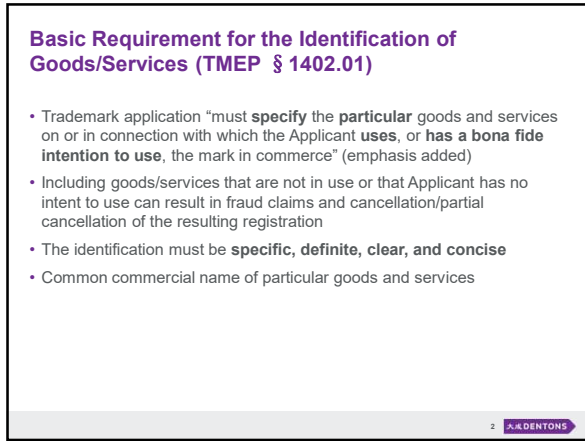
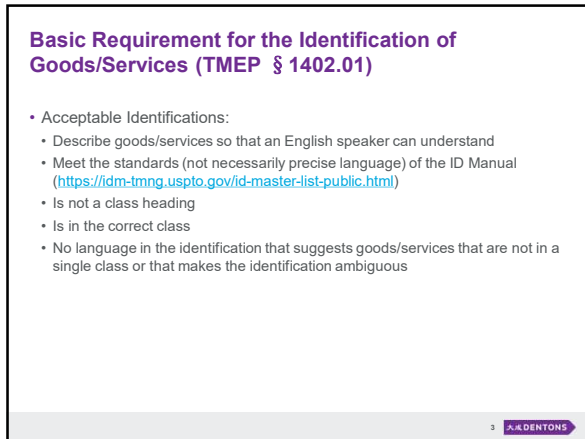




1



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3

Importance of Identification of Goods/Services

- Inaccuracies may prevent registration of trademark
- Applicant must prove use of mark on goods/services as identified in the application
- Do not choose goods/services from the ID Manual that are "close"; if your goods/services are not listed, draft your own
 - TEAS Plus Form: requires selection of goods/services from the ID Manual
 - TEAS Standard Form: allows for manual entry of goods/services

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Amending Goods/Services After Filing

- Limited ability to amend after filing: you may "clarify", "limit", or "narrow" the identification of goods/services but not "expand" or "broaden"
- Example:
 - Application ID: "clothing"
 - Acceptable Amendment: "clothing, namely, shirts, pants, shorts"
 - Unacceptable Amendment: "clothing, namely, shirts, pants, shorts; footwear"

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Classification of Goods/Services

- US utilizes the NICE Classification system: goods/services generally categorized into 45 different classes
- Classification is a Trademark Office function
- ID Manual provides some guidance, but don't sweat the classification -- focus on how the goods/services are described in the narrative

| class | Good Title |
|-----------------|---|
| GOODS | |
| 1 | Apparatus |
| 2 | Arms |
| 3 | Chemicals and cleaning preparations |
| 4 | Leather and furs |
| 5 | Pharmaceuticals |
| 6 | Wool goods |
| 7 | Metals |
| 8 | Hand tools |
| 9 | Electrical and scientific apparatus |
| 10 | Medical apparatus |
| 11 | Governmental control apparatus |
| 12 | Transport |
| 13 | Alcohol |
| 14 | Jewelry |
| 15 | Woolen yarns |
| 16 | Woolen yarns |
| 17 | Woolen goods and yarns made |
| 18 | Leather goods |
| 19 | Non-metallic building materials |
| 20 | Paints and varnishes otherwise classified |
| 21 | Household and glass |
| 22 | Clothing and furs |
| 23 | Fur and furs |
| 24 | Fur and furs |
| 25 | Textiles |
| 26 | Fur goods |
| 27 | Fur accessories |
| 28 | Toys and sporting goods |
| 29 | Meat and processed foods |
| 30 | Foodstuffs |
| 31 | Natural agricultural products |
| 32 | Spirit beverages |
| 33 | Wine and spirits |
| 34 | Tobacco and pipes |
| SERVICES | |
| 35 | Advertising and business |
| 36 | Insurance and finance |
| 37 | Building, construction and repair |
| 38 | Telecommunications |
| 39 | Transportation and storage |
| 40 | Treatment of materials |
| 41 | Education and entertainment |
| 42 | Computer and scientific |
| 43 | Hotels and restaurants |
| 44 | Medical, dental and agricultural |
| 45 | Personal and legal |

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6

Grammar and Punctuation

- semicolons are used to separate distinct categories of goods (e.g., shirts; footwear; belts)
- commas are used to separate lists of goods/services within a broader category (e.g., "clothing, namely, shirts, pants, shorts")

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Drafting Reminders

- Avoid indefinite words and phrases (e.g., including, comprising, such as, etc.)
- Proper punctuation (see previous)
- Do not use trademarks in the identification of goods/services (either those of Applicant or of a third-party)
 - Using the applied-for trademark (or parts of it) in the identification of goods/services could render the mark descriptive, or worse, generic
- Do not include goods/services that you do not sell to the public or provide to "others"
- Understand how the identification of goods/services affects the specimen requirements

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8

Special Considerations: Providing Services to Others

- Services are provided to third parties and the identification should not include services performed internally to support Applicant's business
 - "advertising and marketing services": only include when Applicant provides ad agency-type services; do NOT include for Applicant advertising its own goods/services
- For certain services, Trademark Office may require an amendment to the identification of goods/services to clarify that the services are being provided for the benefit of others.
- Generally, a good check on services is to include the phrase "to others" or "for the benefit of others" when determining whether Applicant actually provides the services (or has an intent to do so)

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Identification of Goods/Services & Specimens

- How goods/services are described determines the nature of specimens required to prove use
- Goods: specimen must show the mark "affixed" to the goods as they are transported or sold in commerce (e.g., labels, tags, packaging, etc., but not advertisements)
- Services: specimens must show the mark associated with some description/indication of the services and can include advertisements, websites, marketing literature
- If available, reviewing HOW Applicant uses the mark prior to drafting the identification of goods/services can save specimen headaches later!

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Identification of Goods/Services & Specimens

- Common Example: Software
 - "Downloadable software" is a good in Class 9 and requires a specimen showing the mark affixed to the goods (e.g., App store or a CD or a website with a "Download" button)
 - "Non-downloadable software" or "software as a service" is a service and classified into one of several classes based on the purpose of the software; specimens can include websites and advertisements

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Registering Trademarks for the Cannabis Industry

- For federal registration, Applicant's use of the trademark must be lawful use in interstate commerce
- Cannabis businesses run afoul of this requirement due to:
 - The Controlled Substances Act (CSA)
 - The Food, Drug, and Cosmetic Act (FDCA)
- US Trademark Office refuses trademark applications intended to be used in connection with cannabis-based products, cannabis paraphernalia, and services facilitating the distribution and sale of the above
- Even if the identification of goods/services is more general, not specifically identifying cannabis (e.g., brownies, chocolates, etc.), the Trademark Office may refuse registration if its research suggests the mark is intended for use on unlawful goods/services

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Definitions under the Controlled Substances Act (CSA)

- **Marijuana**
 - "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" (subject to certain exceptions). 21 U.S.C. § 802(16).
- **CBD**
 - Cannabidiol (CBD) is a chemical constituent of the cannabis plant that is encompassed within the CSA's definition of marijuana".
- **The CSA prohibits manufacturing, distributing, dispensing, or possessing certain controlled substances, including marijuana**
 - USPTO refuses registration of marks covering goods containing CBD or other marijuana extracts because such goods are unlawful under federal law

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Hemp Removed from Definition of Marijuana

- **What is Hemp?**
 - "the plant Cannabis sativa L. and any 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 percent on a dry weight basis."
- **2018 Farm Bill** (effective: December 20, 2018)
 - Removes hemp from the CSA's definition of marijuana - meaning that cannabis plants and derivatives including CBD that contain no more than **0.3% THC** on a dry-weight basis are no longer controlled substances under the CSA

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Effects of the 2018 Farm Bill for Applications Identifying CBD or Other Cannabis Products

- Applications filed **after** December 20, 2018
 - Potentially removes the CSA as a ground for refusal of registration but *only* if the goods are derived from hemp
 - Cannabis and CBD derived from marijuana still violate federal law - such applications will be refused registration
 - **PRACTICE TIP:** Identification of goods must specify that Applicant's hemp-goods contain less than 0.3% THC to be compliant with federal law

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Effects of the 2018 Farm Bill for Applications Identifying CBD or Other Cannabis Products (continued)

- Applications filed **before** December 20, 2018
- Registration will be refused due to unlawful use or lack of bona fide intent to use in lawful commerce under the CSA
- Applicant may amend filing date to December 20, 2018
- Applicant must amend description of goods to specify that the CBD or cannabis products contain less than 0.3% THC

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Food and Drug Administration (FDA)

- Not all hemp-derived products are lawful (even after the 2018 Farm Bill)
- 2018 Farm Bill explicitly preserved FDA's authority to regulate products containing cannabis or cannabis-derived compounds under the Federal Food, Drug, and Cosmetic Act (FDCA)
- Certain products may still violate the FDCA
 - Ingestible CBD Products
 - Applications for foods, beverages, dietary supplements, or pet foods containing CBD may be refused as unlawful, even if derived from hemp

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Applications for Cannabis Services

- Applications for services are also examined for compliance with the CSA and 2018 Farm Bill
- Services involving the cultivation or production of cannabis that is "hemp"
 - Examining Attorney will issue inquiries regarding Applicant's authorization to produce hemp
 - Applicant required to provide additional statements confirming compliance with 2018 Farm Bill

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Identification of Goods and Services Considerations

- Description of goods must specify that hemp-derived goods contain no more than 0.3 percent THC on a dry-weight basis
- Examples:
 - **KING OF HEMP** - Reg. No. 1513638; Filed: Dec. 20, 2018; Registered: Oct. 15, 2019
 - "Hemp cigarettes comprised of industrial hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not greater than 0.3 percent on a dry weight basis" in Class 34.
 - **CREATED BY DESIGN CBD** - Reg. No. 5975267; Filed Feb. 24, 2019; Registered: Feb. 4, 2020
 - "Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges all comprised of cannabidiol (CBD) derived from Cannabis sativa L with a delta-9 tetrahydrocannabinol (THC) content of no more than 0.3 percent on a dry weight basis" in Class 34.
 - **K KLOUT BOTANICALS & Design** - Reg. No. 5979765; Filed: May 10, 2019; Registered: Feb. 4, 2020
 - "Anti-aging cream; anti-wrinkle cream; aromatic oils; aromatic oils for the bath; aromatic preparations, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner; non-medicated lip balm; soap, body polish; body and foot scrub and non-medicated foot cream; body and beauty care cosmetics, body butter; body cream; body cream soap; body lotion; body milk; body scrub; body scrubs, cold cream; creamy foundation; cuticle cream; exfoliant creams; facial cream; hair shampoo; hair balsam; hair conditioner; hair conditioners; hair gels; hair mousse; lip balm; moisturizing body lotions; moisturizing creams; night cream; non-medicated herbal body care products, namely, body oils, salves, and lip balms; skin moisturizer; skin moisturizing gel; scented body lotions and creams; scented oils; skin cleansers; skin lotion; skin soap; skin softeners; skin toners; sunscreen cream; sunscreen creams; beauty creams for body care; foundation; oils for hair conditioning; skin care preparations, namely, body balm; all the foregoing goods containing CBD derived from hemp with a delta-9 THC concentration of not more than 0.3 percent on a dry weight basis" in Class 3.

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Preserving Rights for Cannabis-related Brands

- Alternatives to Federal Trademark Registration
 - **Common law usage**
 - **Copyright**
 - i.e. for a brand's logo
 - **State registrations**
 - State registration for cannabis trademarks where recreational use of cannabis is legal and in some states where medical use is permitted
 - State registration can preserve rights

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Preserving Rights for Cannabis-related Brands (continued)

- Option 1: Betting on a Change in Federal Law
 - *Example:* file ITU application for "plant seeds, dried flowers, natural plants and flowers, all of the foregoing being lawful under both state as well as federal law"
 - Registration will not issue until Applicant can show use (and if the goods are cannabis then Applicant cannot show use until federal law changes)
 - **Alternative Filing Options** (filing for lawful goods/services):
 - Providing informational services related to cannabis or marijuana-related goods and services.
 - Online journals, namely, blogs featuring information about cannabis.
 - Branded merchandise - shirts, hats, bags.
 - A company that sells edible CBD-related food products may elect to sell a spinoff non-CBD related food line.

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Brand Protection

- Brand protection is as important in the cannabis industry as much as any other industry
- In the evolving cannabis-industry, brand owners should obtain consider a variety of approaches to trademark protection now and not wait for federal law changes
- Cannabis-related brand owners should:
 - Enforce their trademark rights like any other brand owners;
 - Distinguish trademarks from surrounding text (i.e. different font or color, use of TM symbol); and
 - Monitor use of brand's trademark by third parties.

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Take-Aways

- Identification of goods and services must be clear, definite, and include the common commercial name
- Identification of goods and services affect the nature of specimens that must be provided for registration and maintenance
- Trademarks cannot be federally registered for goods and services that are unlawful under federal law
- Goods containing CBD or other marijuana extracts are unlawful under the Controlled Substances Act and/or FDCA and, thus, federal trademark applications listing these goods are
- Brand protection is extremely important in the cannabis industry; waiting for federal law to change to protect your trademark

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Thank you



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