



# THINK FORWARD

## USPTO Issues Examination Guide on Trademark Applications for Cannabis and Cannabis-Related Goods and Services

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On May 2, 2019, the United States Patent and Trademark Office (“USPTO”) issued Examination Guide 1-19 (“Examination Guide”), which outlines the path to registration for trademark applications covering hemp-based goods and services. The issuance of the Examination Guide serves as a departure from the USPTO’s longstanding bar to the registration of cannabis-related marks, and signals the potential for further relaxation of the USPTO’s prohibition on federal registration of trademarks and service marks for cannabis and cannabis-related goods and services as state legalization of cannabis continues to crop up across the country.

To obtain federal registration for a mark, a mark’s use in commerce must be lawful under federal law. *See generally Trademark Manual of Examining Procedure §907.* The USPTO will not issue registrations for marks covering goods or services that violate federal law – even if such goods or services are legal at the state level. Despite the legalization of cannabis for medical use in 33 states and the legalization of cannabis for recreational use in 10 states, cannabis has been deemed illegal by the federal government under the Controlled Substances Act (“CSA”)<sup>[1]</sup>. Cannabis-related marks have therefore been ineligible for federal trademark registration.

On December 20, 2018, the Agricultural Improvement Act of 2018, better known as the 2018 Farm Bill, was signed into law. In relevant part, the 2018 Farm Bill removed “hemp<sup>[2]</sup>” from the CSA’s definition of marijuana, thus removing “hemp” from the list of controlled substances under the CSA and creating an avenue for federal registration of marks covering some goods and services derived from hemp. Now, marks covering certain hemp-derived goods and services with less than 0.3% tetrahydrocannabinol (“THC”)<sup>[3]</sup> may be eligible for federal registration. However, the USPTO will continue to refuse registration when the identified goods or services in an application involve cannabis that meets the definition of marijuana and encompass activities still prohibited under the CSA.

To assist in the prosecution of trademark applications for these newly registerable goods and services, the USPTO outlined the requirements an application must meet before it may be eligible for registration for hemp-derived goods and related services. First, the USPTO advises that only applications covering hemp-derived goods and services with less than 0.3% THC are registerable. Second, an application’s identification of goods for all goods derived from hemp must **explicitly** state that the hemp-derived goods contain less than 0.3% THC. Third, only applications for marks covering hemp-based products and related services filed **after** December 20, 2018 are eligible for federal registration. Any applications filed prior to December 20, 2018, must be amended or refiled<sup>[4]</sup>. Specifically, applicants must request the USPTO amend their filing date to December 20, 2018, or withdraw their application and submit a new one. Notably, the USPTO will also examine applications to register service marks for compliance with the CSA and the 2018 Farm Bill; and, as such, an application’s identification of services must also specify that the involved cannabis contains less than 0.3% THC on a dry weight basis. Moreover, there

are additional requirements for applications that include services involving the cultivation or production of hemp.

Restrictions still remain on the registrability of marks for hemp and hemp-derived goods. For example, applications to register marks covering hemp-derived foods, beverages, dietary supplements, or pet treats will still be refused as unlawful because the use of hemp in items for human or animal consumption has not yet been approved by the Food and Drug Administration (“FDA”)<sup>[5]</sup>.

While Examination Guide 1-19 signals the budding federal registrability of marks for certain hemp-derived goods and services, applicants should consider the stringent requirements placed on the same. Mark owners should think critically about whether their trademarks for cannabis and cannabis-related products and services are potentially eligible for federal protection, as we expect to see a significant influx of applications covering these types of offerings in the near future. Filing applications for eligible products and services now may help mark owners gain a foothold in what will likely be a competitive business field going forward.

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<sup>[1]</sup> Under the Controlled Substances Act the drug class “Marihuana” (also referred to as “cannabis” or “marijuana”) is defined as “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.” 21 U.S.C. §802(16). Cannabidiol (“CBD”), a chemical constituent of the marijuana plant is included in the Controlled Substances Act’s definition of “Marihuana.” *See id.*

<sup>[2]</sup> Hemp is defined as “the plant *Cannabis sativa* L., and any other part of that plant, including the seeds thereof and all derivatives, extracts, cannabinoids, isomers, acids, salts, and salts of isomers, whether growing or not, with a delta-9 tetrahydrocannabinol (“THC”) concentration of not more than 0.3% on a dry weight basis.” Agricultural Improvement Act §297A.

<sup>[3]</sup> THC is the main psychoactive ingredient of cannabis.

<sup>[4]</sup> The USPTO takes the position that any applications filed before December 20, 2018 lacked a valid basis to support registration at the time of filing because the applied-for goods violated federal law. *See Examination Guide 1-19: Examination of Marks for Cannabis and Cannabis Related Goods and Services after Enactment of the 2018 Farm Bill.*

<sup>[5]</sup> The 2018 Farm Bill specifies that the FDA retains its authority to regulate goods containing cannabis and cannabis-derived compounds, and the FDA has taken the position that cannabis infused items for human or animal consumption require the FDA’s approval before they may be sold to consumers. The FDA is conducting clinical investigations into the safety and efficacy of such products for human and animal consumption.