

The Newlyweed Game: Who Wants to Learn About Cannabis Trademarks?



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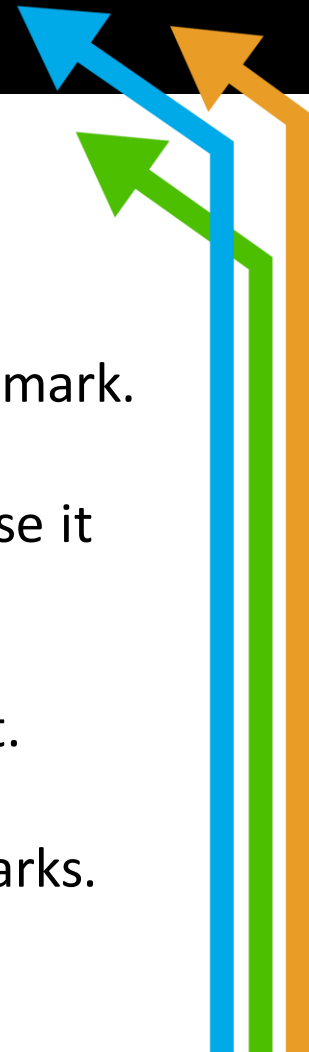
What is a Trademark?

TM 



- A recognizable expression indicating the source of goods and services to consumers.
- Trademark protections exist so you can prevent others from using marks confusingly similar to yours and benefiting from the work you've put into your goods/services.

Types of Trademark Protection in the U.S.



- **COMMON LAW TRADEMARK**

- Free. Rights are acquired automatically upon use of the trademark.
- Protects mark in your geographic region only (& only if you use it first).
- Vulnerable to attack from those who register their marks first.
- TM or SM signify that a business is claiming rights in its trademarks.

Types of Trademark Protection in the U.S.

- **STATE TRADEMARK REGISTRATION**
 - Requires application/s and filing fee/s.
 - Must have a trademark already in use.
 - Protects the mark in that state only.
 - Can register for “state lawful” cannabis goods/services!
 - Can use TM or SM with state registered marks but not [®].



Types of Trademark Protection in the U.S.



- **FEDERAL TRADEMARK REGISTRATION**

- Application/s and filing fee/s required
 - At the USPTO: US Patent and Trademark Office
- Generally, protection covers the entire United States.
- Not available for federally unlawful goods and services
- Use “®” in the U.S. upon approval and registration number

USPTO Trademark Terms

- **Office Action:** A letter sent to an applicant outlining refusals or requirements.
 - **Refusals:** Issued for substantive concerns with an application.
 - Ex: a pre-existing confusingly similar mark on the register.
 - **Requirements:** Issued for administrative concerns with an application.
 - Ex: need for a disclaimer.
- If there are no issues/resolved issues = approval for publication.
- If there is no opposition = Proceed to registration.**

***there may be more steps depending on the type of application filed*

Common Trademark Refusals

- **Likelihood of Confusion**
 - Mark is similar to a previously filed trademark application or registration in appearance, sound and/or meaning used with similar or related goods/services.
- **Merely Descriptive**
 - When a mark merely describes a quality characteristic, function, feature, purpose, or use of the goods/services.



Common Trademark Requirements

- **Identification Requires Amendment**
 - The identification of goods/services in an application must conform to the USPTO's strict specification requirements.
- **Disclaimer**
 - A formal acknowledgment that a word is descriptive and the applicant can't own it exclusively.
- **Translation**
 - A translation for a word in another language.



1. \$100

**406 GREENS FOR “RECREATIONAL MARIJUANA”
DID THE USPTO APPROVE THIS APPLICATION
WHEN IT WAS FIRST EXAMINED?**

A: Yes.

B: No.

C: No, but it can be fixed.

D: Yes, but only medical MJ.

1. \$100

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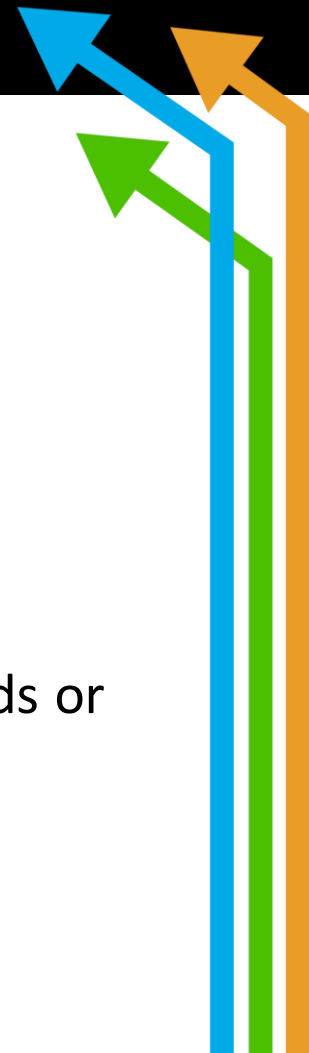
THE CASE: 406 GREENS for “Recreational Marijuana”

- **RESULT?** Received a Controlled Substance Act Unlawful Use Refusal.
- **WHY?** The ID included “marijuana,” which is federally unlawful.
- **CAN THE REFUSAL BE OVERCOME?** No.
 - You can narrow the scope of an ID but you can’t change it.
 - IDs including “cannabis” or “hemp” can often be amended to be lawful.



“Lawful Use in Commerce”

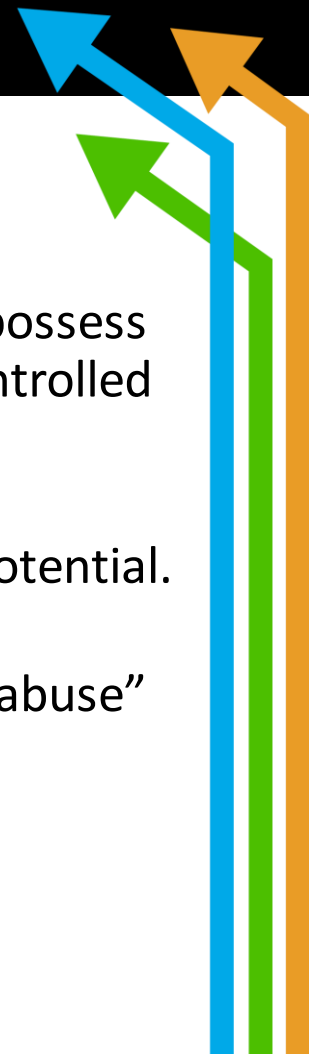
- Trademark Act Sections 1 and 45,
 - **A mark must be in lawful use** in federal commerce to be registered.
- USPTO Policy
 - If the application’s record indicates that the identified goods or services violate federal law, registration is refused.



Marijuana and the CSA *(a gentle reminder)*

Controlled Substances Act

- It is unlawful to: manufacture, distribute, dispense, or possess, or possess with intent to manufacture, distribute, or dispense a Schedule I controlled substance.
- CSA ranks drugs as Schedule I-V based on medical use and abuse potential.
- Sched. I: “no currently accepted medical use” + “high potential for abuse”
- Marijuana is currently listed as Schedule I.



2. \$200

DAD GRASS FOR “ASHTRAYS FOR SMOKERS, CIGARETTE ROLLING PAPERS, WATER PIPES...” THE TERM “GRASS” IN THE APPLICATION INDICATES TO THE USPTO THAT THE APPLICANT SELLS CANNABIS. DID THE USPTO APPROVE THIS APP?

A: Not initially.

B: Yes.

C: Pipes: yes. Papers: no

D: No, it can't be fixed.

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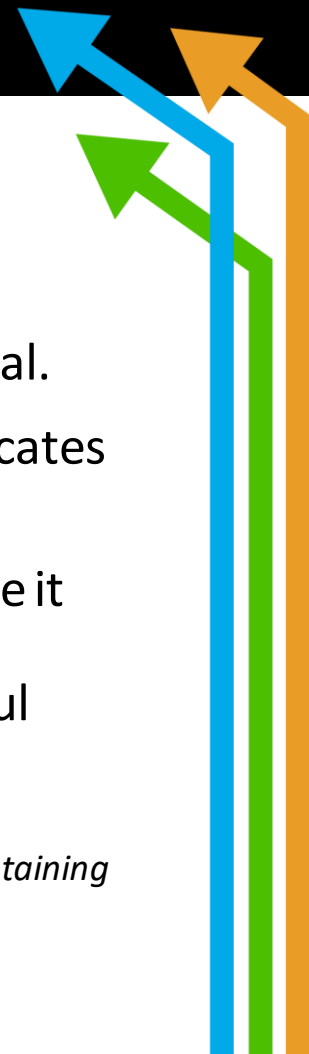
D: No, it can't be fixed.

THE CASE:

DAD GRASS for “ashtrays for smokers, cigarette rolling papers, water pipes...”

- **RESULT?** Received a Controlled Substance Act Unlawful Use Refusal.
- **WHY?** The goods are smoking paraphernalia, and the website indicates they sell medical marijuana.
- **CAN THE REFUSAL BE OVERCOME?** This ID did not specifically state it was for use with marijuana. The applicant was able to amend the identification* to specify that the goods are only for use with lawful products.

**Class 34: ashtrays for smokers, cigarette rolling papers, water pipes..., all of the foregoing containing or for exclusive use with tobacco, hemp or CBD solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis*



CSA Unlawful Use Refusals: Paraphernalia

Controlled Substances Act:

- It is unlawful to: sell, offer to sell, or transport drug paraphernalia.

If the application is for smoking articles and accessories and

- Has “cannabis” in it: can amend and overcome.
- Has “marijuana” in it: can't amend or overcome.
- Has a specimen indicating use with cannabis: can amend and overcome.

NOTE: Since paraphernalia can be used with multiple products, usually amending the ID to say it's only for use with hemp will overcome the USPTO's objections, as they realize you can't really control what a purchaser does with the product.



3. \$300

**FROGEYE HEMP FOR “HEMP FLOWER, PRE-ROLLED
HEMP FLOWER”**

DID THE USPTO APPROVE THIS APP?

A: Yes.

B: Not initially.

C: Maybe.

D: No, it can't be fixed.

3. \$300

**FROGEYE HEMP FOR “HEMP FLOWER, PRE-ROLLED
HEMP FLOWER”**

DID THE USPTO APPROVE THIS APP?

A: Yes.

B: Not initially.

C: Maybe.

D: No, it can't be fixed.

THE CASE: FROGEYE HEMP for “hemp flower, pre-rolled hemp flower”

- **RESULT?** No Office Action. Received an Examiner’s Amendment.
- **WHY?** When an application only has requirement issues, rather than refusals, an examiner can contact the applicant and, if they authorize the needed changes, insert those into the application and approve the mark for publication.

**Class 34: Smokeable herbs, namely, hemp flower and pre-rolled hemp flower, any CBD in the goods being solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis*



Now I Know My CBDs: Hemp and the 2018 Farm Bill

A Quick Review

- **2018 Farm Bill**
 - Formally defined and legalized hemp.
- **Hemp**
 - Cannabis plants with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3% on a dry weight basis
 - FDA has still not approved CBD derived from hemp for ingestion or medicinal/therapeutic use.
- **Marijuana**
 - Cannabis plants with a delta-9 tetrahydrocannabinol (THC) concentration of more than 0.3% on a dry weight basis



4. \$500

EDIBLISS FOR “CBD INFUSED CHOCOLATE”.

DID THE USPTO APPROVE THIS APP?

A: Not initially.

B: Yes.

C: Chocolate is illegal!!!

D: No, it can't be fixed.

4. \$500

EDIBLISS FOR “CBD INFUSED CHOCOLATE”.

DID THE USPTO APPROVE THIS APP?

A: Not initially.

B: Yes.

C: Chocolate is illegal!!!

D: No, it can't be fixed.



THE CASE: EDIBLISS for “CBD infused chocolate”

- **RESULT?** Received a CSA Unlawful Use Refusal AND an FDCA Unlawful Use Refusal.
 - The CSA refusal was withdrawn once the legal definition of hemp CBD was included.
 - The FDCA refusal was maintained.
- **WHY?** FDA has not approved the use of hemp CBD in ingestible products.



The Federal Food, Drugs and Cosmetics Act (FDCA)

- The FDCA prohibits the introduction or delivery for introduction into interstate commerce of:
 - (1) a food *[which includes foods, beverages, supplements, and their ingredients, for humans or animals]* which contains
 - (2) a drug or a biological product *[CBD is an active ingredient in an FDA-approved drug (Epidiolex)]*
 - (3) for which substantial clinical investigations have been instituted *[This is true of CBD]* and
 - (4) for which the existence of such investigations has been made public *[This is true of CBD]*.



5. \$1,000

CBDAZZLE FOR “TOPICAL CREAMS...FOR ANALGESIC PURPOSES, SOLELY DERIVED FROM HEMP WITH A DELTA-9 THC CONCENTRATION OF NOT MORE THAN 0.3% ON A DRY WEIGHT BASIS WITH ONLY NATURALLY OCCURRING AMOUNTS OF CBD.”

DID THE USPTO APPROVE THIS APP?

A: No, it can't be fixed.

B: Dazzling is a red herring.

C: Yes.

D: Not initially.

5. \$1,000

CBDAZZLE FOR “TOPICAL CREAMS...FOR ANALGESIC PURPOSES, SOLELY DERIVED FROM HEMP WITH A DELTA-9 THC CONCENTRATION OF NOT MORE THAN 0.3% ON A DRY WEIGHT BASIS WITH ONLY NATURALLY OCCURRING AMOUNTS OF CBD.”

DID THE USPTO APPROVE THIS APP?

A: No, it can't be fixed.

B: Dazzling is a red herring.

C: Yes.

D: Not initially.

THE CASE: CBDAZZLE for “topical analgesic creams containing hemp CBD”

- **RESULT?**
Received an FDCA Unlawful Use Refusal.
- **WHY?**
FDA has not approved the use of hemp CBD in medicinal products, even in solely topical products.



6. \$2,000

KANNAKISS FOR “LIP BALM...CONTAINING HEMP-DERIVED CANNABIDIOL (CBD) WITH A DELTA-9 TETRAHYDROCANNABINOL (THC) CONCENTRATION OF NOT MORE THAN 0.3 PERCENT ON A DRY WEIGHT BASIS”. DID THE USPTO APPROVE THIS APP?

A: Lip balm is illegal!!!!

B: No.

C: Yes.

D: Not initially.

6. \$2,000

KANNAKISS FOR “LIP BALM...CONTAINING HEMP-DERIVED CANNABIDIOL (CBD) WITH A DELTA-9 TETRAHYDROCANNABINOL (THC) CONCENTRATION OF NOT MORE THAN 0.3 PERCENT ON A DRY WEIGHT BASIS”. DID THE USPTO APPROVE THIS APP?

A: Lip balm is illegal!!!!

B: No.

C: Yes.

D: Not initially.

THE CASE:

KANNAKISS for “Lip balm...containing hemp-derived Cannabidiol (CBD) with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis”

- **RESULT?**

This application did not receive any office actions or refusals.

- **WHY?**

- Topical, cosmetic hemp CBD goods are federally lawful.
- The ID included the legal definition from the start.



7. \$4,000

HEMPADE FOR “NON-ALCOHOLIC WATER-BASED BEVERAGES ALSO CONTAINING HEMP SEED OIL, FLAVORS AND SUGAR”.

DID THE USPTO APPROVE THIS APP?

A: Not initially.

B: Yes.

C: No, it can't be fixed.

D: This question is a lemon.

7. \$4,000

HEMPADE FOR “NON-ALCOHOLIC WATER-BASED BEVERAGES ALSO CONTAINING HEMP SEED OIL, FLAVORS AND SUGAR”.

DID THE USPTO APPROVE THIS APP?

A: Not initially.

B: Yes.

C: No, it can't be fixed.

D: This question is a lemon.

THE CASE:

HEMPADE for “non-alcoholic water-based beverages also containing hemp seed oil, flavors and sugar”

- **RESULT?**

This application did not receive any CSA or FDCA refusals.

- **WHY?**

Hemp seeds and hemp seed derived products can be lawfully included in foods and supplements, as they naturally contain only trace amounts of THC and CBD.



8. \$8,000

TIMOTHY THE CANNABIS BEAR FOR “HATS; T-SHIRTS; BUTTON DOWN SHIRTS; HOODIES”.

DID THE USPTO APPROVE THIS APP?

A: No.

B: T-shirts are illegal!!!

C: Yes.

D: Hats, yes; shirts, no.

8. \$8,000

TIMOTHY THE CANNABIS BEAR FOR “HATS; T-SHIRTS; BUTTON DOWN SHIRTS; HOODIES”.

DID THE USPTO APPROVE THIS APP?

A: No.

B: T-shirts are illegal!!!

C: Yes.

D: Hats, yes; shirts, no.

THE CASE: TIMOTHY THE CANNABIS BEAR for “Hats; T-shirts; Button down shirts; Hoodies”

- **RESULT?**

This application did not receive any office actions or refusals.

- **WHY?**

Goods or services that relate to information about cannabis or convey a message about cannabis are federally lawful.



Lawful Speech/Information Goods/Services

- Clothing related items or ornamental matter that refer to cannabis
- Information about controlled substances
 - *Example: Websites providing marijuana information*
- Legal goods/services relating to cannabis
 - *Example: Drug testing services for job applicants*
- “Weed” or other canna references in marks for goods that don’t actually contain cannabis (and say so in the ID)



9. \$16,000

THE FLOWERY FOR “RETAIL STORE SERVICES FEATURING A WIDE ARRAY OF MERCHANDISE IN THE NATURE OF NOVELTY ITEMS...” AND “...HEALTH-RELATED CONSULTING SERVICES.” THE APPLICANT IS A DISPENSARY. DID THE USPTO APPROVE THIS APP?

A: Yes.

B: Not initially.

C: Consulting: yes. Retail: no.

D: No, it can't be fixed.

9. \$16,000

THE FLOWERY FOR “RETAIL STORE SERVICES FEATURING A WIDE ARRAY OF MERCHANDISE IN THE NATURE OF NOVELTY ITEMS...” AND “...HEALTH-RELATED CONSULTING SERVICES.” THE APPLICANT IS A DISPENSARY. DID THE USPTO APPROVE THIS APP?

A: Yes

B: Not initially.

C: Consulting: yes. Retail: no.

D: No, it can't be fixed.

THE CASE:

THE FLOWERY for “Retail store services featuring a wide array of merchandise in the nature of novelty items...” and “...health-related consulting services.” The applicant is a dispensary.

- **RESULT?**

This application did not receive any office actions or refusals.

- **WHY?**

- Health-related consulting services count as lawful information services, even if they relate to unlawful goods.
- Retail store services for lawful goods are also acceptable.



10. \$32,000

SOUR DIESEL FOR “LIVE HEMP PLANTS; HEMP SEEDS... TO THE EXTENT SUCH PLANTS AND SEEDS ARE LAWFUL UNDER THE 2018 FARM BILL OR OTHER FEDERAL LAWS”

DID THE USPTO APPROVE THIS APP?

A: No.

B: Yes.

C: Seeds: yes. Plants: no.

D: All plants are illegal!!!!

10. \$32,000

SOUR DIESEL FOR “LIVE HEMP PLANTS; HEMP SEEDS... TO THE EXTENT SUCH PLANTS AND SEEDS ARE LAWFUL UNDER THE 2018 FARM BILL OR OTHER FEDERAL LAWS”

DID THE USPTO APPROVE THIS APP?

A: No.

B: Yes.

C: Seeds: yes. Plants: no.

D: All plants are illegal!!!!

THE CASE:

SOUR DIESEL for “live hemp plants; hemp seeds... to the extent such plants and seeds are lawful under the 2018 Farm Bill or other federal laws”

- **RESULT?** Received a Varietal Name Refusal.
- **WHY?**
 - Varietal or cultivar names are generic and cannot be registered as trademarks because they are the common descriptive names of plants or seeds by which such varieties are known to consumers.



11. \$64,000

**BENEFITS FOR “ELECTRONIC
CIGARETTES...CONTAINING CBD DERIVED FROM
CANNABIS WITH A DELTA-8 THC CONCENTRATION OF
NOT MORE THAN 0.3% ON A DRY WEIGHT BASIS”
DID THE USPTO APPROVE THIS APP?**

A: Benefits are illegal!!!

B: No.

C: Yes.

D: Maybe.

11. \$64,000

**BENEFITS FOR “ELECTRONIC
CIGARETTES...CONTAINING CBD DERIVED FROM
CANNABIS WITH A DELTA-8 THC CONCENTRATION OF
NOT MORE THAN 0.3% ON A DRY WEIGHT BASIS”
DID THE USPTO APPROVE THIS APP?**

A: Benefits are illegal!!!

B: No.

C: Yes.

D: Maybe.

THE CASE:

BENEFITS for “Electronic cigarettes...containing CBD derived from cannabis with a delta-8 THC concentration of not more than 0.3% on a dry weight basis”

- **RESULT?**

This application received a CSA Unlawful Use Refusal.

- **WHY?**

“THC, Delta-8 THC, Delta-9 THC, dronabinol and others” are all listed as Schedule I drugs.



12. \$125,000

PURCBD+ FOR “ANIMAL DIETARY FOOD SUPPLEMENTS...CONTAINING CBD DERIVED SOLELY FROM HEMP OR ...FLAX SEED AND ORANGE PEELS”

DID THE USPTO APPROVE THIS APP?

A: No.

B: Oranges and flax, yes;
CBD, no.

C: You can make CBD from
oranges???

D: Yes.

12. \$125,000

PURCBD+ FOR “ANIMAL DIETARY FOOD SUPPLEMENTS...CONTAINING CBD DERIVED SOLELY FROM HEMP OR ...FLAX SEED AND ORANGE PEELS”

DID THE USPTO APPROVE THIS APP?

A: No.

B: Oranges and flax, yes;
CBD, no.

C: You can make CBD from
oranges???

D: Yes.

THE CASE:

PURCBD+ for “Animal dietary food supplements...containing CBD derived solely from hemp or ...flax seed and orange peels”

- **RESULT?** Received an FDCA refusal.
- **WHY?**
 - Pursuant to the FDCA, it is unlawful to introduce food containing added CBD into interstate commerce or to market CBD as, or in, dietary supplements, regardless of whether the CBD is hemp-derived.



13. \$250,000

MUSHROOM INFUSION FOR “DIETARY SUPPLEMENTS”

DID THE USPTO APPROVE THIS APP?

A: No.

B: Not initially.

C: I thought this talk was about weed.

D: Yes.

13. \$250,000

**MUSHROOM INFUSION FOR “DIETARY
SUPPLEMENTS”**

DID THE USPTO APPROVE THIS APP?

A: No.

B: Not initially.

C: I thought this talk was
about weed.

D: Yes.



THE CASE: MUSHROOM INFUSION for “dietary supplements”

- **RESULT?** Received a Request for Information.
- **WHY?** Psilocybin is a Schedule I drug and federally unlawful.
- **RESPONSE**
 - Approved and registered once the goods were amended to state they didn't have psilocybin in them.



Recent Developments: Cannabis Parody Marks

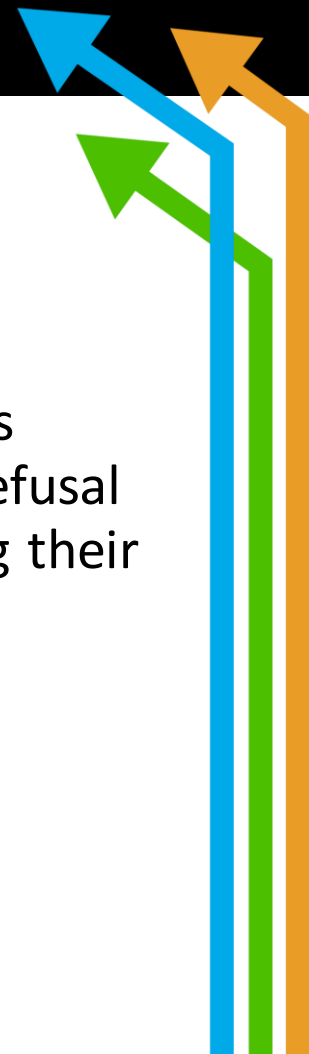
- Cannabis products and packaging which parody well known marks are likely committing trademark and trade dress infringement.
- *WM. Wrigley Jr. Company v. Roberto Conde, et al. (C.D. California 2022)*
 - Products labeled “Medicated Skittles” and “Medicated Cannaburst Gummies” were at issue.

****Parody is not a defense to trademark infringement in this situation.****



Breaking the Grass Ceiling: USPTO and Future Federal Legalization

- Post-2018 Farm Bill:
 - Applicants who applied for now lawful hemp goods/services before the first legal date of hemp could overcome a CSA refusal by amending their filing dates to 12/20/2018 and amending their identifications.
- It's likely that the USPTO would follow a similar approach post marijuana legalization.



Trademark Protection Recap

1. Miscellaneous Trademark Tips

- Include TM, SM, or [®] with your trademarks.
- Search a trademark before using it.
- Avoid trademarks that parody a famous brand's marks.

2. USPTO: You can avoid CSA and FDCA refusals by applying for:

- Non-ingestible and non-medicinal hemp goods (with legal definition).
- Paraphernalia specified to only be used with hemp (with legal definition).
- Informational, speech, or clothing type goods/services.

3. State Trademark Registrations:

- Can cover federally unlawful goods that are state legal.



Any Questions?

Thank you!



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