

CBD Is Still Not Free (To Register): An Update on Trademark Registration Guidelines for Cannabis Products

The United States Patent and Trademark Office (USPTO or Office) issued an examination guide on Friday, May 2, 2019, regarding the examination of trademarks for cannabis and cannabis-related goods and services after the enactment of the 2018 Farm Bill (Examination Guide). The Examination Guide answers some questions about how applications are going to be reviewed going forward and how current pending applications are going to be reviewed, but also opens up a whole host of additional questions and uncertainties.

The new guidelines may signal a trend towards allowing federal registration of CBD products, however, protection over the goods that really matter is still a ways away.

First, the Examination Guide reminds the public that CBD is only lawful if it comes from plants containing no more than 0.3 percent THC (i.e. hemp plants). Specifically, the Examination Guide provides that goods derived from hemp (i.e. containing less than 0.3 percent THC) are lawful in light of the Controlled Substance Act (CSA) and 2018 Farm Bill. However, if the goods meet the definition of “marijuana” (i.e. containing more than 0.3 percent THC), the goods will be refused as an unlawful use in commerce.

This means heightened scrutiny of applicants and applicants’ business at the examination stage. The USPTO is prepared to issue inquiries concerning applicants’ authorization to produce hemp and seek statements to confirm that their activities meet the requirements set forth in the 2018 Farm Bill with respect to the production of hemp. Think more Informational Requests from examining attorneys, requests for supplemental evidence of use of the mark in commerce, and additional submissions of product packaging and labeling. Also, clients’ own websites are either going to be their best friend or their worst enemy. That is the very first place examiners will look to see how applicants’ identified goods are obtained, extracted and processed so as to ensure they comply with the Federal regulations for the definition of hemp.

Next, the Examination Guide informs the public that federal trademark applications cannot contain a date of first use in commerce earlier than the date of enactment of the December 20, 2018 Farm Bill. For all applications filed prior to that time, the Applicant will be required to modify their filing date and date of first use to December 20, 2018. This is concerning as it is unclear how the Office will review applications now all having a December 20, 2018, filing date against each other for priority.

Furthermore, the Examination Guide provides that not all goods for CBD or hemp-derived products are lawful because they are still undergoing investigation by the FDCA. Foods, beverages, dietary supplements, or pet treats containing CBD will still be refused as unlawful under the FDCA even if derived from hemp, because such goods may not be introduced lawfully into interstate commerce. As such, the Examination Guide instructs the USPTO that, as a result of the FDA’s clinical trials on CBD, it is not allowed to register CBD marks used in connection with dietary supplements and food items (the biggest classes being 005 and 029). The peripheral classes (i.e. non-food/non-dietary products) likely can be registered (although they will likely be forced to modify the filing/date of first use to December 20, 2018).

Pending applicants have no choice but to sit tight on their federal rights, and will likely see more clearly how the new Examination Guide regulations will be applied once the Final Refusals roll in. While the Examination Guide does provide some much needed uniformity among the Office, review of pending applications remains unpredictable and subject to the discretion of the examining attorney assigned to the application. In this evolving industry’s journey from illicit to legal, applicants should continue to look to alternative means of protection, like state trademark



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registrations, particularly with respect to dietary supplements and food items to secure protection over CBD and CBD-related products.

Marijuana is still classified as a Schedule I controlled substance by the U.S. Drug Enforcement Agency, and as such, it remains a federal crime to grow, sell and/or use marijuana. Any content contained herein is not intended to provide legal advice to assist with violation of any state or federal law.
