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# Approaching 420: A Look at the Current Cannabis-Related Trademark Landscape a Year After the USPTO's Release of Examination Guidelines

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Products involving CBD and hemp seeds have been rapidly flooding the market in the United States, and businesses have sought and are seeking to protect their brands in connection with products in this emerging market, given the legalization of various forms of marijuana in individual states. Since the United States Patent and Trademark Office (USPTO) released its examination guidelines for examining trademark applications for cannabis and cannabis-related goods and services in May of 2019,<sup>1</sup> the legal landscape concerning the types of goods and services that businesses can obtain trademark protection for is constantly evolving. While the USPTO will not allow applicants to register federal trademarks for goods in “violation of federal law,” it does allow applicants to register trademarks for cannabis and cannabis-related goods and services if the use in commerce is lawful. This article takes an up-to-date look at the types of cannabis-related goods and services that can obtain trademark registration, and where they can be registered.

## What Can Be Registered Federally?

To determine what goods and services involving cannabis can be registered, the USPTO will analyze any federal trademark application to make sure that it is compliant with the Controlled Substances Act (CSA) and the 2018 Farm Bill. The 2018 Farm Bill removed “hemp” from the CSA’s definition of marijuana, which allows cannabis plants and derivatives, such as cannabidiol (“CBD”), that contain no more than 0.3% delta-9 tetrahydrocannabinol (THC) on a dry-weight basis to no longer be controlled substances under the CSA. If an application for goods related to cannabis or CBD concerns goods derived from “hemp,” the application could be granted if it specifies that the goods contain less than 0.3% THC, and if the goods and services are compliant with other federal laws, including the Federal Food, Drug, and Cosmetic Act (FDCA).<sup>2</sup> However, if the identified goods contain more than 0.3% THC, the application will be denied, as the goods identified violate federal law.

Currently, there are thousands of CBD- and THC-related applications pending with the USPTO involving various classes and goods. To date, the USPTO has granted registrations involving cannabis, and cannabis-related goods and services in multiple trademark classes, including, but not limited to, the following general types of goods/services<sup>3</sup>:

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<sup>1</sup> See United States Patent & Trademark Office, <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%201-19.pdf>.

<sup>2</sup> The U.S. Food and Drug Administration has released further guidelines and information concerning the FDA regulation of cannabis and cannabis-derived products, including cannabidiol (CBD). See U.S. Food & Drug Administration, <https://www.fda.gov/news-events/public-health-focus/fda-regulation-cannabis-and-cannabis-derived-products-including-cannabidiol-cbd#farmbill>. Per the FDA, even if goods meet the definition of “hemp” under the 2018 Farm Bill, they can still violate the law if marketed or sold to the public in ways that run afoul of the FDCA. Accordingly, applicants that attempt to register trademarks involving THC, or CBD involving dietary supplements, and food (including animal food), among other goods, violate federal law, and will not be federally registered at this time.

<sup>3</sup> The specific descriptions of goods and/or services in the trademark registrations specify that the goods/services are involved with delta-9 tetrahydrocannabinol (THC) concentration of not greater than 0.3% on a dry-weight basis.

Class	Goods
1	Fertilizer for cannabis and hemp markets; fertilizers; inoculants
3	Body oils; non-medicated toiletry preparations; moisturizing preparations for the skin; cosmetic preparations for skin care; soap; topical lotions; shower gel; shampoo; conditioner; non-medicated lip balm; massage oils; body scrub; bubble bath; make-up; lipstick; eyeshadow
4	Candles
5	Beauty creams, lotions, cleansers, oils, masks, serums, and gels containing cannabidiol (CBD); face oils; essential oils for personal use
11	Electric slow cooker for use in infusing oil
16	Packaging materials
21	Sealed container for household use having humidity-stabilization beads for maintaining humidity levels in smoking materials, namely, loose tobacco and dried herbs
22	Bags specially adapted for the extraction of herbs and essential oils
34	Cigarettes containing tobacco substitutes, not for medical purposes; hemp cigarettes composed of industrial hemp; electronic cigarette liquid (e-liquid) comprising flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges containing cannabidiol (CBD)
35	On-line retail store services featuring subscription boxes containing hemp-based clothing, among other products; on-line retail store services featuring smokers' articles; online retail department store services featuring in-store order pickup; retail store services featuring hemp-derived products, namely, non-medicated cosmetic skin care products in the nature of topical herbal extracts containing CBD derived from cannabis
39	Passenger transport
41	Hookah lounge services
43	Bar and cocktail lounge services
44	Farming services in the field of cannabis; providing a website featuring health information in the field of marijuana, and cannabis; massage therapy services involving the use and/or provision of products containing or derived from cannabis

Accordingly, if a trademark applicant's goods or services fall within the definition of "hemp" products containing less than 0.3% THC, and the goods/services are compliant with other federal laws, applicants should seek to file and register their trademarks if they are currently using them in commerce, or intend to use them in commerce, so that they may obtain federal protection and put others on constructive notice of their trademark rights.

### State-Specific Registration Considerations

Even if trademark applicants cannot obtain federal trademark registration for their desired cannabis-related goods and services, applicants may be able to obtain protection for their trademarks within certain states. Since 2012, various states have individually begun to legalize various forms of marijuana. Currently, 11 states (Alaska, California, Colorado, Illinois, Maine, Massachusetts, Michigan, Nevada, Oregon, Vermont, and Washington) and the District of Columbia have legalized recreational

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marijuana to some extent, while 22 states have legalized medical marijuana use to some extent. These states where various uses of marijuana are legal may provide trademark applicants the opportunity to register state trademark registrations for cannabis-related goods/services that are currently being rejected, or are likely to be rejected, by the USPTO.

For example, trademark registrations have been accepted by the California Secretary of State for such cannabis-related goods as “dry cannabis flower,” “cannabis wax,” “live cannabis flowers,” “live cannabis,” “dried marijuana,” “dried marijuana flowers,” and other “dried marijuana products.” Accordingly, if a cannabis-related good/service fails to meet the requirements to obtain federal trademark registration through the USPTO, applicants may still be able to register their trademark applications in various states, depending upon the individual state’s rules and regulations concerning cannabis-related goods and services.

## Registration of Cannabis-Related Trademarks Outside of the United States

Like the individual states mentioned above, various countries have different regulations and prohibitions concerning cannabis-related goods and services, and what trademarks, if any, can be registered. An example of one country where cannabis-related goods are registerable is Canada, which legalized recreational cannabis nationwide in 2018. As a result, the Canadian government allows trademark applicants to register goods and services related to recreational cannabis, like “cannabis,” “dried cannabis,” and “live cannabis plants,” among other goods.<sup>4</sup> Likewise, other countries, like Colombia and Mexico, permit cannabis-related trademark registrations to a certain extent.

## How to Safeguard Your Trademark Rights Going Forward

In light of the various legal frameworks for registering cannabis-related trademarks on the federal, state, and international levels, businesses and individuals who hope to obtain trademark protection for cannabis-related goods and services should file trademark applications for cannabis-related goods and services where registration is legally obtainable. That is, if an applicant is using a trademark in connection with goods or services that meet the definition of “hemp” within the 2018 Farm Bill, and meet the requirements of other relevant laws, the applicant should try to apply for federal trademark protection. Applicants should also try to apply for state trademark protection where federal trademark protection is not available for certain cannabis-based goods or services.

Where federal or state registration is not legally obtainable with regard to various goods or services, users may be able to obtain common-law rights to the trademarks if they are in use. In order to protect their rights, potential trademark applicants for cannabis-related goods should monitor USPTO guidelines related to federal applications of those products, and any applicable state trademark laws.

Venable’s Intellectual Property team is very familiar with helping companies navigating the current cannabis landscape. For more information, please contact Marci Ballard, Kristen Ruisi, or Maria Sinatra.

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<sup>4</sup> See Canadian Intellectual Property Office, <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wro4527.html>. Use of trademarks in Canada must also satisfy Canadian laws concerning the promotion of cannabis.