

PBPA Podcast Transcript
Maintaining Your Nonprofit's Trademark- What Comes Next
(21:14 minutes)



Sireesha ([00:03](#)):

You've gone through the process, secured your trademark, and now you've got the official "Circle R" next to your name. But what comes next? What do you need to do to keep your trademark active and protected? In today's episode of the PBPA Podcast, Vijay Nenmeni will talk about the key deadlines you can't afford to miss, how to monitor for infringement, and what ongoing steps nonprofits should take to ensure their trademark remains a valuable asset.

Sireesha ([00:43](#)):

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. 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 ([01:52](#)):

Vijay Nenmeni is corporate counsel in Intellectual Property and Litigation with Cox Enterprise. He has spent his career in industry, law firms and in-house advising his clients on all aspects of intellectual property and with a special focus on patents. Today, he's flexing his trademark muscles as he answers my questions about trademark maintenance. Thank you so much for being here today, Vijay.

Vijay ([02:18](#)):

Thank you Sireesha. And thanks to PBPA for having me on this podcast. Like Sireesha mentioned, I'm a patent attorney who occasionally moonlights as a trademark nerd. And today we're gonna dive into trademark maintenance. Something that sounds painfully boring, but it's secretly thrilling, believe me.

Sireesha ([02:36](#)):

That's very true, Vijay. It may sound boring, but it is incredibly important, particularly after nonprofit has gone through the trouble of getting their trademark registered. And for this episode, we're talking about what a nonprofit should do after it has received an official registration certificate from the USPTO. If any of our listeners do not have a federal trademark, want to learn about the trademark registration process, I'll drop a link in the show notes with background on that. But today we're going to dive directly into trademark maintenance. And Vijay, to start off with, let's talk about after a nonprofit receives its trademark registration from the USPTO, what is the first step they should take?

Vijay ([03:28](#)):

As the listeners are aware, a trademark, a federal trademark is a powerful tool. It protects your nonprofit's name, logo, or tagline from misuse, confusion, and infringement. But trademarks are not "set it and forget it". They require care. Think of a trademark like a house plant. If you water it regularly, it grows strong. If you forget about it, it just dies. So once a nonprofit has a registered trademark, I would think of three different areas that they need to pay attention. First, the nonprofit needs to ensure they keep using the trademark for the goods and services that was claimed when you first registered. That is that you use it in commerce. So the way you would do it is you use your either logo or other material on your brochure and in other communications, and that you periodically document that you're actually using it. Keep records of use such as website screenshots, labels, brochures, et cetera. Also do an annual audit of "Are you still using the mark the way you registered it?". So that's kind of the first step. And also use the circle R appropriately Using TM is only for unregistered trademarks. Use a circle R. That is the first step.

Vijay ([04:46](#)):

The second would be start thinking about maintenance fees and deadlines, to make a note in your calendar to follow up at five year mark and 10 year mark. We'll kind of go through that in more detail and assign this tracking task to someone in the organization who is responsible. And the third aspect to think about is that you should police your mark. The law requires trademark owners to police their marks, which means actively watching to ensure others aren't using your name or logo. That can cause confusion and weaken your brand. So we'll go through all these three items or areas in more detail. And I would also suggest the audience to look through US Patent Office "Keeping Your Registration Alive Link".

Sireesha ([05:34](#)):

I'll drop a link to that resource "Keeping Your Registration Alive" in the show notes. Vijay, let's talk about those specific years to follow up that you mentioned? What are those maintenance deadlines and the associated costs for the filings for each of those rounds?

Vijay ([05:57](#)):

So after the trademark has been received between the first step happens at between the years five and six after registration, we must file something called "Section Eight Declaration", which is the declaration of use. This is basically saying to the patent office, "Hey US Patent Office, we are still using this trademark in real life." And this step costs about \$125 for every class that is trademarked. And the next step happens after about 10 years after registration. And it happens for every 10 years. So at this point, you need to file the Section eight that we spoke about just now, the declaration of use plus a Section nine, which is a renewal application. And this joint filing costs about \$525 per class.

Vijay ([06:49](#)):

And there is also an optional bonus round that you can file. This is called a Section 15 declaration. You can file this anytime after five years after your trademark has been registered. And this makes your trademark incontestable. This is like giving your trademark a legal gym membership. It gets stronger and it becomes immune to certain challenges. This is entirely optional, but it's highly recommended, especially if you plan to expand licensure brand or friend of copycats. This costs about \$200 per class. Note that all the fees that I mentioned are per class. And before you file any required maintenance

document, act carefully reevaluate your trademark use. If you aren't using your trademark with one or more goods or services that you originally registered for, you must identify those goods or services in your declaration and delete them from your registration. You won't be charged a fee for deleting the goods, but you make sure that it's up to date.

Sireesha ([07:50](#)):

Okay, so when a nonprofit files one of those declarations, in addition to the filing fees that you mentioned, what else does it need to provide?

Vijay ([08:01](#)):

In addition to the fees, you need to have proof that you're using your marking commerce. And this is called a specimen. We, we kind of touched on this earlier. This could be a screenshot on your website, it could be a brochure, a label of your product, your annual fundraising gala flyer with your logo front and center. You need one specimen for each class of goods or services. Just make sure it shows your trademark in action and not just hanging out in a Google document.

Sireesha ([08:32](#)):

Okay, so the nonprofit needs to prove that it's still using that trademarked item, whether it's five years or 10 years after that initial registration.

Vijay ([08:42](#)):

Just one more point to add is if you are filing the section 15 declaration to mark incontestability then you also need to file that there have been no lawsuits pending for your mark.

Sireesha ([08:56](#)):

And Vijay, what will it happen if a nonprofit were to miss one of these deadlines to file?

Vijay ([09:03](#)):

Ultimately your trademark could get canceled. It's like letting your website domain expire. For instance, one day your hopeforpaws.org and the next day it's a crypto scam site. You don't want that to happen, right? But you are not doomed if you miss the deadline per se. But time is of the essence. The US Patent and Trademark Office gives a six-month grace period after the deadline to file your maintenance documents, either section eight or section nine. But you allowed to pay a late fee. Currently it's a hundred dollars per class, but your registration can still be saved at that point. Just make sure your trademark is still in active use. Obviously if you're not using your trademark, you cannot revive a debt trademark that way by using the grace period, what if you actually miss the grace period as well? So at this point the trademark is done, it's canceled, and you need to reapply from scratch. And in the meantime, somebody else could register a similar mark and you may lose the benefit of your original registration date, which can hurt if you ever have to enforce your rights.

Sireesha ([10:14](#)):

So we encourage our listeners to make a note, as Vijay mentioned earlier in your calendaring system to follow up five, 10 years after your initial registration. And if you are a PBPA client, please do reach out to PBPA because we can help you with filing those declarations. But are there other ways, Vijay, that a nonprofit will be notified? Does the USPTO send letters or emails to help a nonprofit track the filing deadlines and requirements?

Vijay ([10:48](#)):

The USPTO does send email reminders, text reminders, but I wouldn't depend on those. They do these email and text reminders for section eight filing at the year five to six mark and for the section eight or nine combo every 10 years. But that's only if you opted for email communication when you originally filed your application and your contact information is up to date at the US Patent Office database. And some tips for nonprofit like Sireesha just mentioned, would be please calendar or use a docketing system. You can use Google Calendar, you can have spreadsheets or other trademark software. Assign this task to a staff member, an attorney, or to a board member with compliance duties and add the deadlines to your organization's annual planning checklist. Also, you will realize that you'll get a lot of unsolicited letters from third parties that are privy to your information since it has been filed publicly. Make sure that you review those emails and letters and that they are from the US Patent and Trademark Office and that the emails are from @uspto.gov and not from other sources.

Sireesha ([12:06](#)):

That's right, Vijay. Those letters from third parties can be very tricky to figure out if they're actually from the USPTO or not. So we definitely encourage our nonprofits to look closely at those letters or those emails and we even have an article about that and I'll leave a link for that one in the show notes as well.

Vijay ([12:31](#)):

Awesome.

Sireesha ([12:32](#)):

And now that we've covered the maintenance filings, let's talk about other steps a nonprofit should take to protect their registered trademark. As you mentioned earlier in the episode, if you don't police, you could potentially lose your trademark? What does that mean?

Vijay ([12:48](#)):

So policing your trademark simply means keeping an eye out to make sure others aren't using names or logos that are confusingly similar to yours. For nonprofits, this could look like, for instance, another group in your state starts using a nearly identical name for a similar fundraiser. Or a for-profit company uses your logo on merchandise without your permission. This may lead to confusion with your donors or partners. For instance, some donors are now donating to this other company which has a very similar name to yours, which ultimately undermines your brand. So if you don't actively protect your brand, if you don't actively police your brand, you risk a few things. One is dilution that your brand becomes weaker because there are too many similar names that are floating around. That could even abandon your trademark because you did not police them. Courts can say you effectively gave up your rights by not enforcing them because you kept seeing these other companies taking your name, but you did not

do anything, anything in return. And you can risk your mark becoming generic. I'm sure everybody knows the famous examples of aspirin, dumpster. Those used to be trademarks, but those have become generic.

Sireesha ([14:11](#)):

So let's talk a little bit more about confusingly similar trademarks. How should a nonprofit look out for that to make sure there's no confusingly similar trademarks?

Vijay ([14:23](#)):

A few things that a nonprofit can do is you can set Google alerts with your organization's name and slogan and other things that you're trademarked. You can do Google alerts with those, or you could watch for lookalikes on social media and event listings, conferences. So when your volunteers or directors go to different conferences they can watch out for is that other wordings or other slogans that are owned by your organization that are used by others. You can even look at Etsy website and other websites and you can also use simple trademark watch services. Some of them are free and some are paid. But those are some ways that the nonprofit can look out for confusingly similar trademarks.

Sireesha ([15:12](#)):

And can we speak briefly about what should a nonprofit do if it seems someone out there is using a confusingly similar trademark?

Vijay ([15:22](#)):

Absolutely. So first I would say don't panic and definitely don't start with a cease and desist email written in all caps. And this is not the time you unleash your inner "LAW & ORDER: Special Nonprofits Unit". Absolutely not. First I would confirm that there is a actual conflict. Ask "Is the other company or organization, are they in a similar space?" If they are not, then you don't have to worry. But are they doing school lunches? Are they doing fundraising? Are they into education or public service? Then you need to start worrying. Is their name or logo really similar or is it just kind of rhyme? Not really similar, just rhyme. That's okay. And are donors or volunteers or the public confused or the donors now starting to donate to the other organization than your organization. Then there is actual confusion or there is conflict. So if your nonprofit, for example, is "Hearts for Hope" and theirs is "Hopeful Hearts" and both of you are running food pantries in Georgia, yes, absolutely there is a problem.

Vijay ([16:32](#)):

So once you confirm that there is actual conflict or an actual problem, then you would gather evidence, take screenshots of their websites, their social media marketing material on all of that. And then note any public confusion like, like we said, if there is any misdirected donation, keep records of those. And then do a comparison, like a side by side comparison with all your material. And after you're done all that and you're confirmed that that is an actual issue, then consider reaching out nicely. So friendly professional email maybe all it takes something like we have noticed that you're using a name or logo that's very similar to ours and we are concerned about confusion in our shared community. Could we chat about how to avoid this overlap? Think of it more like a polite neighborly knock on the door, not throwing bricks through their windows. And if that doesn't resolve things, if they won't stop and the

confusion is still growing at this point, a cease and deist letter from an attorney might be appropriate. But talk to an attorney. You don't always need litigation, but a legal letter can often resolve things quickly. Get legal help first. You don't want to be the nonprofit that goes viral threatening another charity with a medieval sounding trademark scroll.

Sireesha ([17:51](#)):

That is great guidance right there, Vijay, on how to approach that potentially tricky situation. And this has all been such helpful information. To close out, can you share some common pitfalls that nonprofits might encounter and how can they avoid them?

Vijay ([18:11](#)):

Yeah, so some of the common pitfalls are thinking that "Oh, we are a nonprofit. Nobody will steal from us." And so if you're not policing your trademarks, then you are in for a rude awakening because nonprofits, just like any other business, are liable to have their name stolen or their logo stolen. So you need to be policing your trademark for sure. And then the next step, like we spoke about not maintaining your trademark or forgetting to it or renewing it after the trade period has lapsed, but those are some common pitfalls. And for those, make sure you calendar your trademark dates and have somebody who is actively managing the trademarks.

Vijay ([18:58](#)):

And the other common pitfall we see is that you're rebranding without re-registering. So for instance, you registered with the logo and then you redesigned it for some reason and then you did not go in and re-register it. Then you may lose any coverage that you have. And also be aware of name drift. For instance, if you foundation is called "Feeding Hearts Foundation". That's the name that you registered with, but you're starting to rebrand it with signs, which call it "Feeding Hearts Atlanta". Then the name has drifted and you haven't registered the name that you're actually using. And obviously don't ignore copycats like we already spoke about this, by not policing. So even though you see someone using it, you didn't want to get into trouble. So you don't do anything that's going to be trouble again.

Sireesha ([19:52](#)):

Well, there you have it listeners, your Trademark Maintenance 101 guidelines. After all the time, money, and effort you have put into getting your official registration certificate, these are the steps to help your nonprofit maintain its shiny new trademark. Thank you Vijay for walking us through these considerations and for sharing your time and expertise with us today.

Vijay ([20:18](#)):

Thank you so much, Sireesha. I just have a closing remark for the listeners. Your trademark is like your nonprofit's superhero cape: Keep it clean, keep it visible, and don't let anyone else wear it.

Sireesha ([20:32](#)):

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.