

Practice Update

Trademark Protection and the Cannabis Sector

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Companies entering into the emerging market for medical and recreational marijuana products and services will face unique challenges when attempting to protect trademarks. Such challenges include brand protection in states where such products are legal and navigating the trademark application process before the United States Patent and Trademark Office (USPTO).

Currently, both medical and recreational marijuana products violate the Federal Controlled Substances Act. Because of such prohibition, companies in the business of selling such products and services are inquiring about how to protect their investments in their valuable intellectual property. In that regard, we recommend clients contact counsel for:

- State and federal trademark clearance searches to determine whether or not the proposed trademark is available for use and/or registration;
- Securing registered trademark protections in states where the sale of such products is legal;
- Devising a strategy in which to seek registered trademark protection before the USPTO. Such strategies include:
 1. Applying for trademark protection for ancillary products, such as clothing, rolling papers,

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pipes, and marijuana-themed magazines and websites;

2. Because of the recently passed Farm Bill (December 20, 2018), certain CBD products that are hemp derived are now legal products; thus applying for trademark protection for hemp infused products, such as lotions, creams, etc.
 3. Applying for trademark protection for the actual cannabis-infused products, such as vape pens, transdermal patches, creams, lotions, edibles, etc.
 4. Determining a timeline in applying for trademark protection for the marijuana and cannabis products themselves on an “intent-to-use” basis in the event such products become legal on the federal level within the next three-to-four years.
- Seeking copyright protection as an alternative route to protecting a logo or design mark.
 - Negotiating license agreements for the proprietary recipes, formulas, and other technology related to the medical marijuana products;
 - Drafting Non-Disclosure Agreements and Intellectual Property Ownership Statements;
 - Identification of technology that may be subject to patent and/or trade secret protection; and
 - Trademark monitoring, protection, and enforcement of trademarks (which includes domain name review, internet searches, and USPTO searches).

The current tension between federal and state laws regulating the distribution and sale of medical and recreational marijuana products and services has created uncertainty as to the best methods in which to protect such valuable intellectual property. Nonetheless, there are strategies that can be put in place to maximize protection of marijuana business trademarks and other intellectual property.

Disclaimer

Possessing, using, distributing, and/or selling marijuana or marijuana-based products is illegal under federal law, regardless of any state law that may decriminalize such activity under certain circumstances. Although federal enforcement policy may at times defer to states' laws and not enforce conflicting federal laws, interested businesses and individuals should be aware that compliance with state law in no way assures compliance with federal law, and there is a risk that conflicting federal laws may be enforced in the future. No legal advice we give is intended to provide any guidance or assistance in violating federal law.