



# Cannabis Trademarks

SFIPLA 2018

# Trademark Protection

## ▶ Federal

"the fact that the provision of a product or service may be lawful within a state is irrelevant to the question of federal registration when it is unlawful under federal law." *In re Brown*, 119 USPQ2d 1350, 1351 (TTAB 2016) .

## ▶ State

Goods & Services can “touch the plant”

# Controlled Substances Act

- **Plant-Based Products**

- The Controlled Substances Act (CSA) prohibits, among other things, manufacturing, distributing, dispensing, or possessing certain controlled substances, including marijuana and marijuana-based preparations. 21 U.S.C. §§812, 841(a)(1), 844(a).

- **Marijuana Defined**

- “The term "marihuana" means all parts of the plant *Cannabis sativa* L., whether growing or not; the seeds thereof; the resin extracted from any part of such plant; and every compound, manufacture, salt, derivative, mixture, or preparation of such plant, its seeds or resin. Such term does not include the mature stalks of such plant, fiber produced from such stalks, oil or cake made from the seeds of such plant, any other compound, manufacture, salt, derivative, mixture, or preparation of such mature stalks (except the resin extracted therefrom), fiber, oil, or cake, or the sterilized seed of such plant which is incapable of germination.” 21 U.S.C. § 802(16)

- **Paraphernalia**

- In addition, the CSA makes it unlawful to sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia, *i.e.*, “any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under [the CSA].” 21 U.S.C. §863 (emphasis added)

# Goods & Services

## No registrations that violate the CSA

- Cannabis flower
- Cannabis Products
- Cannabis infused products
- Cultivation
- Dispensary
- Distribution
- Manufacturing
- Paraphernalia (primarily intended for cannabis)

# Acceptable Cannabis Goods & Services

## Free Speech

- **Advocacy**
- **Business consulting**
- **Educational**
- **Informational**



# Goods & Services

Also . . .

Federal Drug and Cosmetics Act (FDCA) prohibits sales of a “food” that contains a drug for which substantial clinical investigations have been instituted and made public.

And such investigation of cannabidiol have begun, therefore:

**No CBD Infused**



**Food**



**Dietary Supplements**



**Beverages**

# Cannabinoids

- **80 plus cannabinoids**

THC Psychoactive	CBD Non-psychoactive
Euphoria and relaxation Sleep and drowsiness Appetite stimulant Painkiller Anti-emetic Muscle relaxant	Anti-anxiety Neuroprotective Anticonvulsant Anti-psychotic Anti-tumoral Painkiller Anti-inflammatory

\*Aforementioned effects not generally recognized by the FDA

# Sources of Cannabinoids

*Cannabis sativa* L.

*C. sativa*

*C. indica*

*C. ruderalis* (aka Hemp)



# CBD

- **Regardless of the source, the USPTO takes the position that CBD does not naturally occur in the non-marijuana parts of the hemp plant, namely the mature stalks and seeds.**
- **Thus, CBD constitutes an illegal marijuana extract or derivative (according to the USPTO)**

# Trademark Selection

- **Distinctive**
- **Exclusive**
- **Cannabis-specific Considerations**

# Distinctive

## ■ Distinctive

### ■ Inherently Distinctive

- Fanciful: Igzactly, Nuvilex
- Arbitrary: Volcano<sup>®</sup>, Eden Labs<sup>®</sup>
- Suggestive: Twirling Hippy Confections, Goddess Delivers

### ■ Merely Descriptive with Acquired Distinctiveness

- Bhang<sup>®</sup>

## ■ Not Distinctive – Descriptive or Generic

- Slang: weed, marijuana, mary jane, pot, ganja, joint, smoke, high, bud, bong, canna, and MANY more
- Cannabis leaves
- 420
- Green

# Non-Registrable Marks

- **Merely descriptive (absent showing of acquired distinctiveness)**
- **Confusingly similar to mark(s) in issued registration or pending application**
- **Famous marks**
- **National Symbols**
- **False Connection with Person**
- **Geographical**
- **Varietal/Cultivar Names**

# Cannabis Considerations

## AVOID

### ▪ Attractive to Children

- Cartoons
- Designs, images, graphics, symbols, color scheme associated with children
- Celebrities, characters, or persons associated with children
- Words that refer to products commonly associated with children
- Imitation of candy packaging or labeling
- The term “candy” or “kandy”

*See:*

Cal. Bus. & Prof. Code § 26120; CDPH Regs. § 40410

OR Admin. Rules 845-025-7000

MD Code 10.62.24.01(C)(4)

Minn. Admin. Rules 4770.0850(C)



# Cannabis Considerations

## **AVOID**

- Incorporating strain names in products that are “attractive to children”

### **Oregon Banned:**

**Girl Scout Cookies**

**Grape Ape**

**CandyLand**

**Charlotte’s Webb**

**Cinderella**

**Bubblelicious**

**Smurf**

**Dr. Who**

**Bruce Banner**

**Death Star**

**Skywalker**

**Jedi Kush**

**LSD**

**Blow**

# Exclusive

- **Exclusive**
  - **Avoid infringement**
    - Registered & prior, pending applied-for marks
    - Common Law marks
    - “Famous” marks
  - **Avoid dilute and weak marks**
    - More use = Less protection
    - More use = Less distinguishable

# Clearance

- **Consider marks in their entirety**
- **Consider phonetic equivalents, plural forms, reversals of terms, variations**
- **Consider marks in connection with relevant goods or services**
- **There is no mechanical test for determining likelihood of confusion**
- **Be wary of aggressive trademark owners and famous marks**



# **Cannabis Comprehensive Clearance**

- **Evoke has worked with Corsearch to develop a tailored Comprehensive Search product**
  - **All cannabis (marijuana) products arguably related**
  - **Related non-cannabis marks**
  - **State registrations**
  - **Business & corporate names**
  - **Common Law resources**

# Protecting Strain Names

- **Varietal & cultivar names are not source indicators**
  - Rather, identify the type of plant
- **But can “brand” a varietal/cultivar**
  - Look at the horticultural industry

# Scientific Naming

- **Binomial Nomenclature**
  - A scientific name consisting of two or more Latin words
    - **First word:** The genus or group to which a plant belongs
    - **Second word:** The species name within the group
      - *Cannabis sativa* L.

# Horticultural Branding

- Apples

Varietal	Brand
Red delicious	STEMILT
Cripps Pink	PINK LADY
Fuji	RAINIER
Granny Smith	YUMMY

# Horticultural Branding

- **Other examples from the horticultural industry**
  - **DOLE<sup>®</sup> pineapple**
  - **WHITE ROSE<sup>®</sup> pears**
  - **STARBUCKS<sup>®</sup> coffee**
  - **PRAIRIE GOLD<sup>®</sup> wheat**
  - **SUN-MAID<sup>®</sup> raisins**



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