, the "Guidelines for Trademark Policy" from FSFE should be considered³.

2. What about copyright notices when forking a program? What is the relationship to trademark protection?

Copyright notices serve to inform about the owner of the copyright. Although they are not necessary for copyright protection, they serve as evidence of who is to be regarded as the author or copyright owner. Accordingly, Section 13 of the German Copyright Act provides as follows:

"The author has the right to be acknowledged as the author of the work. He can determine whether the work is to be provided with an author's designation and which designation is to be used."

² <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=DE>.

³ <https://download.fsfe.org/NGI0/V2/FSFE%20-%206%20-%20Trademark%20Policy%20Guidelines.pdf>.

This regulation pertains to the moral rights of the author and does not protect companies that are only holders of the exclusive exploitation rights. Nevertheless, author's notices and copyright notices should never be altered or deleted without the consent of the designated author or copyright owner.

If a source code file has been modified, this is usually traceable in the history. If this is not the case, or if there is a wish to make it obvious in the source code that it has been modified, this may be indicated by an appropriate notice (e.g. "modified by [name of developer who modified the code]").

Copyright notices are independent of trademark protection. Even if the name of the copyright owner and the trademark are identical, the copyright notice must be retained, as described above. The trademark owner cannot prohibit the copyright notices in source code headers based on trademark law; however, a copyright notice does not give any right to use the designation other than in the form intended by the copyright owner.

3. What is to consider for contributors, distributors and users if they use a renamed software of a fork?

The protection of a registered trademark is limited to the use of the protected logo or name respectively. If a fork has been renamed, the trademark of the original project is irrelevant for contributors, distributors, and users of the forked software if they do not use the trademark of the original project.

4. What to do if the copyright owner seeks (and subsequently acquires) a trademark after the fork has already been made public?

The fact that a trademark has been applied for does not affect the possibility that a trademarked term can at the same time be the name of a software, i.e. its title. The Higher Regional Court of Düsseldorf ruled that the name of an open source software may be used insofar as the use does not indicate the origin of the company, but only represents information about the type and quality of a product.⁴ However, it must be the same software. If a fork is further developed and differs from the original software, it may no longer be referred to as such. However, references such as "based on" with the denomination of the original software may still be permitted by Art. 14 para 1 (b) Regulation (EU) 2017/1001. This is ultimately a question of the concrete constellation. For more details see 5. below.

⁴ See <http://germanitlaw.com/wp-content/uploads/2012/05/OLG-Duesseldorf-Urteil.pdf>.

5. If someone owns a EU trademark: under which conditions I'm permitted to use the trademarked words or logo?

The owner of a trademark cannot prohibit all use of the protected name or logo. The protection is limited to the “use in the course of trade, in relation to goods or services”, i.e. to distinguish such goods or services of one trademark owner from other goods and services. Just using a trademark outside the course of business (e.g. in a dictionary) is permitted. Furthermore, Articles 14 and 15 Regulation (EU) 2017/1001 provide for the following limitations of the protection of trademarks (even in the course of trade) where the use made by the third party using the trademark is in accordance with honest practices in industrial or commercial matters:

- Use the trademark for the purpose of identifying or referring to goods or services as those of the owner of that trademark, in particular, where the use of that trademark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts. An example would be to inform users that a specific software is intended to interact with another program or is based on a prior development. Naming for this purpose is permitted in most cases.
- Use of the name or address of the third party, where that third party is a natural person (although the name is identical with the trademark).
- Use of signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or service.
- An EU trademark shall not entitle the owner to prohibit its use in relation to goods which have been put on the market in the European Economic Area under that trademark by the owner or with his/her consent. The typical application case is the redistribution of data carriers with software that the trademark owner has distributed (so called “principle of exhaustion”). Of course, the buyer of a product is permitted to resell it without consent of the trademark owner. Under certain conditions, this also applies to software downloads (see *UsedSoft GmbH v Oracle International Corp.*, ECLI:EU:C:2012:407).

In most of the cases described above, only the word mark may be used because it is sufficient to describe a third-party product. Logos, on the other hand, may not usually be used without a trademark license (exception: principle of exhaustion).

6. I've received a "cease and desist" notice that I'm infringing a trademark with my fork of a FOSS project – what should I do?

There is no “one size fits all” recommendation. Trademark litigation can be costly, and trademark infringement can sometimes be enforced by way of preliminary injunction proceedings. Therefore, in serious cases involving lawyers legal advice should be sought within the deadline set as to whether the warning is justified and what reaction is appropriate.

If a warning letter is obviously incorrect, e.g. because the mark of the trademark owner is not used at all in the fork, there can be no trademark infringement that can be prohibited. Under German law, the person issuing the warning letter must in such cases reimburse the costs of defense by a lawyer (in the amount of the statutory fees).

7. What is the scope of protection of a EU trademark or a trademark of one country respectively?

The protection of a trademark is limited to the use (e.g. selling products, offering services, importing products) in the country or countries for which trademark protection exists. The EU trademark provides protection for all EU member states.⁵

If a product or service is offered on the Internet, trademark protection may be sought in all countries to which the offering on the Internet is intended.

8. Are there legal claims that could be made against people making a fork, e.g. damages for false allegations regarding termination of the project, statements that tarnish the reputation of the original project or its creators, etc.?

Disparaging claims or false facts that can negatively affect the reputation of software may be legally inadmissible. This is a question of the individual case and here, in particular, claims under competition law come into consideration. Directive 2006/114/EC concerning misleading and comparative advertising contains a list of misleading advertising that member states shall combat by “adequate and effective means”.⁶

The responsibility for false allegations only applies to the persons who make such allegations or spread allegations made by third parties. Contributors and users of the software who do not make false claims are not affected by claims against them.

⁵ For the situation with regard to the UK after the Brexit see https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/Brexit/Brexit_Q_and_A_en.pdf.

⁶ <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32006L0114>.