



This article presents general guidelines for Ohio nonprofit organizations as of the date written and should not be construed as legal advice. Always consult an attorney to address your particular situation.

Nonprofit Brand Protection Options: Common Law Trademarks, State Registration & Federal Registration

Creighton Frommer, Esq., RELX

Many nonprofit organizations seek to protect their key brands with trademarks. This article will provide guidance in choosing how to best protect them through trademark. For instance, depending on the reach of your organization and your budget, a “common law” unregistered trademark may suffice or you may want a registered state or federal trademark. This article will outline the three different trademark protection options that your nonprofit organization can receive and the pros and cons of each option.

What is a Trademark?

A trademark is a unique word, symbol, logo, design, or a combination of these things used to identify the source of your goods or services and distinguish that source from others. A trademark is most commonly used with a business name. See our article with FAQ’s about [Trademarks](#) for more details. For this article, we will discuss a hypothetical organization, “Alpha Helpers of Ohio,” protecting its name as a trademark.

Common Law Trademarks

Common law trademarks are also known as unregistered trademarks. Instead of needing a registration, your nonprofit organization automatically owns a common law trademark, and receives certain exclusive rights, as soon as it starts publicly using it related to activities like soliciting donations or providing goods or services to the public. But without a registration, common law trademark rights are limited to the particular geographic area in which your organization operates.

Once a common law trademark has been established through use, your organization can start using the ™ symbol with the trademark to put others on notice that you consider the applicable word, logo, or phrase a trademark. A good practice is to use the ™ on the first or most prominent use on your website or materials, so the overall content does not become cluttered with trademark symbols. For example, if your organization has a website, you may choose to use the ™ symbol in the website heading, but not in subsequent text.

Cheap and easy, common law trademarks require no registration process, no examination process, and no fees. They can last as long as they are used. Like any trademark, registered or not, you must protect your trademark rights, by not allowing others to use your trademark or confusingly similar trademarks in your area, to keep them exclusive to your organization.



In our example, Alpha Helpers of Ohio™ gains common law trademark rights automatically by using this name. Before selecting that name, they first ran a quick internet search of “Alpha Helpers of Ohio” and found no other groups using that name. The organization notifies others that it considers the phrase a trademark by placing the symbol beside its name. Then, for so long as they continue to use and protect it, the name should be exclusive to them within their existing geographical area. However, if Alpha Helpers of Ohio uses the name only in Dayton and another organization uses the same name for a similar organization in Cleveland, Dayton’s Alpha Helpers of Ohio might not be able to stop the Cleveland organization. Alpha Helpers of Ohio also periodically conducts internet searches of its name to confirm that they are the only organization, in the areas they operate, to use that name.

Ohio – State Trademarks

The Office of the Ohio Secretary of State registers trademarks used within the state. For a \$125 filing fee, registering with the Ohio Secretary of State’s office creates additional rights, which extend throughout Ohio, that a common law trademark does not receive. For example, a state registration provides public notice to others, including prospective trademark applicants, that you already use a trademark. The registration itself can be used as evidence that a trademark exists if another organization infringes on your trademark. In the same way as common law trademarks, you can use the ™ symbol with state trademarks.

Unlike a common law trademark, a state trademark goes through an examination process before the application is approved. In Ohio, this process confirms a trademark is valid and proper, including, but not limited to, not being descriptive or generic and not confusingly similar to an existing Ohio trademark. Prior to applying for a registration, you may wish to research with the Ohio Secretary of State’s office database and generally online to make sure the same or a similar trademark that your organization hopes to use is not already used in Ohio.

An Ohio trademark application also requires an example of its use, also known as a specimen. An application can be expedited for quicker review at an additional cost. Your Ohio trademark registration must be renewed after ten years. See the Ohio Secretary of State’s [guide](#) on registering trademarks in Ohio for more details.

Continuing our example, if Alpha Helpers of Ohio™ registered its name in Ohio, they should have exclusive rights in the name across Ohio in their field. Like with a common law trademark, Alpha Helpers of Ohio periodically searches for other organizations using their trademark. Using the earlier scenario of the Cleveland organization using the same name after our Dayton organization started use, our non-profit should let the Cleveland organization know they hold the Ohio trademark for the name.

Federal Trademarks

Federal trademarks are trademarks that have been successfully registered with the United States Patents and Trademark Office (“USPTO”). These trademarks must meet specified criteria to receive a certificate of registration from the USPTO, such as sufficient use in commerce across state borders (i.e., your organization must have donors or other activities outside of Ohio). If accepted for registration, a federal trademark grants your organization certain rights that extend throughout the United States, and registration gives your organization the right to use the “circle R” ® symbol.



Only federal trademarks can use the ® symbol. Like common law and state trademarks, a good practice is to use the ® beside your trademark in the first or most prominent use on the website or materials.

While you don't need an attorney to complete the USPTO trademark application, it is a good idea to have an attorney counsel you through the application and examination process, and advise you about a final registration. The application process often takes about 6 months for an initial answer and nearly 12 -18 months to be registered, with additional delays possible. And it costs at least several hundred dollars per application, which are not refunded if your application is refused. During the application process, the USPTO will perform a complex examination of the federal trademark. For example, an attorney with the USPTO will review the application to see if the application meets the minimum filing requirements and complies with all applicable trademark rules and statutes.

If the examining USPTO attorney refuses your application, you will receive an Office Action (a letter) explaining any substantive reason(s) for refusal with any technical or procedural deficiencies. Not all applications are accepted for registration, but most applications receive at least one Office Action, even if finally registered. An attorney can assist with responding to Office Actions and advising on your chances of success to obtain a registration.

With a successful registration, the USPTO has specific, periodic renewal and maintenance requirements that a federal trademark owner must abide by ([Maintenance Requirements](#)). If a federal trademark owner fails to timely file the appropriate maintenance documents and pay the applicable fees, the registration will be canceled or will prematurely expire.

Unique to federal trademarks, your organization can also file an "intent-to-use" trademark application to essentially hold your place for a future trademark registration. These special applications are not registrations, but they can prevent other organizations from registering a similar trademark before you can start using yours. Like regular USPTO applications, it is best to consult with an attorney for assistance.

Using our example again, our nonprofit applies for federal trademark protection for "Alpha Helpers" based on activities within and outside of Ohio. If they successfully register the trademark, they may be able to stop other similar organizations from using or registering the same or similar names anywhere in the United States, as long as they use and maintain their federal trademark registration and keep using the trademark.

Conclusion

When considering the best trademark protection for your organization, you have several options. Consider how much you want to spend and how important your trademark is to your nonprofit. Obtaining a state trademark in Ohio is a fantastic middle ground between a free, but unregistered, common law trademark and a more expensive and time-consuming, federal trademark registration.

Also match your trademark with your geographic use and needs. For example, if you want rights throughout Ohio but don't meet the requirements for a federal trademark, then an Ohio state trademark registration may be a smart choice for your organization.



Here are some additional details about each option:

	"Common law" or Unregistered Trademark	Ohio - State Trademark	USPTO - Federal Trademark
Registration costs:	No registration cost.	\$125	Approximately \$250 per class. (Fees)
Use Requirement:	Requires use.	Requires use.	Registration requires use, but intent-to-use application available.
The examination process:	No examination.	Simple examination process.	Complex examination process.
How often these trademarks are searched:	No central database. Parties may see the use in online searches.	Infrequently searched by parties seeking a new trademark.	Frequently searched by parties seeking a new trademark.
How far these rights extend:	Rights can extend throughout the geographical area where it is used.	Rights can extend within Ohio.	Rights can extend within the US.
Applicable symbol:	™	™	®

Often nonprofit organizations select a mix of registrations and unregistered rights depending on the scope of the brand and its importance to the organization.

Need Legal Advice?

If you are a PBPO client and have questions regarding the content of this article or need legal assistance, please contact us at info@pbpohio.org or (513) 977-0304.

Not a Client? Apply to become a client by submitting a [Request for Legal Assistance online](#), or contact us at info@pbpohio.org.

About the Author:

[Creighton Frommer](#) is Chief Counsel, Intellectual Property, Technology & Procurement for RELX, the parent company of LexisNexis, Elsevier, and RX. Creighton also served as President of the Association of Corporate Counsel (ACC) Georgia Chapter and volunteers with Pro Bono Partnership of Atlanta.