

Subject: Re: Our situation

From: Mary Starr <mstarr@nagios.com>

Date: Fri, 20 Mar 2009 15:33:21 -0500

To: Julian Hein <jhein@netways.de>

CC: Ethan Galstad <egalstad@nagios.com>, Olsen Michael <MOlsen@winthrop.com>, Karolina Kalisz <karolina.kalisz@netways.de>

Hello Julian,

We are wondering if you have any intention of responding to these trademark violation issues. The longer it takes you to respond to our email, the less we trust your intentions.

Please advise if you intend to comply with our requests.

Mary Starr
Vice President

Nagios Enterprises, LLC
Office: (888)NAGIOS-1 x702
Fax: (651)204-9103
Email: mstarr@nagios.com
Web: www.nagios.com

Julian Hein wrote:

Hello Ethan,

thank you for your eMail. I also appreciate, that we are trying to resolve this. I just returned from my vacation, so I had no time to take any measures or even think about your mail. So please allow a few days until I can get back to you with a reply.

Regards,
Julian

Ethan Galstad <egalstad@nagios.com> wrote on 06.01.09 21:25:

Julian -

Thank you for your email. We appreciate your effort to resolve these issues.

It comes as a surprise to us that you believe we would not have a problem with the way NETWAYS is using the Nagios trademark. I immediately notified you there was a problem with the "Nagios Conference" name when you first proposed it in January of 2006. You then proceeded to file for a Nagios trademark in Germany before responding to my emails. From our perspective, this indicates that you intentionally and knowingly violated the Nagios trademark.

I allowed you to use the conference domain and name the first year because it had already been announced to the community. I obviously should not have allowed that to happen. Despite our agreement, the domain name was never transferred after the first conference. I believe the conference name and domain name were addressed the second year because they still had not been "fixed".

I didn't react initially when you told me about "NagiosWiki" and "NagiosForge" in Stockholm in June because I was already angry about the conference name still being unchanged. Besides, what was the point of me saying something at that point when NETWAYS had already launched the sites without asking for permission beforehand? It was already done. We had been dealing with a lot last year, so I added those issues to things that needed to be addressed when we met with you in Germany in September.

Our trademark policy clearly states that the Nagios trademark cannot be used for any commercial intent without obtaining prior written permission from us. This includes "community" sites that are run by companies and would prevent sites like "NagiosWiki", "NagiosForge", etc. from operating without our explicit permission. The policy also contains contact information if people have questions regarding the trademark and its usage. We were never contacted by NETWAYS requesting permission to use or license the marks in these ways.

We have been accommodating and trusting with regards to these trademark issues, but this has proven to be a bad business choice on our part. We have expended significant resources to investigate and defend this and other Nagios trademark violations. As a result of our findings, we require NETWAYS to take the following actions immediately:

1. Transfer the ownership of the German "Nagios" trademark that you filed in 2006 to Nagios Enterprises
2. Transfer all domain names that NETWAYS owns or controls that contain "Nagios" (or variations thereof) to Nagios Enterprises. This includes nagiosexchange, nagiosforge, nagioswiki, etc. To date, we have identified more than 50 domains owned by NETWAYS that meet this criteria.
3. Immediately update the Nagios Exchange/Wiki/Forge websites to state that "Nagios and the Nagios logo are registered trademarks of Nagios Enterprises". Remove any claims that NETWAYS owns trademarks that constitute "combined marks". For instance, the NagiosForge site states that "NagiosWiki and the NagiosWiki Logo are trademarks of NETWAYS GmbH."

Upon compliance with these demands, we will consider:

1. Allowing NETWAYS to continue to operate the Exchange/Wiki/Forge websites with a written contract
2. The possibility of a continued business partnership with NETWAYS

We look forward to resolving these issues quickly.

Regards,

Ethan Galstad
President

Nagios Enterprises, LLC
Web: www.nagios.com
Office: (888) 624-4671 x701
Mobile: (651) 278-1477

Julian Hein wrote:

Hello Mary and Ethan,

please let me first say, that this is not very easy for me. I have to write this email in a foreign language and I am not sure if I will always manage to find the exact right words for what I want to say.

I have the feeling, that both of you are very angry with us: I saw all the news related to Netways or to the German conference disappear on nagios.org and I read the last mail you sent to Bernd, when he tried to initiate a phone conference.

For some time I thought that things might cool down after some time or we would find a mutual way to handle the situation. But we haven't really talked in the last weeks and I do not want to get the situation much worse, so I would like to make a first move into settling the situation.

At the conference you said, that you had the feeling that we were going behind your backs and I did not understand that at this time, but I was doing a lot of thinking in the last weeks and I tried to put myself into your situation. Especially if I try to imagine, that you think that we did all what happened on purpose or as part of a plan, I than can understand that you feel quite miffed.

Still I think or hope, that we can sort it out and therefore I would like to explain our views or our reasons to some specific issues I guess you are angry with:

First of all, I realized much later than you think, that the trademark is really such an important issue for you. The first time I remember you brought it up, was when we talked about the first Conference. We registered the nagiosconference.org domain, than you told us, that the name is not OK, than we both agreed on "NETWAYS Nagios Conference" and changed the domain name. From that time I knew or I thought that it is mainly a problem with commercial offerings or products and service names. We kept the conference name the same - we agreed on that before - and the issue did not come up until the 3rd conference this year. Just before the conference you told us, that we would need to change the Name again. We agreed on a new Name and to keep the old one just for the 2008 conference, because we already had printed material. Next years conference will be called "NETWAYS Conference on Nagios", so we complied here fully. And it is no problem for us.

Second NagiosExchange. I did not know that you have a problem with the Name the first time this year in Nuremberg at the conference: When we launched it, we did not know each other. One day, the logo just appeared on the nagios.org website. Some time later Ton approached us and after implementing a mirror at Altinity, he declared NagiosExchange to be the official Plugin Repository: http://sourceforge.net/forum/forum.php?forum_id=509712

When you later talked about the trademark you said things like "community services can use the trademark", or "it is ok, as long as it is nothing commercial". We also always posted, that Nagios is a registered trademark of you. It is written on NagiosExchange since the start or on our website since ages.

So when we launched NagiosForge and NagiosWiki, we did not have the slightest idea, that you would have a problem with it. When we told you about it in Stockholm - as far as I can remember - you did not mention any concerns you might have had. Thinking about it now, I am sure you had concerns on that day, but we did not know about them. In Stockholm you just expressed your concerns with the conference name and we talked about them. The solution was, keeping the name just for this year and change it in 2009.

So the first time we heard about trademark problems with NagiosExchange was in September in Nuremberg. Please understand, that we were pretty surprised and did not offer to immediately signing everything over to you. We were just pretty shocked and needed sometime to think about it. Nevertheless we expressed that we are open to discuss potential solutions. Later on Bernd tried to initiate phone conferences to talk about it, I made a suggestion to eliminate NagiosForge and NagiosWiki as a quick fix and so on.

We are still open to discuss solutions. Right now our plan is to rename the service. We want to call it something like "NaPLAX - The source for Nagios Plugins and AdOns" and fade out the name NagiosExchange, Forge and Wiki. So Nagios will no longer be part of the Name, the Logo or the Domain name.

I also saw that you feature nagios-fr.org somewhere, so maybe there is already a possibility to keep the Name AND comply with trademark regulations. Of course I would be happy to hear that. If not, we can still change the name. As a tradeoff, it would be nice if we could use the old domains for some time as a forwarder.

Third, the German trademark. I know now that this was a mistake, but I registered it, before we even knew each other, almost a year before the

first conference. Please let me explain why I did it:

At this time, you did not seem to care much about the Nagios trademark situation outside the US. At this time we started to promote Nagios very heavily in Germany and that was also the time when the idea of the conference came up. At this time there were companies and law firms in Germany, that registered trademarks of popular Open Source projects and than tried to sue users of the project or companies offering services with it. It even happened with Linux: Someone registered it as a trademark and then tried to get "damages" from Linux companies like SUSE. So I thought a good way of protecting myself here would be to register the trademark myself. It is also not very expensive in Germany. Some of my friends are lawyers and so I did not have to pay any legal fees and German equivalent of the PTO only charges about 390 Dollar for registering a trademark. I promise, that I had no intention to harm you, the Nagios Project or Nagios Enterprises nor anybody else. I just registered it, received the certificate and put it into a drawer to be safe in the future. That's it. And I even forgot about it, until the thing was brought up in the German Nagios Forum. Somebody discovered that the nagios.de Domain is registered to somebody in Austria using it as a forwarder to his business website. They also discovered that we had the trademark registered and asked us, if we could help them to get the domain for the German community, by using the trademark. It was just a few weeks ago.

I still have no intention at all to use the trademark in any way. Especially I do not want to interfere with you guys. I saw that Nagios Enterprises filed for a trademark registration in Germany as well, which is good. If you need any help there, just let me know.

OK, to come to an end: Please understand, that I never did anything deliberately against your will. I sure shoot forward way too fast, I did things I should have asked you before and I was too pushy. And I apologize for that. But I never did this to harm you or exploit anything. I always wanted to push Nagios and make it more popular. Because that also helps Netways.

When I said, we are committed to our business and private relationship, I really meant it. This is why I am writing this long mail, I am trying to state my point of view and I am willing to do a lot to remove this problem. Please give my statements a thought and let me know how you see the problem.

I would be very happy to hear from you.

Regards,
Julian