

**PBPA Podcast Transcript**  
**Episode 25 – What’s In a Name?**  
**Legal Considerations of Nonprofit Branding**  
**(23:41 minutes)**



Sireesha ([00:00](#)):

Most nonprofits choose a name intentionally, whether it relates to your mission, your founder, or your area of service. If you're deciding on a name for your organization or a new program, there are some specific considerations and steps you should take before claiming a name. In this episode of the PBPA Podcast, Creighton Frommer will guide us through legal considerations in selecting a name for a nonprofit

Sireesha ([00:34](#)):

Hello and welcome to the PBPA Podcast. In each episode of the PBPA Podcast, we explore legal questions relevant to Georgia nonprofits. I'm your host Sireesha Ghanta, Counsel and Education Director at the Pro Bono Partnership of Atlanta. PBPA strengthens our community by engaging volunteer attorneys to provide nonprofits with free business legal services. We provide numerous free resources via our website, including articles and webcasts specific to Georgia nonprofits and their business legal concerns. We also provide direct legal services to our clients. For more information on client eligibility requirements, to apply to be a client or to access our vast learning center, visit our website at [pbpatl.org](http://pbpatl.org). Before we jump into this episode's topic, keep in mind that this podcast is general information, not legal counsel, contact your attorney for guidance on your nonprofits' specific situation.

Sireesha ([01:46](#)):

Creighton Frommer is a longtime PBPA volunteer he's Chief Counsel of intellectual property at RELX group. And over the more than 10 years that Creighton has volunteered with PBPA, he has helped numerous clients with IP matters and spoken on the topic in webcasts, and now in this podcast episode. Thanks for being here today Creighton,

Creighton ([02:10](#)):

Thank you for having me. It's a pleasure.

Sireesha ([02:14](#)):

So Creighton, when a nonprofit is just starting out, their focus is to find funds and to support their mission. Where should branding and name selection fit in as a nonprofit is just starting out.

Creighton ([02:29](#)):

It is an important piece. I know the registration and setup of the corporation comes first and your corporation name doesn't have to meet, match your trademark name. But pretty soon after you register your corporation, I think you're gonna want to develop a name that can be a brand, and it's gonna help shape the identity and encourage early supporters. And developing a name that's available and reflects upon your nonprofit well is key to the development of it.

Sireesha ([03:03](#)):

And Creighton, what makes a good name for a trademark?

Creighton ([03:07](#)):

Yeah, so I'll, I'll kinda use the word trademark and brand interchangeably research cuz it's, you know, they're, they're basically the same thing and trademark is just kinda the legal form of a brand. Um, and there's a couple different ways to approach, you know, finding, a good mark or a good brand. There's some organizations that like to pick something very arbitrary and kinda unique to what they're doing, that doesn't, that they can kind of fill that identity with what their nonprofit does. Like in the, in the retail world, like the word "nike" or "apple" for computers. These are brands that don't describe what they're selling. And so the market sort of through marketing and investment, you kind of fill that name with what you want it to mean. But I think more common for nonprofits is a name that suggests what, what your organization does.

Creighton ([03:56](#)):

So if you take Pro Bono Partnership, you know, it suggests that it's working with pro bono work and it's partnering people together. It's a, it's a unique name. In Georgia, we work with like Homestretch, you know, it helps people, you know, it connects peoples with homes that that need help or habitat for humanity. You know, it's, these are names that don't exactly describe what they do, because if you complete what your organization is doing, you won't be able to get trademark protection. Um, but if you take like Habitat for Humanity, if it was called instead homes for people who need homes, something, something very generic. You know, people use those words all the time to describe what, what that provides. So that's not a good trademark, but if you just take that one step that makes people use a bit of a mental leap from the name to what you're actually doing, those can make the best trademarks.

Sireesha ([04:50](#)):

And what about the logo?

Creighton ([04:52](#)):

You can you can pick logos that also are unique. And I think that's, that's one aspect of the name too, that I, I didn't really mention is, is it must be exclusive to your organization and we'll talk a bit more about how to ensure you know, how exclusivity works, but for a logo it's important that, that the brand, your identity is included with the logo. So, you know, it may be something simple. Um, it may be something that maybe the shape of the logo reflects something along the lines of what your nonprofit is doing. But the main thing is that it just should be unique to, and identify your organization. You don't want it to conflict or be confusing with other logos. And, frankly, sometimes people change logos over time, you know? So, you know, if you think about different companies that we all know, you know, logos evolve. So the main thing I think is to pick a good word trademark, and then, you know, over time you may find a logo that fits your needs. But I think the main focus should be on the, the wordmark.

Sireesha ([05:52](#)):

And can you explain what is a wordmark versus a trademark?

Creighton ([05:56](#)):

So, I mean, a wordmark, just being a trademark that is a word or a phrase. So like Pro Bono Partnership, like habitat, humanity, these are all wordmarks. Um, what are not wordmarks would be like a tagline or logo. So I think in McDonald's, you know, "I'm loving it", you know, that's a tagline that can also be a trademark, you know, maybe a nonprofit would want to have a tagline. I don't think that's very common normally, but, but it's possible to have a tagline as a trademark. Um, and then, like I said, of

course, a logo, would be a different type of trademark. You can also get a trademark on if you're producing products or materials, kind of the style and design of those materials. But, for most nonprofits, I think the focus is the wordmark.

Sireesha ([06:38](#)):

And does a nonprofit need to register a trademark for their name or logo?

Creighton ([06:45](#)):

Yeah, this is a good question. It's one. I think we hear a lot from nonprofits. When we look out into the commercial world, you know, having a trademark registration to protect it from other competitive organizations is very important. In the nonprofit space, it's also important, but it, but you don't maybe have the same competitive, um, challenges that you do in, in the commercial world, but you can still register a trademark. Uh, so there are three levels. Basically when you look at a trademark, you can get a federal registration, which is with the United States patent and trademark office, and that registration will cover you nationally for your name. Um, it involves an examination process with the US PTO and it costs, you know, several hundred dollars plus usually some legal work to get a US federal registration.

Creighton ([07:36](#)):

Um, the next level would be, and I think this is a, it makes a good, it went for a lot of small to medium nonprofits in Georgia would be a state registration. So you can file with the state of Georgia and they have their own trademark office. It's less than a hundred dollars. You can put your name on the list and it'll be considered for a straight state trademark. Um, both put the world based beyond notice that that you've got it registered. You've got the trademark. Um, if you, if somebody else has a similar name, that's confusing, you can point them back to that trademark registration and say, see, I've got it registered. Somebody else has accepted my name as my trademark.

Creighton ([08:15](#)):

And then there is the option here in the United States of what we call a common law or unregistered trademark. So if you have, whether it's a logo or a wordmark or tagline, you don't have to register it and you can still get trademark rights essentially immediately upon use. So once you start using that name, that brand to solicit donations, provide services, the term we use in the, the law is "use it in commerce", although for a nonprofit commerce is, you know, loosely defined. But once you use it to, to collect money or to provide services, then you basically have started collecting trademark rights in it. So that's a great way for a nonprofit to start using a new brand, not feeling like they have to jump right into registration, especially if it's a new nonprofit, they don't have maybe the funds or the time to devote to getting a trademark registration. Um, they can just start using it collect some trademark rights. And then when they're ready look at registration. You know, I think my go back to the wordmark being the most important. I think if you do look to registration, you wanna look first to your wordmark. You know, when I work with clients, a lot of times, we'll say, you know, if it's a logo, that's a temporary logo or especially tag lines, which are often temporary in nature, it's really often not worth getting a registration, at least a federal registration. You might still get a state registration, but you, it depends on kind of your needs and risks. And I these are some of the considerations that I think a nonprofit would look at.

Sireesha ([09:41](#)):

And I do also want to mention that we have a great article on this topic that Creighton helped out with talking about these various options available to nonprofits, as they're trying to determine what

type of trademark registration or not to register their name or logo. And I'm gonna include a link to that article in this episode's web page. And speaking about web pages or websites, websites are also very important for a new organization. Creighton, tell us how does a domain relate to a trademark?

Creighton ([10:20](#)):

It's an interesting connection, because if you think about how people access your information about your nonprofit, it's most likely through the domain name, it's through the website nowadays. You know, it's, anybody can pull it up on their phone or their computer. And the first thing they're gonna do is do a Google search or a, a Bing search or they're using and find your nonprofit. And the first thing they're gonna look at is the domain. And so that domain name should reflect your brand and identity. Um, and so when it goes to, when you're selecting it, your initial, wordmark your initial trademark for your organization? I would say the first thing you probably wanna do is look to see is the domain name available you, is there a version of that, of that name that you can get as a domain name it's not already taken and make sure that you pick a name that that can be, can be registered as a domain?

Creighton ([11:08](#)):

Uh, it's sort of like the the front door, you know, essentially of your, of your nonprofit. You want to have the trademark reflected in the domain name. And then if you do see others once you have a trademark, if you see others using your domain name or sorry, using your trademark in a domain name, there are certain rights. You can have to help reclaim that domain name if somebody's using it in bad faith. And hopefully, you know, for organizations that PBPA works with and, and you would not be running into the situation normally, but those options are available. So I think from a, from a nonprofit perspective, the main goal is to make sure that the domain name is reflects your trademark. And you may also wanna consider getting different variations of the domain name. So of course, we're all used to working with.com or.org for a nonprofit. So, you know, making sure you can register both the.org, the.com, but there may be other versions you may want to get. Um, you know, if you're abbreviating in the domain name, you may want to get a version that's not abbreviated just to make sure that somebody doesn't come in and try to take a similar domain name, just causing, confusion for people trying to find your organization.

Sireesha ([12:18](#)):

OK. So we've talked about domain names and trademarks and logos on wordmarks. One thing I wanna ask is how does this relate to a corporate name? Do you have the option to have your brand name be, does it have to be exactly the same as your corporate name? Or can you have some flexibility with that? And then do you have to do a DBA registration? How does that work?

Creighton ([12:45](#)):

Yeah. So when you're doing a corporate name you're right, you may pick whatever you want that that's available on the corporate name database, and that's a much more looking it for equal matches between names. So as long as somebody hasn't basically registered that exact same name as your corporation, then it should be available and you should be able to register that corporation name. Then when you pick a, a trademark, when you're comparing your trademark to other trademarks that are existing, it's a standard of not an exact match, but a likelihood of confusion. So you can have, you know, different spellings or different sounds. And that's how you can check availability of a trademark. But yeah, so you can pick any trademark, no matter what the, the corporate name is. If you have a trademark that is different than your corporate name, and you're, you probably will want to work and

make sure that you're using the corporate name for your corporate purposes, you know, in contracts and in, you know, signing materials, any sort of, kind of legal purpose.

Creighton ([13:44](#)):

You know, if you think about it, your corporate name is like your full name as a person. And your trademark is like, maybe your nickname and people may call you that, but you would always use your full legal name in legal materials. Now, if you want to use your nickname, your trademark as your name, then you would want to look at you know a fictitious business name. And, and there are some, some nuances there you may want to talk to people at PBPA to help figure out the, the best way to use those. Cuz there are some nuance and it's, it can be, it's maybe tough to get your head wrapped around the different, the three different ways of using those names. But for the most part, and for these purposes, you know, you can pick a trademark that is completely different, has nothing to do with your corporate name. You just don't want to use your trademark as your corporate name, unless you've gone through those processes.

Sireesha ([14:38](#)):

And so once a nonprofit has its name and logo and maybe even a domain name set for its website. Creighton, what's next as the organization grows? What should they do to protect and grow their brand?

Creighton ([14:55](#)):

Yeah, so a brand, when I work with folks, you know, a brand is almost like you know, almost like a child. I mean, it's, it's something that, of the, of the organization, of, and of the founder. And it's, it's gotta build its own identity. Um, you'll have kind of a brand voice, you know, that all reflects the reputation and the goodwill of, of your organization. And so you need to take care of it make sure it's managed well. Um, and that it reflects and continues to reflect as, as your organization grows that growth. So one of the main things we look at from a legal perspective is making sure that others are not using your brand without your authority organizations can sometimes get into trouble with essentially allowing others to use the trademark without approval and then losing the trademark rights because the whole nature of a trademark is there's only one and only source coming from that, from that provider from that, from that trademark, you know, if you think of Coca-Cola, there's only one company, there's only one organization that can provide Coca-Cola now they made license other companies to use uh Coca-Cola but it's all originally coming from the, the home Coca-Cola, they, they have control over whatever has their brand.

Creighton ([16:10](#)):

And so when you think about using it controlling the mark there's one example that happened, actually it was in the, in the nonprofit space. An organization called free cycle in California, where, you know, it was an organization that supported the giving away of materials, you know, maybe instead of recycling it and turning into back to its original parts, giving them away and letting people reuse different items. And they had different chapters around California, but there was no control over what those chapters were doing and how they worked and how they operated from the home. And they essentially lost their trademark rights because the "market", the, the people that saw a "freecycle" didn't know what they were gonna get when they saw that brand. That's sort of the worst option. And it's very rare, but as an organization director, you want to make sure that you're not letting others use your name without you having oversight of how that use is, and that it fits your standards. Um, you know, every organization

has different standards of quality and yeah, professionalism that, that they want to maintain. And so that needs to be consistent across all uses. And the only way to do that is to either produce whatever content it is, yourself or authorize and review content that that others are using and putting your brand on.

Sireesha ([17:29](#)):

Similar to that your name being used by others, what is a nonprofit supposed to do if they see another organization with their same name?

Creighton ([17:43](#)):

Yeah, these can be difficult situations. Um, because as I mentioned it, you know, trademarks often do get sort of treated like somebody's children and, and they become emotionally tied to them. And so if another organization comes up with a name, you know, usually happens in parallel where there's no, there's no malicious intent. It's just two organizations may have the same idea of what a great brand is. And they may come up with the same name or something very similar. Like I said, it's a "likelihood of confusion" test. And basically then it comes down to which one was first, who has senior rights. And so if your organization was first and you believe that there's confusion, frankly, I think you, you would want to talk with PBPA because getting into a dispute about a trademark is a complicated question. You know, there are legal elements to what is "likelihood of confusion", and so you'll want to talk with that attorney to help you navigate. Is there really confusion? Is there not confusion and how to approach the other party? Because most of the time it's not, it's not malicious, it's not intentional. Parties will need to work out some sort of arrangement to to make sure that they can, you know, the junior party, if they were really this confusion can change its name. And so the, the senior trademark owner may work with counsel and send either what we call like a "cease and desist" notice in some instances, or maybe just pick up the phone and help explain, we've got our trademark rights that are earlier than, than when you've created. And there's confusion. So gonna ask you to, to basically phase it out to change it. Um, if you don't do that, then you can lose your trademark rights because you won't be the only provider. It goes back to exclusivity. So there is an element that you can't really ignore situations like that

Creighton ([19:24](#)):

Now trademarks do operate geographically. And so, you know, if, if another organizations in another state and is not operating in for the same beneficiaries and working with the same donation pool, they're operating independently, and they may just to be two organizations that in parallel provide the same service and don't conflict with each other. And there's no confusion, but if they are also within your jurisdiction, your area, and there's maybe people who receive mail from both of 'em or receive benefits from both of them, there's clearly gonna be some confusion between those two organizations. And it's something, again, you'll want to work with PBPA to help address. Uh, and frankly sooner, rather than later, it's not something you wanna sit on. Um, you know, within, you know, within a matter of days or weeks, you wanna work with an attorney to, to help resolve that.

Sireesha ([20:19](#)):

And that would be a situation where a nonprofit should not send a letter themselves to the other organization. They really should reach out to counsel for assistance with that.

Creighton ([20:30](#)):

Yeah, I think it makes a lot of sense to reach out to counsel because there are a lot of ways to, to solve it. And there are a lot of, like I said, trademark law is a very subjective area, which makes it fun to practice in, but there are a lot of things to consider like with markets and who came first. The last thing an organization wants to do is send a notice letter or, or some sort of complaint to a party who says, and saying, you need to change your trademark because they're confusing. And the other party says "Actually we were here first. You need to change your trademark." And it happens in the real world where, you know, the party who thought they were the winner was actually the loser. It ends up losing their trademark.

Sireesha ([21:08](#)):

Any other tips, Creighton?

Creighton ([21:10](#)):

You know, working with counsel at the beginning. You know, if when you are developing your new organization or developing a new brand or a new trademark, just to talk through the ideas of what you wanna pick can be very helpful. Even if you don't wanna register it, they can uh, trademark counsel can help with searches. You know, you can look online yourself first when you're looking for new marks and just see if who else is using that name. If anybody else is using that name for nonprofit services, are they using them for nonprofit services in your area? Um, has it already been taken, going back to the domain name is the domain name available, and then some, a bit of legal investment, little legal work in the beginning can help in the long run to avoid you having to change your name later when it gets much more expensive to rebrand and recreate a different brand identity.

Creighton ([22:00](#)):

Yeah, I think the other thing would be when we look at trademarks it's it is a subjective area, you know, there's a lot of there are a lot of versions of, of marks out there. So, you know, from time to time, we might get questions. Well, like I said, I see this this other name out there, they're operating in my space, but they're maybe in Montana or they may be in New York. And it goes back to, I was saying that you know, geography and, and markets do have a lot to do with, with how you protect your trademark. So don't jump into something that you know, when it comes to maybe creating a dispute or creating something that, that maybe is something we just have to live with as a nonprofit

Sireesha ([22:41](#)):

Creighton, thank you for being here today to share your time and expertise with us, you really help to clarify a lot of these questions. Um, we always appreciate your insight.

Creighton ([22:52](#)):

Yeah, my pleasure. Thanks for the invite. And it's always enjoyed working with you Sireesha and PBPA. Thanks.

Sireesha ([22:59](#)):

We hope that you found this episode of the PBPA Podcast to be informative and helpful. We add new episodes every month with short conversations about general, yet important legal information for Georgia nonprofits. Remember that this is not legal counsel. Talk to your attorney about your organization's specific concerns. Thanks for tuning into the PBPA Podcast. And to all nonprofits listening out there, thank you for all the good work you continue to do in our community.