

CANNABIS TRADEMARKS AND THE FIRST AMENDMENT

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I. INTRODUCTION

Trademark law has been a part of the United States’ legal landscape since the earliest days of the Republic, and common law trademarks predate it.¹ The Lanham Act,² the main body of trademark law, contains a provision banning “immoral” marks from receiving the protection that comes with registration through the United States Patent and Trademark Office (USPTO).³

The prohibition on immoral trademarks has been steadily eroding as a result of First Amendment litigation in the United States Supreme Court.⁴ In light of recent Supreme Court decisions on trademark registrations and free speech, the question then becomes: Is the ban on cannabis trademark registrations justifiable under the First Amendment in light of these recent cases?⁵ It is this author’s contention that the Supreme Court should also strike down the provision with regard to trademarks for cannabis.⁶

1. See *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 142–43 (2015) (“Trademark law has a long history, going back at least to Roman times.”). This Article will use “trademark” and “mark” to serve for trademarks and servicemarks generally.

2. 15 U.S.C. § 1051 (2018).

3. 15 U.S.C. § 1052(a) (2018).

4. See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019) (holding that the Lanham Act’s ban on “immoral” trademarks violates the First Amendment); *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (holding that the federal law prohibiting disparaging trademarks violates the First Amendment).

5. *Iancu*, 139 S. Ct. at 2297; *Tam*, 137 S. Ct. at 1751.

6. The use of the term “cannabis” instead of “marijuana” is a purposeful choice: it deals with the plant with and without the THC (delta-9 tetrahydrocannabinol) and CBD (cannabidiol) components, it is

This is a review of Supreme Court trademark litigation interpreting the First Amendment as well as recent trademark litigation at the state and federal levels. Finally discussed is the issue of whether the USPTO should or will issue registrations in light of this recent line of cases.

II. CANNABIS UNDER FEDERAL LAW

The federal law on cannabis used to be relatively straightforward.⁷ It was illegal—full stop; so it could not be produced, sold, or consumed under any circumstances.⁸ Much has changed since then, but the basic status of the substance remains the same: It is illegal under federal law, but with more asterisks than before.⁹ The Controlled Substances Act, the Continuing Appropriations Acts, and the Agriculture Improvement Act of 2018 have changed the landscape for legal cannabis in the United States.¹⁰ Additionally, the Food and Drug Administration recently approved two drugs with tetrahydrocannabinol (THC) and cannabidiol (CBD) as active ingredients.¹¹

A. Controlled Substances Act

Although many states have legalized cannabis in various forms, cannabis consumption and production is still illegal under federal law. The statute is known as the Controlled Substances Act (CSA).¹² The conflict between federal and state law was largely settled by the Supreme Court's decision in *Gonzales v. Raich*.¹³ In *Raich*, the Supreme Court upheld the principle of federal supremacy and affirmed the federal government's right to regulate controlled substances upon Commerce Clause grounds.¹⁴

Raich upholds the general concept that although the “commerce” may be wholly intrastate—or as in *Wickard*,¹⁵ personal and noncommercial—Congress may still regulate the production and consumption of cannabis.¹⁶ “Congress had a rational basis for concluding that leaving home-consumed

the preferred term of the industry, and it avoids the linguistic issues associated with the criminalization of the substance. See *Marijuana vs Cannabis: Why Language Matters*, MARY MART (June 8, 2017), <https://www.marymart.com/marijuana-vs-cannabis/>.

7. See Scott C. Martin, *A Brief History of Marijuana Law in America*, TIME (Apr. 20, 2016), <http://time.com/4298038/marijuana-history-in-america/>.

8. See *id.*

9. See *id.*

10. See Agriculture Improvement Act of 2018, Pub. L. No. 155–334, 132 Stat. 4490 (codified as amended in scattered sections of 7 U.S.C.); Controlled Substances Act, 21 U.S.C. §§ 802, 812, 841 (2018); see Continuing Appropriations Act, 2018, Pub. L. No. 115–56, 131 Stat. 1139 (2018).

11. See discussion *infra* Part II.D (explaining how the FDA classifies THC and CBD).

12. 21 U.S.C. §§ 802, 812, 841.

13. *Gonzales v. Raich*, 545 U.S. 1, 29 (2005).

14. *Id.*

15. *Wickard v. Filburn*, 317 U.S. 111, 128–29 (1942).

16. *Raich*, 545 U.S. at 2.

marijuana outside federal control would similarly affect price and market conditions.”¹⁷

The *Wickard* decision challenged the price and production quotas of the New Deal Laws, in which a farmer growing for personal consumption was still subject to the federal regulations on agricultural products.¹⁸ *Raich* concludes that Congress’s power under the Commerce Clause also extends to personal growth and consumption of cannabis.¹⁹

B. Continuing Appropriations Acts

1. Rohrabacher–Farr Amendment

In light of the CSA, the question then becomes: If the substances are illegal and the Cole Memo²⁰ has been rescinded, then why are so many shops opening up and why do businesses feel comfortable with doing business openly? The answer is, in part, the Continuing Appropriations Acts.²¹

The text of the 2018 Act is titled the Consolidated Appropriations Act, 2018, but the relevant section is often referred to as the Rohrabacher–Farr Amendment²² and reads as follows:

None of the funds made available under this Act to the Department of Justice may be used, with respect to any of the States of Alabama, Alaska, Arizona, Arkansas, California, Colorado, Connecticut, Delaware, Florida, Georgia, Hawaii, Illinois, Indiana, Iowa, Kentucky, Louisiana, Maine, Maryland, Massachusetts, Michigan, Minnesota, Mississippi, Missouri, Montana, Nevada, New Hampshire, New Jersey, New Mexico, New York, North Carolina, North Dakota, Ohio, Oklahoma, Oregon, Pennsylvania, Rhode Island, South Carolina, Tennessee, Texas, Utah, Vermont, Virginia, Washington, West Virginia, Wisconsin, and Wyoming, or with respect to the District of Columbia, Guam, or Puerto Rico, to prevent any of them from implementing their own laws that authorize the use, distribution, possession, or cultivation of medical marijuana.²³

17. *Id.* at 19.

18. *Id.*; *Wickard*, 317 U.S. at 128.

19. *Raich*, 545 U.S. at 32–33.

20. Memorandum from James M. Cole, Deputy Attorney Gen. to All U.S. Attorneys (Aug. 29, 2013), <https://www.justice.gov/iso/opa/resources/3052013829132756857467.pdf>. Better known as the “Cole Memo.” See Lisa Rough, *The Cole Memo: What Is It and What Does It Mean?*, LEAFLY (Sept. 14, 2017), <http://www.leafly.com/news/cannabis-101/what-is-the-cole-memo>. The Cole Memorandum delineated the prosecutorial priorities of the Obama Administration and stated that prosecuting state-legal dispensaries was not a priority. See *id.*

21. Continuing Appropriations Act, 2018, Pub. L. No. 115–56, 131 Stat. 1139 (2018).

22. *Rohrabacher–Farr Amendment*, WIKIPEDIA, https://en.wikipedia.org/wiki/Rohrabacher–Farr_amendment (last updated Jan. 4, 2020, 10:00 PM).

23. Consolidated Appropriations Act, 2018, Pub. L. No. 115–141, § 538, 132 Stat. 348, 444–45 (2018).

The amendment prohibits the Department of Justice (DOJ) from using federal funds to interfere with states implementing their own medical marijuana laws.²⁴ It does not apply to recreational or adult use of cannabis, and it does not define what “implementing” means.²⁵ That interpretation was left to the courts.²⁶

To date, this provision has been included in subsequent appropriation acts, updated with the language: “medical marijuana states.”²⁷ Notably, this has no actual effect on the CSA itself.²⁸ It only binds the DOJ with regard to medical marijuana states and those programs.²⁹

The legal status of cannabis under federal law is unchanged.³⁰ Cannabis is illegal under the CSA.³¹ This only prohibits the use of funds by the DOJ to interfere with the states’ medical marijuana programs.³²

2. United States v. McIntosh

This lack of clarity has caused a number of cases to arise around the country.³³ The most notable case is *United States v. McIntosh* from the Ninth Circuit.³⁴ As of the writing of this Article, *McIntosh* is the controlling case on the conflict between the state and federal laws regarding cannabis and the interpretation of the Continuing Appropriations Act in regard to federal enforcement.³⁵

In short, the court’s holding states that if the parties are in compliance with the state laws on medical marijuana, then they cannot be prosecuted for violations of the CSA.³⁶ Defendants that are charged with CSA violations are entitled to an evidentiary hearing as to whether or not they are in compliance with state laws.³⁷ This has no effect on the CSA itself, nor does it have any effect on state laws regarding recreational cannabis.³⁸

24. *Id.*

25. *Id.*

26. *See* *United States v. McIntosh*, 833 F.3d 1163, 1175–76 (9th Cir. 2016).

27. Consolidated Appropriations Act, 2018 § 538; Consolidated Appropriations Act, 2019, H.R. Res. 648, 116th Cong. § 537 (2019) (enacted).

28. Controlled Substances Act, 21 U.S.C. ch. 13 (2018); Consolidated Appropriations Act, 2018 § 538.

29. 21 U.S.C. ch. 13; Consolidated Appropriations Act, 2018 § 538.

30. Controlled Substances Act §§ 802, 812, 841.

31. *Id.*

32. *See* Consolidated Appropriations Act, 2018 § 538.

33. *See* *United States v. McIntosh*, 833 F.3d 1163, 1163 (9th Cir. 2016).

34. *Id.*

35. *Id.*; Robert L. Greenberg, *Medical Marijuana Post-McIntosh*, 20 CUNY L. REV. FOOTNOTE F.46 (2016) (providing further analysis of the Controlled Substances Act and *United States v. McIntosh*).

36. *McIntosh*, 833 F.3d at 1179.

37. Controlled Substances Act, 21 U.S.C. ch. 13 (2018); *McIntosh*, 833 F.3d at 1179.

38. 21 U.S.C. ch. 13; *McIntosh*, 833 F.3d at 1179.

C. Agriculture Improvement Act of 2018

The Agriculture Improvement Act of 2018 changes the way the government treats agricultural products derived from the cannabis plant.³⁹ After decades of an effective ban on the agricultural product grown by our Founding Fathers, hemp is now permitted to be grown again in the United States.⁴⁰

The THC-containing plant and the industrial hemp plant are the same plant.⁴¹ There is some controversy about whether there are several species of the same plant or different breeds of the same species, but it is agreed that both “hemp” and “marijuana” is of the same genus.⁴² The main difference between hemp and marijuana are in the THC content of the flowers produced by the plant.⁴³ Hemp has low levels of THC and is often utilized for its industrial and food purposes (e.g., paper and hemp seeds as a “superfood” protein source).⁴⁴ Marijuana has comparatively high levels of THC and is bred for the flowers or “buds” which are smoked, vaporized, processed into a concentrated form, or processed into an edible form.⁴⁵

However, different breeds of the plant have differing concentrations of THC, CBD, and other medicinal chemical compounds, which are generally referred to as cannabinoids.⁴⁶ The Agriculture Improvement Act of 2018 legalizes hemp with a concentration of THC that is less than 0.3% by dry weight.⁴⁷

39. Agriculture Improvement Act of 2018, Pub. L. No. 115–334, 132 Stat. 4490 (codified as amended in scattered sections of 7 U.S.C.).

40. See *Did George Washington Grow Hemp?*, GEORGE WASHINGTON’S MOUNT VERNON, <https://www.mountvernon.org/george-washington/facts/george-washington-grew-hemp> (last visited Mar. 22, 2020); *Hemp*, MONTICELLO, <https://www.monticello.org/site/research-and-collections/hemp> (last visited Mar. 22, 2020). Yes, both George Washington and Thomas Jefferson grew hemp. *Id.*

41. See Nicole Gleichmann, *Hemp vs Marijuana: Is There a Difference?*, ANALYTICAL CANNABIS (Sept. 2, 2019), <https://www.analyticalcannabis.com/articles/hemp-vs-marijuana-is-there-a-difference-311880>.

42. *Id.*

43. *Id.*

44. See, e.g., Kentucky Hempsters, *Why Are Hemp Seeds Considered a ‘Superfood’?*, LEAFLY (Nov. 13, 2015), <https://www.leafly.com/news/lifestyle/why-are-hemp-seeds-considered-a-superfood> (“Many people call hemp a ‘superfood,’ and for good reason. All hemp foods begin with hemp seeds, which are unique because they contain many of the nutrients needed to maintain a healthy diet. With a nearly perfect balance of omega 3 to omega 6, plus iron, vitamin E, and all of the essential amino acids, hemp seeds are said to be the most nutritionally complete food source in the world.”).

45. See Agriculture Improvement Act of 2018, Pub. L. No. 115–334, 132 Stat. 4490 (codified as amended in scattered sections of 7 U.S.C.) Many sources available—online and offline—have conflicting and often inaccurate information. For purposes of this Article and for purposes of the laws and cases discussed herein, hemp and marijuana are the same plant. The Agriculture Improvement Act’s definition includes any plant that could be called hemp or marijuana (*sativa* or *indica*). *Id.*

46. See Gleichmann, *supra* note 41.

47. *Id.*

The term “hemp” means 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.⁴⁸

Notably, the definition of hemp does not contain any reference to CBD nor does it provide guidance on what can be done with legal hemp and any concentrated chemicals derived therefrom.⁴⁹ It is possible that one could isolate or concentrate the THC from the low-THC cannabis and ultimately end up with an end product with a very high concentration of THC, but the Agricultural Improvement Act gives no specific guidance on this.⁵⁰ The resulting chemical compound, however, would likely violate the concentrate prohibitions of the CSA.⁵¹

D. The Food and Drug Administration’s Opinion on THC & CBD

The Food and Drug Administration (FDA) classifies THC and CBD as drugs and not as dietary supplements.⁵² The FDA issued a statement in response to the Agriculture Improvement Act that clarifies its position on these cannabinoids:

Just as important for the FDA and our commitment to protect and promote the public health is what the law *didn’t* change: Congress explicitly preserved the agency’s current authority to regulate products containing cannabis or cannabis-derived compounds under the Federal Food, Drug, and Cosmetic Act (FD&C Act) and section 351 of the Public Health Service Act. In doing so, Congress recognized the agency’s important public health role with respect to all the products it regulates. This allows the FDA to continue enforcing the law to protect patients and the public while also providing potential regulatory pathways for products containing cannabis and cannabis-derived compounds.⁵³

48. Agricultural Marketing Act of 1946, 7 U.S.C. § 1639o (2018).

49. *Id.*

50. Controlled Substances Act, 21 U.S.C. ch. 13 (2018). Presumably, concentrations of THC derived from otherwise legal hemp products would still be illegal under the CSA. *Id.*

51. *Id.*

52. Federal Food, Drug, and Cosmetic Act, 21 U.S.C. §§ 301, 331, 333 (2018).

53. Press Release, Scott Gottlieb, M.D., Comm’r of Food and Drugs, Food and Drug Admin., Statement from FDA Comm’r Scott Gottlieb, M.D., on Signing of the Agric. Improvement Act and the Agency’s Regulation of Prods. Containing Cannabis and Cannabis-Derived Compounds (Dec. 20, 2018), <https://www.fda.gov/news-events/press-announcements/statement-fda-commissioner-scott-gottlieb-md-signing-agriculture-improvement-act-and-agencys>.

The FDA has asserted its role in regulating CBD- and THC-based products through its drug approval process.⁵⁴ The FDA-approved Epidiolex is a drug used for the treatment of seizures, in which CBD is the active ingredient.⁵⁵ Marinol and Syndros are the brand names of Dronabinol, also approved by the FDA, which is a THC-based drug that is prescribed for patients that have extreme nausea from diseases such as cancer or AIDS and for patients with anorexia.⁵⁶

The FDA treats CBD as an active ingredient in drugs and not as a dietary supplement:

[The FDA] treat[s] products containing cannabis or cannabis-derived compounds the same as any other FDA-regulated products — meaning they're subject to the same authorities and requirements as FDA-regulated products containing any other substance. This is true regardless of the source of the substance, including whether the substance is derived from a plant that is classified as hemp under the Agriculture Improvement Act. . . .

[The FDA will] take enforcement action needed to protect public health against companies illegally selling cannabis and cannabis-derived products that can put consumers at risk and are being marketed in violation of the FDA's authorities.⁵⁷

The proliferation of CBD-based products around the country make it appear to consumers as though they are legal dietary supplements, but in reality, these products are in violation of several federal laws, even after the passage of the Agriculture Improvement Act.⁵⁸

The changes of the Agriculture Improvement Act are many, but as the CSA is itself little changed, it would stand to reason that the USPTO would not change its stance on registration of cannabis-related trademarks.⁵⁹ However, when taken in combination with the recent line of cases before the Supreme Court, USPTO's position may be untenable.

54. Press Release, United States Food and Drug Admin., FDA Approves First Drug Comprised of an Active Ingredient Derived from Marijuana to Treat Rare, Severe Forms of Epilepsy (June 25, 2018), <https://www.fda.gov/news-events/press-announcements/fda-approves-first-drug-comprised-active-ingredient-derived-marijuana-treat-rare-severe-forms>.

55. *Id.*

56. See *Dronabinol (Rx)*, MEDSCAPE, <https://reference.medscape.com/drug/marinol-syndros-dronabinol-342047> (last visited Mar. 22, 2020); *Dronabinol*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Dronabinol> (last updated Apr. 24, 2020, 9:53 PM).

57. Press Release, Scott Gottlieb, M.D., *supra* note 53.

58. *Id.*

59. See *supra* Part I.A (discussing the CSA).

III. PROTECTION FOR CANNABIS TRADEMARKS UNDER CURRENT LAW

The goal of those seeking to register their trademarks is to protect their trade names against those who would seek to free ride on the goodwill established by the name. Trademarks come in three basic varieties: common law trademarks, state-registered trademarks, and (the gold standard) federally registered trademarks under the Lanham Act.⁶⁰

A. Common Law Trademarks

Trademarks do not need to be registered with the USPTO to receive protection from infringers and counterfeiters.⁶¹ There exist state trademarks and what are known as “common law trademarks.”⁶² While a full discussion of common law trademarks is beyond the scope of this Article, a brief discussion is appropriate.

Put simply, if a name is used in trade, that trademark receives some protection from others.⁶³ The example I typically give students is that if a business opens known as “Joe’s Diner,” a competitor cannot just open up across the street using the same name. It violates common law concepts of fair competition, consumer protection, and equitable conduct, and generally violates our notions of right and wrong.⁶⁴ Courts recognize that even without a registration, competitors cannot steal a trademark and a company’s goodwill for the purpose of deceiving the mark holder’s customers.⁶⁵

Upon researching, there have not been any instances of litigation involving cannabis common law trademarks, but recently there was an instance of litigation involving state trademark registrations of cannabis businesses.⁶⁶

B. State Trademarks

Individual states often have their own trademark registration processes through their respective secretaries of state.⁶⁷ This process is generally simply one of registration, and there is no examination of the mark.⁶⁸ By contrast,

60. *State Trademark Registration in the United States*, INT’L TRADEMARK ASS’N (July, 2014) <http://www.inta.org/TrademarkBasics/FactSheets/Pages/StateTrademarkRegistrationsUSFactSheet.aspx> (last updated July 2014).

61. *Id.*

62. *Id.*

63. *Common Law Trademark*, MANDOUR & ASSOCIATES, <https://www.mandourlaw.com/common-law-trademark-rights/> (last visited Mar. 22, 2020).

64. *See id.*

65. *See What Is a Trademark*, LAW SHELF, <https://lawshelf.com/courseware/entry/what-is-a-trademark> (last visited Mar. 16, 2020) (providing a brief background on trademarks and trademark law).

66. *See infra* Part II.B.2 (discussing state trademark litigation).

67. *State Trademark Registration in the United States*, *supra* note 60.

68. Joe Stone, *Why Have a State Trademark?*, CHRON, <https://smallbusiness.chron.com/state-tradem>

federal registration requires an examination before the USPTO will register the mark.⁶⁹ More and more states, however, are placing their trademark registries online to facilitate searches.⁷⁰ These registrations are intended for businesses that are conducting intrastate commerce, as opposed to interstate commerce.⁷¹ Such registrations would only provide protection within such a state.⁷² Limited protection may be available at common law by virtue of the use of the mark in commerce, even if the mark is not registered.⁷³

However, while many states have trademark searches, many do not. Many states, including New York, have business name searches and state registration for trademarks, but do not have state trademark searches easily accessible.⁷⁴

1. State Trademark Registration and Search

In contrast to states like New York, several of the states that have legalized cannabis maintain online databases of their trademark registrations. For example, Colorado, California, and Arizona maintain such online databases that are available to the public.⁷⁵

a. Colorado

Colorado was one of the first states to legalize medical and then recreational, adult-use cannabis.⁷⁶ As such, it maintains an extensive online database of its state-registered trademarks.⁷⁷

A search of “cannabis” shows 185 results, with 146 of them listed as effective.⁷⁸ A search of “Marijuana” provides ninety records, of which fifty-three are effective.⁷⁹ The oldest of the effective cannabis listings dates

ark-55478.html (last visited Mar. 16, 2020).

69. *Id.*

70. See *State Trademark Information Links*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks-getting-started/process-overview/state-trademark-information-links> (last visited Mar. 16, 2020).

71. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:1 (5th ed. 2017).

72. *Id.*

73. 5 MCCARTHY, *supra* note 71, § 27:2.

74. See, e.g., *Division of Corporations State Records & UCC*, N.Y. DEP'T ST., <https://www.dos.ny.gov/corps/index.html> (last visited Mar. 16, 2020).

75. *History of Marijuana on the Ballot*, BALLOTPEdia, https://ballotpedia.org/History_of_marijuana_on_the_ballot (last visited Mar. 16, 2020).

76. *Id.*

77. *Trademark Advanced Search*, COLO. SECRETARY ST., <https://www.sos.state.co.us/biz/AdvancedTrademarkSearchCriteria.do> (last visited Mar. 16, 2020).

78. *Id.*

79. *Id.*

to a 2012 registration for a cannabis-related ministry that utilizes the mark “Cannabis Revival.”⁸⁰

b. California

California, too, has a trademark search available, and the first litigation relating to state trademarks comes from the State of California, as discussed in the next section.⁸¹

California maintains its own database, separate from that of other states and the USPTO.⁸² These state databases contain the relevant registration information including the status of the state trademark registrations.

2. State Trademark Litigation

The first lawsuit of which this author is aware is one that involves a dispute over state trademark registrations for cannabis businesses and it was filed in California in December 2018.⁸³ *Harvest on Geary, Inc. v. Harvest of Napa, Inc.*, was filed in California Superior Court for San Francisco County.⁸⁴ Both companies claimed the use of the mark “HARVEST” related to a cannabis dispensary business.⁸⁵

Harvest involved two companies: an Arizona cannabis company and a California cannabis company; the Arizona company looked to expand its business into California.⁸⁶ The California-based Harvest sued the Arizona-based Harvest for violations of its California trademarks and its trademarks at common law.⁸⁷

80. *Summary*, COLO. SECRETARY ST., <https://www.sos.state.co.us/biz/TradeMarkDetail.do?quitBut tonDestination=AdvancedTrademarkSearchResults&masterFileId=20121468861> (last visited Mar. 16, 2020).

81. *California Trademark Search*, CAL. SECRETARY ST., <https://tmbizfile.sos.ca.gov/Search> (last visited Mar. 16, 2020).

82. *Id.*

83. Complaint for Trademark Infringement and Unfair Competition at 4, *Harvest on Geary, Inc. v. Harvest of Napa, Inc.*, No. CGC-18-571773 (Cal. App. Dep’t Super. Ct. Dec. 3, 2018) [hereinafter Plaintiff’s Complaint].

84. *Id.* at 6.

85. *Id.* at 7.

86. *See id.*; Memorandum of Points and Authorities in Support of Defendants’ Motion to Dismiss at 2, *Harvest on Geary, Inc. v. Harvest of Napa, Inc.*, No. CGC-18-751773 (Cal. App. Dep’t Super. Ct. Jan. 22, 2019) [hereinafter Defendants’ Motion to Dismiss].

There is already a lawsuit pending in Arizona which involves the same relevant parties and the same legal issues, namely the ownership, priority, and use of the HARVEST name, trademarks, and service marks. The claims made by Plaintiffs in the instant case should have been asserted in the lawsuit which has been pending in Arizona since September 2017.
Id. The motion to dismiss filed by defendants in this case refers to an ongoing case in Arizona, but does not give a case name, number, *etc.* The author was unable to find the Arizona case.

87. First Amended Complaint for Trademark Infringement and Unfair Competition at 2, *Harvest on Geary, Inc. v. Harvest of Napa, Inc.*, No. CGC-18-751773 (Cal. App. Dep’t Super. Ct. Jan. 22, 2019) [hereinafter First Amended Complaint].

Both companies are using the trade name of “Harvest,” and use similar trademarks.⁸⁸ Defendants filed a motion to dismiss in January of 2019, but no decision has been issued as of this writing.⁸⁹

The issue is one of interest as it involves state trademarks in an instance of interstate commerce. That is, while cannabis businesses that are legal under state laws must be wholly contained in the state, companies can have two separate entities and do business (excluding cannabis business) on an interstate basis.

In this instance, the two Harvest entities both tried to claim the name as a trademark for the cannabis business within the State of California.⁹⁰ Both Harvests looked to expand their respective businesses within California, but only one could realistically do business under that trade name.⁹¹ The issue of who can rightfully claim the name will necessarily have an impact on businesses throughout the United States.

Such issues arise when companies that are using the same or similar marks in different states cause conflict. In the absence of a federal trademark registration scheme, this kind of litigation will become more and more of an issue, further clogging up the courts.

The interstate trademark issue looks like the exact kind of issue that federal registration under the Lanham Act was designed to limit.⁹² Whatever the outcome of this litigation, it is certainly the first of many to come. Under the current state-exclusive trademark regime, a less-than-scrupulous business could take the established trade name of a business in one state and copy its trademarks and open business in another state without worry.⁹³ The interstate nature of federal trademark registration is specifically designed to deal with these kinds of interstate issues, and the registration and prosecution scheme is designed to nip these problems—if you will pardon the expression—in the bud.

IV. UNITED STATES FEDERAL TRADEMARK LAW—LANHAM ACT

While trademarks for cannabis products are prohibited, a mark related to cannabis is not necessarily excluded from the USPTO trademark registration.⁹⁴ In this Section, I will discuss the United States federal

88. Chloe Veltman, *Competing Cannabis Companies Duke It Out for California Trademark Rights*, KQED (Mar. 1, 2019), <https://www.kqed.org/news/11729888/competing-cannabis-companies-duke-it-out-for-california-trademark-rights>.

89. Defendants’ Motion to Dismiss, *supra* note 86, at 1; *see also* Alison Malsbury, *The Battle Over the HARVEST Trademark for Cannabis Retail*, CANNA L. BLOG (Mar. 26, 2019), <https://www.cannalawblog.com/the-battle-over-the-harvest-trademark-for-cannabis-retail/> (providing further analysis of the suit).

90. *See* Plaintiff’s Complaint, *supra* note 83.

91. *See* Malsbury, *supra* note 89.

92. *See* Lanham Act, 15 U.S.C. ch. 22 (2018).

93. *See* MCCARTHY, *supra* note 71, at § 22:1.

94. *See In re Brown*, 119 U.S.P.Q.2d (BNA) 1350, 1351 (T.T.A.B. 2016).

trademark law, known as the Lanham Act,⁹⁵ and its application to various trademarks relating to, or evocative of, cannabis, cannabis usage, and advocacy in favor of legalization. Then, I will look at the recent line of United States Supreme Court cases and analyze the current status of cannabis trademarks in light of these decisions.

In terms of cannabis-related trademarks, some companies have gotten around the prohibition by instead filing for trademarks on lifestyle brands.⁹⁶ Trademarks for cannabis-related marks are not prohibited, but trademarks that are found to be immoral have been rejected by the USPTO.⁹⁷ Several of these immoral trademark rejections have been overturned by the United States Supreme Court, and are discussed in the next section.

A. Trademark Law Background

While the full history of trademarks and the policy behind them are beyond the scope of this Article, this Section will have a brief background on trademarks in order to illustrate both the exclusion of cannabis trademarks and why such an exclusion is impermissible.

All trademark registrations go through an examination by the United States Patent and Trademark Office, and the back-and-forth with the USPTO is referred to as prosecution, which is similar to the process of patent prosecution on the other side of the house.⁹⁸

Once the USPTO approves a trademark for registration, it is presumed to be valid and not confusing to consumers when compared to similar marks in a similar field.⁹⁹ That is, trademark registrations are generally tailored to the industry in which the petitioner is seeking registration.¹⁰⁰ With the exception of fanciful terms, for example, Verizon, Kodak, etc., registration is often limited to a particular industry or field. For example, Apple was limited to the computer and technology industry so that consumers would not confuse it with Apple Corps, the musical studio that produced The Beatles.¹⁰¹

Similarly, while confusion between the World Wildlife Foundation and the World Wrestling Federation seems unlikely, the latter WWF changed its

95. 15 U.S.C. §§ 1051–72.

96. See generally Emily Pyclik, *Obstacles to Obtaining and Enforcing Intellectual Property Rights in the Marijuana Industry*, 9 AM. U. INTELL. PROP. BRIEF 26 (2018).

97. See *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (refusing registration after determining trademark was immoral); *Matal v. Tam*, 137 S. Ct. 1744 (2017) (rejecting registration after determining the trademark was disparaging).

98. See, e.g., Cynthia M. Ho, *Splicing Morality and Patent Law: Issues Arising from Mixing Mice and Men*, 2 WASH. U. J.L. & POL'Y 247 (2000).

99. *In re Brown*, 119 U.S.P.Q.2d (BNA) at 1351.

100. See, e.g., PAN AM, Registration No. 4,941,545; PAN AM, Registration No. 3,171,134; PAN AM, Registration No. 3,171,135.

101. See *Apple Corps v Apple Computer*, WIKIPEDIA, https://en.wikipedia.org/wiki/Apple_Corps_v_Apple_Computer (last visited Mar. 16, 2020) (providing a brief summary of the trademark issues of Apple Computer and Apple Corps).

name to WWE to avoid issues with the former.¹⁰² During the name change, the wrestling company utilized the slogan “Get the F Out” although, there does not appear to be a trademark registration for that particular slogan.¹⁰³

B. “Immoral” Trademark Ban

In short, the Lanham Act explicitly prohibits registration of trademarks for cannabis.¹⁰⁴ The relevant section of the Act states that registration will be denied if the mark in question “[c]onsists of or comprises immoral, deceptive, or scandalous matter.”¹⁰⁵ Furthermore, the Trademark Trial and Appeal Board has rules stating that most registrations for marks are for legal products, and the USPTO will not reject a mark without good reason.¹⁰⁶

Generally, the USPTO presumes that an applicant’s use of a mark in commerce is lawful under federal law. Thus, registration generally will not be refused based on unlawful use in commerce unless “either (1) a violation of federal law is indicated by the application record or other evidence, such as when a court or a federal agency responsible for overseeing activity in which the applicant is involved, and which activity is relevant to its application, has issued a finding of noncompliance under the relevant statute or regulation, or (2) when the applicant’s application-relevant activities involve a *per se* violation of a federal law.”¹⁰⁷

“[I]t would be anomalous for the Patent and Trademark Office to accord recognition to the use of a mark when the use relied upon was unlawful. To cite an extreme example, it would be unthinkable to register a mark for use on heroin.”¹⁰⁸

In light of this, the issue of cannabis marks looks clear: the USPTO will not grant these marks. Cannabis remains a schedule I controlled substance under the CSA.¹⁰⁹ Therefore, the USPTO will not register a trademark that would provide protection for illegal drugs.

In light of recent Supreme Court litigation, that may no longer be the case.¹¹⁰ The issue of morality often comes down to an issue of viewpoint

102. See *WWE*, WIKIPEDIA, https://en.wikipedia.org/wiki/WWE#WWF_name_dispute (last updated Apr. 16, 2020).

103. *Id.*; see U.S. PATENT & TRADEMARK OFF., <https://www.uspto.org> (follow “Trademarks” hyperlink; then follow “Search (TESS)” hyperlink; then follow “Basic Word Mark Search” hyperlink; then search “Get the F Out”) (last visited Mar. 16, 2020).

104. *In re Brown*, 119 U.S.P.Q.2d (BNA) at 1351.

105. 15 U.S.C. § 1052(a) (2018).

106. See generally TBMP (3d ed. Rev. 2, June 2019).

107. TMEP § 907 (2018) (quoting *In re Brown*, 119 U.S.P.Q.2d (BNA) at 1351), [tme.uspto.gov/RDMS/TMEP/current#/TMEP-90061e1661.html](https://www.uspto.gov/RDMS/TMEP/current#/TMEP-90061e1661.html).

108. *Satinine Societa v. P.A.B. Produits*, 209 U.S.P.Q.2d (BNA) 964, 967 (T.T.A.B. 1981).

109. See discussion *supra* Part II.A (discussing the Controlled Substances Act).

110. See discussion *infra* Part V (analyzing recent trademark litigation).

neutrality. That is, in deciding what is an “immoral, deceptive, or scandalous matter,”¹¹¹ the USPTO is taking a viewpoint that violates the First Amendment’s Free Speech protections.

C. Non-Cannabis, Cannabis-Related Trademarks Evocative of Drug Use

The USPTO has allowed trademarks for products or services that are *evocative* of cannabis consumption and use. Trademarks that allude to consuming illegal products—but themselves are aimed to ostensibly legal products—have been permitted registration.¹¹² These are examples of products that are legal, but the products’ names evoke illegal substances.

1. Acapulco Gold

Acapulco Gold was one of the first brands in the field of cannabis.¹¹³ Just as in legal goods, illegal goods try to differentiate themselves by using trademarks to inform consumers of the quality and characteristics of the products they are purchasing.

Capitalizing on the notoriety of the cannabis brand, James Hepperle attempted to register the trademark Acapulco Gold for his business, which was a brand of suntan lotion.¹¹⁴

The Trademark Trial and Appeal Board held that:

While the notation “ACAPULCO GOLD” may be a synonym for marijuana, the question as to whether or not a term is scandalous or immoral within the meaning of Section 2(a) of the Statute must necessarily be considered in relationship to the goods in connection with which it is used. The goods in this case is suntan lotion, and, in our opinion, to the average purchaser of suntan lotion in the normal marketing milieu for such goods, the term “ACAPULCO GOLD” would suggest the resort city of Acapulco noted for its sunshine and other climatic attributes rather than marijuana.¹¹⁵

While the term *Acapulco Gold* was evocative of the infamous strain of cannabis at the same time, the Trademark Trial and Appeal Board (TTAB) determined that it could be registered as a trademark.¹¹⁶ However, The TTAB ultimately rejected the mark as possibly confusing in light of an Acapulco

111. 15 U.S.C. § 1052(a) (2018).

112. See *infra* Part V (identifying cases in which trademark registrations were permitted).

113. See, e.g., *Acapulco Gold*, WIKIPEDIA, https://en.wikipedia.org/wiki/Acapulco_Gold (last updated Feb. 21, 2020 6:27 PM); *Acapulco Gold*, LEAFLY, <https://www.leafly.com/strains/acapulco-gold> (last visited Mar. 16, 2020).

114. *In re Hepperle*, 175 U.S.P.Q. (BNA) 512 (T.T.A.B. 1972).

115. *Id.* at 512.

116. *Id.*

mark relating to lipstick and face powder.¹¹⁷ However, the precedent of allowing marks that may be perceived as alluding to or relating to scandalous activities has been largely set by this case.¹¹⁸

2. Plant Names

To oversimplify things a bit: plant names are not traditionally granted trademark registrations, as they are frequently considered to be the name of the item and not a descriptive, identifying mark.¹¹⁹ To give a similar example: Tylenol is a brand name, but the drug name itself, acetaminophen, would not receive a trademark registration as it is simply the name of the item, not the branding associated with it.¹²⁰

As such, plants are frequently denied protection, but with notable exceptions. The United States Court of Appeals for the Federal Circuit has given some guidance in one of its appeals:

We do not of course hold that an applicant is precluded from acquiring trademark protection for a particular variety of grass seed. If an applicant wishes to establish trademark protection for its variety of grass seed, it can do so by associating a particular brand name with its grass seed. However, having designated the term “Rebel” as the varietal name for grass seed and having failed to associate any additional word with the Rebel grass seed that would indicate the seed’s source, Applicant here is prohibited from acquiring trademark protection for the generic and only name of that variety of grass seed.¹²¹

The court here is making a clear distinction between the name of the product and the branding thereon.¹²² In short: the thing itself cannot be trademarked, but the branding may be. Put another way, a trademark is an adjective, not a noun, *e.g.*, the thing is a Xerox-brand copy machine and not a “Xerox.”

This situation may be contrasted with pharmaceutical products where a generic name is designated for a new pharmaceutical product and its manufacturer associates it with a brand name. For example, ibuprofen is the generic term designated for a particular nonsteroidal anti-inflammatory drug and ADVIL is a brand name indicating a source of the drug. Trademark

117. *Id.*

118. *See, e.g., In re McGinley*, 206 U.S.P.Q. (BNA) 753, 754 (T.T.A.B. 1979).

119. *Plant Names: Trademark vs Patent*, COURIER-J. (Jan. 16, 2015, 8:42 AM), <https://www.courier-journal.com/story/life/home-garden/2015/01/16/plant-name-trademark-vs-patent/21854139/> (discussing the difficulties of trademarking plant names).

120. *Id.* (using Advil and Band-Aid as an example).

121. *In re Pennington Seed, Inc.*, 466 F.3d 1053, 1058 (Fed. Cir. 2006).

122. *Id.*

protection does not inure to the generic name there and it does not do so here.¹²³

In separating the branding from the product, there can still be protection while allowing for the use of a generic term for the product.

The protection that may accrue to cannabis businesses is that their brands of products can be protected, even if there may be some issue regarding the sales of products relating to individual strains of the products, even if such products are proprietary to the business. The *In re Pennington Seed* example above is illustrative in this sense.¹²⁴

In *Pennington Seed*, the court differentiated between the name of the type of grass and a trademark that can be issued to the developing company for other products and services.¹²⁵ The development of registration for these companies can still carve out protection for its brands without necessarily covering material that is illegal under the CSA. Such a carve-out could work for these cannabis businesses, but I am unaware of any such test as of yet. However, cannabis-related businesses have registered trademarks for non-cannabis products.¹²⁶

D. Political Free Speech

The usage of cannabis-related terminology in trademarks has been long permitted with regards to political speech, both in favor of prohibition and for those advocating legalization and decriminalization.

I. NORML

Probably the best-known legalization advocacy group in the United States is the National Organization for the Reform of Marijuana Laws (NORML).¹²⁷ NORML has been advocating for legalization since 1970.¹²⁸ NORML has several live trademark registrations including Registration Number 0,997,137 (with a registration date of 1974) and Registration Numbers 5,817,875, 5,817,876, and 5,817,877 (with the newest registrations dating to 2019).¹²⁹

123. *Id.*

124. *Id.*

125. *Id.*

126. See discussion *infra* Part IV.E (providing examples of trademarks for non-cannabis products).

127. *Introduction*, NORML, <https://norml.org/about/intro> (last visited Mar. 16, 2020). In the interest of full disclosure, the author is a life-member of the NORML Legal Committee.

128. *Id.*

129. NORML, Registration No. 0,997,137; NORML, Registration No. 5,817,875; NORML, Registration No. 5,817,876; NORML, Registration No. 5,817,877.

2. Iowa State University NORML Chapter

The Iowa State University student club branch of NORML wanted to use the University's logo in addition to a picture of a cannabis leaf, but the University denied its request.¹³⁰ The United States Court of Appeals for the Eighth Circuit ruled in favor of the students, stating: "NORML ISU's use of the cannabis leaf does not violate ISU's trademark policies because the organization advocates for reform to marijuana laws, not the illegal use of marijuana."¹³¹ Therefore, advocacy for legislative change, specifically the legalization of cannabis, is not equivalent to the promotion of illegal activity.

E. "Lifestyle" Brands and Trademark "Laundering"

Cannabis businesses have been creative in seeking to protect their trademarks. Many businesses in the industry seek to differentiate the cannabis products from other products as part of a "lifestyle brand."¹³² This kind of trademark registration is sometimes referred to—derisively—as trademark "laundering."¹³³

Another option that marijuana businesses previously used to seek protection for their business names was pursuing protection for the use of their marks on different merchandise, like hats, t-shirts, coffee mugs, etc., in lieu of protection relating to the use of the marijuana product itself. Entities used this method as "trademark laundering", which initially starts with a trademark application for legal goods. The entity would get the mark approved for its legal goods, but then expand the goods or services attached to the mark by using it on additional goods and services not mentioned in the application. For example, a marijuana business may apply for a mark for their legal merchandise, but then, after obtaining registration, also use it on marijuana or marijuana paraphernalia.¹³⁴

Strictly speaking, USPTO-issued trademarks are strictly tailored to the product or service to which the mark attaches.¹³⁵ However, it is not

130. Gerlich v. Leath, 861 F.3d 697, 703 (8th Cir. 2017).

131. *Id.* at 710.

132. See Diana Novak Jones, *Pot Companies Need Creativity to Protect Their Brands*, LAW360 (Oct. 23, 2019, 11:56 AM), <https://www.law360.com/articles/120413/pot-companies-need-creativity-to-protect-their-brands>.

133. Claire Ballentine & Craig Giammona, *Weed from Well-Known Lifestyle Brands Is Next Stage of Legal Cannabis*, BLOOMBERG (Aug. 16, 2019, 3:00 AM), <https://www.bloomberg.com/news/articles/2019-08-16/weed-from-well-known-lifestyle-brands-is-next-stage-of-legal-cannabis>.

134. Pyclik, *supra* note 96, at 35 (footnote omitted).

135. See U.S. PATENT & TRADEMARK OFFICE, PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 3 (2020), <https://www.uspto.gov/sites/default/files/document/s/BasicFacts.pdf> (explaining the requirement of accurately describing goods and services).

uncommon for businesses—regardless of the type of business—to utilize their branding for other purposes.¹³⁶

One analogous example would be The Coca-Cola Company licensing its branding to makers of other products such as coolers, t-shirts, and other products that are not related to its core business of making soda and other soft drinks.¹³⁷ Similarly, Pan Am no longer exists as an airline, but its trademarks still hold value for placement on bags, t-shirts, etc.¹³⁸ There was even a Pan Am television show for a short time in 2012 even though the airline itself went out of business in 1991.¹³⁹

1. *Marley Natural*

Marley Natural is a brand of cannabis and cannabis-related products that capitalizes in large part on the notoriety and reputation of the musician, Bob Marley.¹⁴⁰ Bob Marley is also associated with the culture around cannabis consumption, specifically surrounding smoking, the island nation of Jamaica, and the relaxed culture of the Hippie Generation.¹⁴¹

Consumers flock to Bob Marley and his music and then they may purchase smoking accessories that relate to his image.¹⁴² The Marley Natural brand extends into other product lines as well.¹⁴³ Additionally, Marley Natural lends its name to cannabis products.¹⁴⁴ The trademarks are for smoking apparatuses and cosmetics, not for the cannabis herbs and concentrates, but the trademarks are still federally registered.¹⁴⁵

The USPTO permits registration of brands associated with all other products except those specifically relating to the cannabis plant or its usage.¹⁴⁶ Establishing a brand around these legal products helps to preclude other possible users from utilizing the brand for any product—legal or otherwise.

136. See Michael Stone, *How Will Smart Consumer Product Companies Manage Sustainability Risk, and Opportunity, When It Comes to Their Licensees?*, FORBES (Feb. 4, 2020, 3:39 PM), <https://www.forbes.com/sites/michaelstone/2020/02/04/how-will-smart-consumer-product-companies-manage-sustainability-risk-and-opportunity-when-it-comes-to-their-licensees/#8f212bf56a24>.

137. *Id.*

138. See PAN AM, Registration No. 4,941,545.

139. See *Pan American World Airways*, WIKIPEDIA, https://en.wikipedia.org/wiki/Pan_American_World_Airways (last updated Mar. 16, 2020); *Pan Am* (TV series), WIKIPEDIA, [https://en.wikipedia.org/wiki/Pan_Am_\(TV_series\)](https://en.wikipedia.org/wiki/Pan_Am_(TV_series)) (last updated Mar. 7, 2020).

140. MARLEY NATURAL, <https://www.marleynatural.com> (last visited Mar. 22, 2020).

141. *Bob Marley Biography*, BIOGRAPHY (Jan. 31, 2020), <https://www.biography.com/musician/bob-marley>.

142. MARLEY NATURAL, *supra* note 140.

143. *Id.*

144. See *Herb*, MARLEY NATURAL, <https://www.marleynatural.com/herb> (last visited Mar. 22, 2020).

145. MARLEY NATURAL, Registration No. 5,370,382; MARLEY NATURAL, Registration No. 5,370,383; MARLEY NATURAL, Registration No. 5,454,405.

146. TMEP § 907 (Oct. 2018).

2. Snoop Dogg

Snoop Dogg presumably needs no introduction, but nonetheless he is a rapper who is well known for his affinity for and use of cannabis.¹⁴⁷ Initially known as Snoop Doggy Dogg when he rose to stardom in the early 1990s, he has also been known as Snoop Lion, but he is still best known simply as Snoop Dogg.¹⁴⁸ All of those names, however, are registered as trademarks with the USPTO in his given name of Calvin Broadus.¹⁴⁹

Mr. Broadus recently began his own line of cannabis products, Leafy by Snoop.¹⁵⁰ There are several live trademark applications for this branding as well, but they are for “smoking accessories.”¹⁵¹

F. Hemp Trademarks

Since the passage of the Agricultural Improvement Act, the USPTO issued its own guidance on trademarks relating to hemp.¹⁵² In the guidance, dated May 2, 2019, the Office reiterated its position on trademarks relating to illegal substances: “The United States Patent and Trademark Office (USPTO) refuses to register marks for goods and/or services that show a clear violation of federal law, regardless of the legality of the activities under state law.”¹⁵³

However, the USPTO states: “For applications filed on or after December 20, 2018 that identify goods encompassing cannabis or CBD, the 2018 Farm Bill potentially removes the CSA as a ground for refusal of registration, but *only* if the goods are derived from ‘hemp.’”¹⁵⁴

147. *Snoop Dogg Biography*, BIOGRAPHY, <https://www.biography.com/musician/snoop-dogg> (last updated Oct. 24, 2019).

148. *Id.*

149. SNOOP DOGGY DOGG, Registration No. 2,278,013; SNOOP DOGG, Registration No. 2,697,128; SNOOP DOGG POUNDS SMOKING ACCESSORIES, Registration No. 5,978,488; SNOOP LION, Registration No. 4,889,807.

150. Merry Jane, *Leafy By Snoop Product Video*, YOUTUBE (Nov. 10, 2015), https://www.youtube.com/watch?v=rTcFL3npqDQ&feature=emb_title.

151. LEAF BY SNOOP, U.S. Trademark Application Serial No. 87/433,992 (filed May 2, 2017); LEAF BY SNOOP, U.S. Trademark Application Serial No. 87/433,983 (filed May 2, 2017); LBS, U.S. Trademark Application Serial No. 87/824,869 (filed Mar. 7, 2018); LBS, U.S. Trademark Application Serial No. 87/824,883 (filed Mar. 7, 2018).

152. *See* U.S. PATENT & TRADEMARK OFFICE, EXAMINATION GUIDE 1-19 EXAMINATION OF MARKS FOR CANNABIS AND CANNABIS-RELATED GOODS AND SERVICES AFTER ENACTMENT OF THE 2018 FARM BILL (2019), <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%201-19.pdf>.

153. *Id.* at 1.

154. *Id.*

G. Federally Registered Trademarks Used Against Cannabis-Related Businesses

Cannabis businesses cannot benefit from federal registration, but non-cannabis businesses that have had their federally registered trademarks infringed can utilize the federal judicial system to enforce their marks.¹⁵⁵ Trademark litigation against cannabis businesses has been going on for quite some time.¹⁵⁶ Litigation is often prohibitively expensive for small businesses and is often worse for cannabis businesses, which are confined to a single state.¹⁵⁷

I. UPS

United Parcel Service (UPS) is the package delivery service with which all Americans may be familiar.¹⁵⁸ Its large, brown trucks are a ubiquitous sight on our streets, and its no-longer-used slogan of “[w]hat can brown do for you” has become part of the American lexicon.¹⁵⁹

UPS has effectively used its protected trademark power against other service providers that have tried to utilize the good name of UPS for unrelated cannabis delivery systems.¹⁶⁰ On February 13, 2019, UPS filed suit against United Pot Smokers, UPS420, and others for using the name “UPS” in their businesses.¹⁶¹

UPS’s complaint alleged that the use of the defendants’ marks of UPS Green and UPS420, as well as the logo used by UPS420, infringe on UPS’s trademarks.¹⁶² UPS alleged: “Defendants’ unauthorized use of the famous UPS® Mark and UPS® Shield Logo is likely to cause confusion, mistake, or

155. See Susan Okin Goldsmith & Quincy Kayton, *Trademarks for a Budding Industry*, JDSUPRA (Sept. 20, 2019), <https://www.jdsupra.com/legalnews/trademarks-for-a-budding-industry-83206/>.

156. See, e.g., Alison Malsbury, *Cannabis Trademark Bullying: Be Prepared for Worst Case Scenario*, HARRIS BRICKEN: CANNA L. BLOG (June 2, 2019), <https://www.cannalawblog.com/cannabis-trademark-bullying-be-prepared-for-worst-case-scenario/>.

157. *Id.*

158. See UPS, <https://www.ups.com/us/en/Home.page?> (last visited Mar. 22, 2020).

159. See, e.g., Play Pause Video, *UPS-“What Can Brown Do for You?” Commercial (2001)*, YOUTUBE (Aug. 1, 2017), <https://www.youtube.com/watch?v=AQq-EurE-jA>.

160. Brian Flood, *UPS Sues Cannabis Delivery Companies for Trademark Infringement*, BLOOMBERG L. (Feb. 14, 2019, 9:49 AM), <https://news.bloomberglaw.com/ip-law/ups-sues-cannabis-delivery-companies-for-trademark-infringement>.

161. *Id.*; see Complaint for Trademark Infringement, Trademark Dilution, False Designation of Prigin, False Advertising, Unfair Business Practices, and Injunctive Relief at 1, United Parcel Serv., Inc. v. Brendon Kennedy *et al.*, No. 5:19-CV-00284 (C.D. Cal. 2019) [hereinafter UPS Complaint], <https://www.bloomberglaw.com/public/desktop/document/UnitedParcelServiceIncDelawareetalvKennedyetalDocketNo519cv00284C?1571766408>; see also Alison Malsbury, *UPS Sues Multiple Cannabis Delivery Companies for Trademark Infringement*, HARRIS BRICKEN: CANNA L. BLOG (Feb. 16, 2019), <https://www.cannalawblog.com/ups-sues-multiple-cannabis-delivery-companies-for-trademark-infringement/>.

162. See UPS Complaint, *supra* note 161, at 9–10.

deception as to the origin, source, and sponsorship of Defendants' products and services."¹⁶³ Additionally, UPS alleges that the defendants have acquired a poor reputation and thus have hurt the reputation of UPS itself.¹⁶⁴

Assuming, *arguendo*, that the allegations in the complaint are valid, then the case appears to be a classic case of trademark infringement. UPS is policing its trademarks in order to protect consumers against unscrupulous businesses looking to trade on the good reputation and goodwill of companies like UPS that provide quality products and services to consumers.

It appears that the defendants' websites, *upsgreen.com* and *ups420.com*, are no longer functioning.¹⁶⁵ The Internet Archive's Wayback Machine which periodically checks and archives sites has no new updates of *upsgreen.com* since November of 2018.¹⁶⁶ The other site, *ups420.com*, does not have any full captures, but there is no site title in its captures after late 2018.¹⁶⁷

2. Gorilla Glue

Gorilla Glue is a company that makes—appropriately enough—glue and other related products.¹⁶⁸ Its flagship Gorilla Glue is a registered trademark.¹⁶⁹ Gorilla Glue has been aggressive in protecting its mark as a cannabis strain of the same name became popular.¹⁷⁰ Much like the other examples given, Gorilla Glue is not in the cannabis business and does not want its registered trademarks used in commerce by unrelated businesses.¹⁷¹

163. *Id.* at 10.

164. *Id.* (“Defendants’ actions have injured and are likely to continue to injure UPS by creating a risk that consumers will wrongly or mistakenly associate UPS with Defendants’ reputation for unlawful and unprofessional conduct. Further, Defendants’ actions have injured and are likely to continue to injure UPS by tarnishing the famous UPS® Family of Marks.”).

165. *See generally* INTERNET ARCHIVE WAYBACK MACHINE, <https://web.archive.org/web/201811094241/http://upsgreen.com/> (last visited Mar. 22, 2020); INTERNET ARCHIVE WAYBACK MACHINE, https://web.archive.org/web/20190301000000*/http://ups420.com/ (last visited Mar. 22, 2020).

166. *See* INTERNET ARCHIVE WAYBACK MACHINE, <https://web.archive.org/web/20181109194241/http://upsgreen.com/> (last visited Mar. 22, 2020).

167. INTERNET ARCHIVE WAYBACK MACHINE, https://web.archive.org/web/20190301000000*/http://ups420.com/ (last visited Mar. 22, 2020).

168. *See* INCREDIBLY STRONG GORILLA GLUE 100% TOUGH, <https://www.gorillatough.com/products> (last visited Mar. 16, 2020).

169. GORILLA GLUE, Registration No. 2,449,800.

170. Alison Malsbury, *What NOT to Do with Your Cannabis Brand: The Gorilla Glue Trademark Infringement Dispute*, HARRIS BRICKEN: CANNA L. BLOG (Oct. 9, 2017), <https://www.cannalawblog.com/what-not-to-do-with-your-cannabis-brand-the-gorilla-glue-trademark-infringement-dispute/> (discussing the Gorilla Glue trademark dispute).

171. *Id.*

3. Girl Scout Cookies

Another cannabis strain that ran into trademark infringement is “Girl Scout Cookies.”¹⁷² Girl Scouts USA, the distributor of those addicting cookies as part of its fundraising efforts, sent cease and desist letters to a number of dispensaries to stop the dispensaries from using its trademarks.¹⁷³ In doing so, Girl Scouts USA is protecting its intellectual property and ensuring that its branding is only associated with its own products and of the quality of its cookies that consumers expect.¹⁷⁴ Various cannabis guides have also taken to referring to the strain as “GSC” instead of “Girl Scout Cookies” to avoid confusion between brands.¹⁷⁵

This kind of self-policing of brands is much of the *raison d'être* of trademark registration; it allows the trademark holders to police those who would free ride on the goodwill developed by the trademark holders. The beneficiaries are ultimately the consumers at-large.

V. RECENT TRADEMARK DECISIONS FROM THE SUPREME COURT AND THE TRADEMARK TRIAL AND APPEAL BOARD

Several recent cases from the United States Supreme Court regarding trademarks call into question the validity of the banning of trademark registrations under the Lanham Act.¹⁷⁶ These cases have involved the intersection of free speech under the First Amendment of the United States Constitution and the ban on immoral trademarks registration.¹⁷⁷ Two cases in particular, *Matal v. Tam* and *Iancu v. Brunetti*, involve the usage of terms that the USPTO rejected as demeaning and scatological, respectively.¹⁷⁸

In looking to these cases as well as a recent TTAB case, *In re PharmaCann LLC*, the analysis shows that the bar to registration is largely untenable on First Amendment grounds as not viewpoint neutral.¹⁷⁹ A fair analysis, however, will be given to a counterargument that has been presented in the concurrences and dissents in those Supreme Court cases.

There has been a steady weakening of the prohibition on immoral marks, and with the Court’s most recent decision, the existing prohibition on registration of cannabis marks is untenable.¹⁸⁰

172. Chloe Sommers, *The Girls Scouts to Dispensary: Disable Cookies*, MARIJUANA TIMES (Jan 14, 2017), <https://www.marijuanatimes.org/the-girls-scouts-to-dispensary-disable-cookies/>.

173. *Id.*

174. *Id.*

175. See, e.g., GSC, LEAFLY, <https://www.leafly.com/strains/gsc> (last visited Mar. 22, 2020).

176. See, e.g., *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017).

177. See *Brunetti*, 139 S. Ct. at 2297; *Tam*, 137 S. Ct. at 1748.

178. *Brunetti*, 139 S. Ct. at 2297–2302; *Tam*, 137 S. Ct. at 1748–65.

179. See *Brunetti*, 139 S. Ct. at 2297; *Tam*, 137 S. Ct. at 1748; *In re PharmaCann L.L.C.*, 123 U.S.P.Q.2d (BNA) 1122 (T.T.A.B. 2017).

180. *Brunetti*, 139 S. Ct. at 2302.

A. In re PharmaCann

Decided just two days before the decision in *Matal v. Tam*, the USPTO issued its decision in *In re PharmaCann* on June 16, 2017.¹⁸¹ This decision was about whether cannabis trademarks could be registered in the aftermath of *McIntosh*.¹⁸²

The USPTO's TTAB decision was based on the notion that despite the decision in *McIntosh*, the CSA is still in effect.¹⁸³ The CSA's provision that cannabis is a Schedule I controlled substance and thus has no medicinal value.¹⁸⁴ This provision is still federal law, and granting trademark protection for something illegal with no medical value would be against the Lanham Act.¹⁸⁵

The decision in *In re PharmaCann* came after *McIntosh*, but the TTAB held that cannabis products still comprise a violation of the CSA, and are thus ineligible for trademark registration.¹⁸⁶ In its decision, the TTAB said:

[F]or a mark to be eligible for federal registration, “any goods or services for which the mark is used must not be illegal under federal law” . . . [T]he identified goods or services with which the mark is intended to be used are illegal under federal law, “the applicant cannot use its mark in lawful commerce, and it is a legal impossibility for the applicant to have the requisite bona fide intent to use the mark.”¹⁸⁷

If the mark in question is one attached to a product or service that is used or can be used in commerce, registration should be permitted.¹⁸⁸

[R]egistration generally will not be refused based on unlawful use in commerce unless either (1) a violation of federal law is indicated by the application or other evidence, such as when a court or a federal agency responsible for overseeing activity in which the applicant is involved, and which activity is relevant to its application, has issued a finding of noncompliance under the relevant statute or regulation, or (2) when the applicant's application-related activities involve a *per se* violation of a federal law. These appeals involve claimed *per se* violations of the CSA based upon the final amended identifications of services in the applications,

181. *In re PharmaCann*, 123 U.S.P.Q.2d (BNA) at 1128.

182. *See supra* Part II.B.2 (discussing the holding in *McIntosh*).

183. *In re PharmaCann*, 2017 123 U.S.P.Q.2d (BNA) at 1128.

184. *Id.*

185. *Id.*

186. *Id.*

187. *Id.* at 1124 (citation omitted) (first quoting *In re Brown*, 119 U.S.P.Q.2d (BNA) 1350, 1351 (T.T.A.B. 2016); and then quoting *In re JJ206, L.L.C.*, 120 U.S.P.Q.2d (BNA) 1568, 1569 (T.T.A.B. 2016)).

188. *Id.*

“retail store services featuring medical marijuana” and “dispensing of pharmaceuticals featuring medical marijuana.”¹⁸⁹

The USPTO’s rejection of the mark is due to the *per se* violation of the CSA.¹⁹⁰ In the TTAB’s continued examination of the rejection of the mark on appeal, it specified that:

The Examining Attorney’s position on appeal is straightforward and may be summarized as follows: The CSA prohibits, among other things, manufacturing, distributing, or dispensing controlled substances. Marijuana is a Schedule I controlled substance under the CSA. As a result, “[t]he dissemination, distribution and delivery of marijuana is prohibited under all circumstances pursuant to the CSA. The applicant’s services consist of retail store services that feature the sale and distribution of medical marijuana and dispensing of pharmaceuticals featuring medical marijuana. These activities constitute a *per se* violation of the [CSA].”¹⁹¹

In short, so long as cannabis remains a Schedule I controlled substance, it will be considered illegal under federal law, and so no marks for cannabis itself will be granted protection from the USPTO.¹⁹²

Notably, a discussion of the lifestyle brand marks was absent in *In re PharmaCann*.¹⁹³ The logical question is: Would the TTAB have affirmed the rejection of the trademark registration if the applicant had described the services as separate or incidental to other uses of the mark? In other words: If PharmaCann was selling t-shirts, water pipes, and vaporizers, branded with its name and logo, would the mark still be rejected?

In its 2018 decision in *Shirley Plantation, L.L.C. v. Stillhouse Vineyards, L.L.C.*, TTAB found that it would not reject a mark without a good cause.¹⁹⁴

Accordingly, we will not sustain a claim of unlawful use unless either (1) a violation of federal law is indicated in the application record or other evidence, such as when a court or federal agency responsible for overseeing activity in which the applicant is involved . . . has issued a finding of noncompliance under the relevant statute or regulation or (2) when the

189. *Id.* (citation omitted) (first quoting *In re Brown*, 119 U.S.P.Q.2d at 1351; and then quoting *In re JJ206, L.L.C.*, 120 U.S.P.Q.2d at 1569).

190. *Id.* at 1127 n.14 (citing *In re Brown*, 119 U.S.P.Q.2d at 1352 n.11).

191. *Id.* at 1124 (citations omitted) (quoting 16 TTABVUE 7).

192. *See also* Republic Techs. (NA), L.L.C. v. BBK Tobacco & Foods, L.L.C., 262 F. Supp. 3d 605, 607–08 (N.D. Ill. 2017) (discussing of the validity of trademarks in an action between two manufacturers of rolling papers).

193. *In re PharmaCann*, 123 U.S.P.Q.2d (BNA) at 1123–28; *supra* notes 133–140 and accompanying text (discussing lifestyle brands and trademarks).

194. *See Shirley Plantation, L.L.C. v. Stillhouse Vineyards, L.L.C.*, 2018 TTAB LEXIS 483 (T.T.A.B. 2018). The TTAB stated that *Shirley Plantation* “is not a Precedent of the TTAB.” *Id.* at *1 (illustrating the USPTO’s analyses).

applicant's application-related activities involve a *per se* violation of a federal law.¹⁹⁵

The next question then becomes: Does the Agriculture Improvement Act affect the status of cannabis for purposes of the USPTO registration?¹⁹⁶ There is no clear guidance, but in light of the decisions above and the First Amendment analysis below, an educated guess can be made.

B. *Matal v. Tam*

Matal v. Tam was an appeal from a decision of the USPTO rejecting the registration of the mark "The Slants," a band name that was a play upon the racial epithet for Asians.¹⁹⁷ The Trademark office had rejected the mark as disparaging.¹⁹⁸ Tam then appealed the case to the Federal Circuit, and the Supreme Court subsequently granted certiorari.¹⁹⁹

The Supreme Court determined that:

The Lanham Act contains provisions that bar certain trademarks from the principal register. For example, a trademark cannot be registered if it is "merely descriptive or deceptively misdescriptive" of goods, or if it is so similar to an already registered trademark or trade name that it is "likely . . . to cause confusion, or to cause mistake, or to deceive."

At issue in this case is one such provision, which we will call "the disparagement clause." This provision prohibits the registration of a trademark "which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." This clause appeared in the original Lanham Act and has remained the same to this day.²⁰⁰

The Court then discussed what makes a trademark disparaging, and looks to the two-part test that trademark examiners apply when determining whether such terminology is disparaging:

When deciding whether a trademark is disparaging, an examiner at the PTO generally applies a "two-part test." The examiner first considers "the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services. If

195. *Id.* at *98 (quoting *In re Brown*, 119 U.S.P.Q.2d (BNA) 1350, 1351 (T.T.A.B 2016)).

196. *See supra* notes 39–51 and accompanying text (discussing the Agriculture Improvement Act of 2018).

197. *Matal v. Tam*, 137 S. Ct. 1744, 1747 (2017).

198. *Id.*

199. *Id.* at 1755.

200. *Id.* at 1753 (footnotes omitted) (citations omitted).

that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols,” the examiner moves to the second step, asking “whether that meaning may be disparaging to a substantial composite of the referenced group.” If the examiner finds that a “substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark . . . to be disparaging in the context of contemporary attitudes,” a prima facie case of disparagement is made out, and the burden shifts to the applicant to prove that the trademark is not disparaging. What is more, the PTO has specified that “[t]he fact that an applicant may be a member of that group or has good intentions underlying its use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable.”²⁰¹

The fact that the band “The Slants” only had good intentions in its usage of the term, and that the members wanted to eliminate much of the negative connotations associated with such language, was immaterial to the USPTO’s analysis in its rejection of the mark.²⁰²

In its analysis, the Court held that “[t]rademarks are private, not government, speech.”²⁰³ The First Amendment protections are limitations on the government’s ability to regulate private speech.²⁰⁴ The rejection or registration of a mark is not giving the imprimatur to any given trademark.²⁰⁵ To forbid registration that is disparaging would be overbroad.

A simple answer to this argument is that the disparagement clause is not “narrowly drawn” to drive out trademarks that support invidious discrimination. The clause reaches any trademark that disparages *any person, group, or institution*. It applies to trademarks like the following: “Down with racists,” “Down with sexists,” “Down with homophobes.” It is not an anti-discrimination clause; it is a happy-talk clause. In this way, it goes much further than is necessary to serve the interest asserted.²⁰⁶

The overbroad nature of the disparagement clause causes the USPTO to reject too many trademarks, and the fact that the speech is commercial when dealing with trademarks is immaterial.²⁰⁷

There is also a deeper problem with the argument that commercial speech may be cleansed of any expression likely to cause offense. The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech

201. *Id.* at 1753–54 (citations omitted).

202. *Id.* at 1754.

203. *Id.* at 1760.

204. *Id.* at 1759.

205. *Id.*

206. *Id.* at 1764–65.

207. *Id.* at 1765.

is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.

For these reasons, we hold that the disparagement clause violates the Free Speech Clause of the First Amendment.²⁰⁸

Free speech is enshrined in our Constitution.²⁰⁹ That, combined with the fact that a trademark registration is *not* a seal of governmental approval, but a way to ensure consumer protection, means that the restrictions on speech cannot be upheld.²¹⁰

C. *Iancu v. Brunetti*

A year later, on June 24, 2019, the Supreme Court issued its decision in *Iancu v. Brunetti*.²¹¹ That case dealt with the issue of registration of trademarks for an ostensible swear word, which would not receive registration under the Lanham Act, as it is scandalous and immoral.²¹² The mark in question was for the word “FUCTION.” In that case, FUCTION is an acronym for “Friends U Can’t Trust,” but would be pronounced like the swear word “fucked.” Given the risqué nature of the latter word, the USPTO denied registration.²¹³

Justice Kagan wrote the decision for the Court and held that the ban on registration of certain trademarks cannot be upheld in light of viewpoint neutrality.²¹⁴

1. *Viewpoint Neutrality*

Much of the discussion relates to the issue of viewpoint neutrality. When the USPTO takes a stand on which viewpoints are permissible and which are not, then the First Amendment is implicated. The Court’s analysis does, in part, touch upon the issue of cannabis:

The PTO rejected marks conveying approval of drug use (YOU CAN’T SPELL HEALTHCARE WITHOUT THC for pain-relief medication, MARIJUANA COLA and KO KANE for beverages) because it is scandalous to “inappropriately glamoriz[e] drug abuse.” But at the same time, the PTO registered marks with such sayings as D.A.R.E. TO RESIST DRUGS AND VIOLENCE and SAY NO TO DRUGS—REALITY IS THE

208. *Id.*

209. *Id.* at 1757.

210. *Id.* at 1765.

211. *See Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

212. *See Tam*, 137 S. Ct. at 1753.

213. *See Brunetti*, 139 S. Ct. at 2296.

214. *Id.*

BEST TRIP IN LIFE. Similarly, the PTO disapproved registration for the mark BONG HITS 4 JESUS because it “suggests that people should engage in an illegal activity [in connection with] worship” and because “Christians would be morally outraged by a statement that connects Jesus Christ with illegal drug use.”²¹⁵

In making a distinction between those advocating one side of an issue without allowing for registration for those on the other side of said issue is viewpoint discrimination or, at the very least, not viewpoint neutrality.

And the PTO refused to register trademarks associating religious references with products (AGNUS DEI for safes and MADONNA for wine) because they would be “offensive to most individuals of the Christian faith” and “shocking to the sense of propriety.” But once again, the PTO approved marks—PRAISE THE LORD for a game and JESUS DIED FOR YOU on clothing—whose message suggested religious faith rather than blasphemy or irreverence. Finally, the PTO rejected marks reflecting support for al-Qaeda (BABY AL QAEDA and AL-QAEDA on t-shirts) “because the bombing of civilians and other terrorist acts are shocking to the sense of decency and call out for condemnation.”²¹⁶

Offensiveness should not be a determining factor when determining what should and should not be permitted registration as it fails this neutrality test.

Yet it approved registration of a mark with the words WAR ON TERROR MEMORIAL. Of course, all these decisions are understandable. The rejected marks express opinions that are, at the least, offensive to many Americans. But as the Court made clear in *Tam*, a law disfavoring “ideas that offend” discriminates based on viewpoint, in violation of the First Amendment.

How, then, can the Government claim that the “immoral or scandalous” bar is viewpoint-neutral?²¹⁷

The Court held that the lack of viewpoint neutrality was key to its First Amendment analysis.²¹⁸ The “AL QAEDA” and “WAR ON TERROR MEMORIAL” examples above are illustrative of the larger argument.²¹⁹ That is, one is reprehensible (Al Qaeda) and one is not (the Memorial), but both are examples of speech. The First Amendment protects both forms of speech.²²⁰

215. *Id.* at 2300 (citations omitted).

216. *Id.* (citations omitted).

217. *Id.* at 2307 (citations omitted).

218. *See id.* at 2301–02 (discussing that the statute’s language of *immoral or scandalous* lacked viewpoint neutrality).

219. *See id.*

220. *See* U.S. CONST. amend. I.

The USPTO violated the First Amendment rights of those applying for registration by taking a view that some views were permissible and others not permissible.²²¹ The immoral or scandalous bar fails the test and thus could not be upheld.²²² The question then becomes: How does this affect the registration of trademarks relating to cannabis or other substances banned under the CSA?

2. Trademarks for Illegal Substances Not Addressed

The Court does *not* address the issue of whether illegal marks can be prohibited. The question of whether trademarks for substances that are still banned under the CSA is an open question that either the Supreme Court or a change in the legal status of cannabis will ultimately decide.

D. Lanham Act in Light of *Brunetti* and *Tam*

Brunetti and *Tam* widely expand the availability of federal trademark protection.²²³ The morality issue has been effectively determined to violate the First Amendment.²²⁴ For example, as a result of *Tam*, the trademarks for the Washington Redskins have been reinstated.²²⁵

The question then becomes whether or not this prohibition is overturned in its entirety or only the issue of morality/immorality. The question is: Can trademarks aimed at products or services that violate of federal law be registered? Or: Does the ban on illegal marks stand in light of *Brunetti* and *Tam*?

However, if the wording was changed—or interpreted differently—there is a possibility of this Section’s use against cannabis trademarks. Specifically, banning trademarks when used for illegal drugs could be ostensibly viewpoint neutral.

1. “Immoral or Scandalous”

Taken on its face, the *Brunetti* decision looks like it should lead directly to the legalization of cannabis-related trademark registration, but the partial concurrence and partial dissent of Chief Justice Roberts leaves some room to carve out the terms immoral and scandalous as separate:

221. *Brunetti*, 139 S. Ct. at 2301–02.

222. *Id.*

223. *See id.*; *Matal v. Tam*, 137 S. Ct. 1744, 1747 (2017).

224. *See Brunetti*, 139 S. Ct. at 2300-01.

225. WASHINGTON REDSKINS, Registration No. 5,377,352; WASHINGTON REDSKINS, Registration No. 978,824; WASHINGTON REDSKINS, Registration No. 986,668.

[T]he “scandalous” portion of the provision is susceptible of such a narrowing construction. Standing alone, the term “scandalous” need not be understood to reach marks that offend because of the ideas they convey; it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane. That is how the PTO now understands the term, in light of our decision in *Matal v. Tam*.²²⁶

When dealing with marks that may implicate the First Amendment, it suggests that the Court may make a distinction based upon the offensiveness of the language, which is different from the mode of expression. Chief Justice Roberts continues:

I also agree that, regardless of how exactly the trademark registration system is best conceived under our precedents—a question we left open in *Tam*—refusing registration to obscene, vulgar, or profane marks does not offend the First Amendment. Whether such marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods. No speech is being restricted; no one is being punished. The owners of such marks are merely denied certain additional benefits associated with federal trademark registration.²²⁷

The issue of whether the imprimatur of registration equates to approval is one that has been asked in other areas as well. For example, the state or federal government’s licensing of professionals does not necessarily equate to creating state actors out of all licensed professionals.²²⁸

A physician receives her license from the state department of education and a lawyer her admission to practice to the courts, but an incompetent doctor or lawyer does not create a civil rights violation on behalf of the state.²²⁹ While the government has an interest in only licensing competent professionals, the government is not issuing “seal[s] of approval.”²³⁰ Justice Roberts noted: “The Government, meanwhile, has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane. The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”²³¹

The question of whether one has a *right* to a registered trademark is not one specifically dealt with by either *Brunetti* or *Tam*. Justice Roberts’

226. *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring and dissenting).

227. *Id.*

228. *Moore v. Detroit Entm’t, L.L.C.*, 755 N.W.2d 686, 698 (Mich. Ct. App. 2018) (explaining that state licensure does not create a state actor of the professional).

229. *Id.*

230. Dick M. Carpenter et al, *To License or Not to License: A False Choice*, INST. FOR JUST., <https://ij.org/report/license-work-2/report/to-license-or-not-to-license-a-false-choice/> (last visited Mar. 22, 2020).

231. *Brunetti*, 139 S. Ct. at 2303–04 (Roberts, C.J., concurring).

concurrence is correct insofar as no one is being denied speech—that is, one can still do business and speak freely without a registered trademark—but it is denying a property right to those seeking to protect their businesses and (by extension) consumers at large.²³² Furthermore, this property right is inextricably linked to free speech rights.

To be sure, a reading of the majority opinion may lead to a different conclusion than this—namely that the USPTO picking and choosing which marks to which it will grant registration is at issue.²³³

2. Application of Viewpoint Neutrality to Other Industries

If the USPTO was granting or denying all marks relating to certain words or industries, it could be viewed as viewpoint neutral. In choosing between different sides of an issue, it fails the viewpoint neutrality test that Justice Alito’s opinion in *Tam* makes clear.²³⁴

The USPTO’s taking of a discriminatory viewpoint on morality and what constitutes a scandalous mark seem to be at odds with the Court’s majority decision and the logic underpinning it.²³⁵

The *Brunetti* decision opens up the door to many more registrations at the USPTO, but it appears that the Court may be allowing a carve-out that permits the USPTO to forbid those “additional benefits associated with federal trademark registration.”²³⁶

One such carve-out could well be that of substances that are illegal under the Controlled Substances Act. As seen in *In re PharmaCann*,²³⁷ the TTAB rejected the PharmaCann mark, even though the aspiring registrant was engaged in a business that was legal under state law and was free from the threat of prosecution per the Rorhabacher–Farr Amendment.²³⁸

The questions come down to this: is it immoral, scandalous, or obscene based upon its illegality, and is the anti-drug stance of the USPTO a violation of the viewpoint neutrality under the First Amendment? I believe that the USPTO’s stance on cannabis trademarks is untenable in light of *Tam* and *Brunetti*.

VI. CANNABIS TRADEMARKS SHOULD RECEIVE PROTECTION

The continued rejection of cannabis-related trademarks is a violation of an aspiring registrant’s First Amendment Rights. The rejection also hurts

232. *Id.*

233. *See id.* at 2300–01 (majority opinion).

234. *See supra* Section IV.B (discussing the Supreme Court case *Matal v. Tam*).

235. *See Brunetti*, 139 S. Ct. at 2300–01.

236. *Id.* at 2303 (Roberts, C.J., concurring).

237. *See supra* Section IV.A (discussing the *PharmaCann* case).

238. *See supra* Section I.B (discussing the Continuing Appropriations Acts).

consumers' ability to distinguish between products and service. The rejection also ignores the reality on the ground. First, many companies are simply claiming use of these marks at the USPTO as lifestyle brands. Secondly, state trademarks are routinely issued, and third, these products exist and the "knockoffs" are the likely culprit of the recent vaping deaths. Allowing companies to police the bad actors by granting the companies trademark registration can conceivably end—or at least lessen—this problem.

A. First Amendment

The continued banning of the trademarks relating to these products is a violation of the First Amendment. The ban can no longer stand, in light of these recent cases, as it is not viewpoint neutral. The USPTO policy that forbids these trademark registrations is a morality-based, non-viewpoint-neutral position taken by a government entity. Such policies are those very ones rejected by *Tam* and *Brunetti*.²³⁹

The fig leaf of lifestyle brand trademark registrations is a legal fiction—at best—or simply a lie that undermines our rule of law, which facilitates commerce and speech as guaranteed by the Constitution.²⁴⁰

Cannabis advocacy, products which can be ostensibly used for cannabis, other products, and anti-drug advertisements can all receive the benefits and protections of trademark registration.²⁴¹

Federal trademark registration is not giving any product or service the seal of approval by the federal government; it is merely an acknowledgment that a particular mark is used in commerce.²⁴² It is no different than the acknowledgment of a barber's completion of a course of study leading to a license. It is not the government giving a particular brand or product its approval.

To assert otherwise is to argue that the government approves of products like cigarettes, with products like Marlboro and Newport receiving trademark registration. Is the government asserting that sugary sodas like Coca-Cola or Pepsi are healthy for us to consume? Trademarks are to protect consumers and facilitate commerce, not for the government to make value judgments. When commerce between the states is the rule rather than the exception, the continued banning of the registration of such marks is untenable.

B. Consumer Protection

Consumers are protected when there is a trademark registration for products. The purpose of registration is to assure consumers as to the quality

239. See *Brunetti*, 139 S. Ct. at 2297 (majority opinion); *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

240. U.S. CONST. art. I, § 8; *id.* amend. I.

241. See *Brunetti*, 139 S. Ct. at 2303–04 (Roberts, C.J., concurring and dissenting).

242. *In re PharmaCann L.L.C.*, 123 U.S.P.Q2d (BNA) 1122, 1128 (T.T.A.B. 2017).

of the product or service that they are purchasing.²⁴³ To deny protection to these trademarks only encourages the health crises associated with “bootleg carts.”²⁴⁴

Knock-off goods and services regularly free ride on the goodwill of the proper trademark holders.²⁴⁵ Consumers receive protections from shoddy goods because trademark holders have an incentive to police their trademarks. Granting trademark registration would allow the legitimate vaporizer cartridge makers to police the black market and remove these dangerous devices from the market.

State trademarks are not sufficient to overcome the issue. As these cartridges often travel interstate and many of the labels and packaging comes from overseas, only a federal trademark would allow proper policing by those producing safer cartridges.

In order to protect consumers from illegal businesses free riding on the goodwill of those businesses doing business legally in other states and producing legitimate products, we should allow these companies to police the market and protect their trademarks and consumers.

The fact that consumers could be protected, with no additional cost to the government, and are not so protected, is a real national problem. Permitting the issuance of trademarks to the legitimate companies will allow them to police their trademarks outside of the state in which they reside. This would allow for the courts to step in and protect consumers from unscrupulous drug dealers poisoning their clients. Even without legalization of cannabis itself, permitting the trademark registration will make consumers safer, quite literally saving lives.

Put simply: trademark registration *will* save lives. It is no longer a valid position to stand on morality in the face of the First Amendment and the morality of eliminating this black market.

243. *Tam*, 137 S. Ct. at 1751 (2017).

244. See Cady Drell, *Cannabis Vape Companies Saw Bootlegs Coming—So Why Didn't Regulators*, ROLLING STONE (Oct. 4, 2019), <https://www.rollingstone.com/culture/culture-features/cannabis-vape-companies-bootleg-carts-regulators-893863/>. In this context, bootleg carts are THC-based vaporization cartridges that purport to be from a legitimate brand, when they are simply black-market products and do not have the quality, quality control, or safety guarantees of legitimate products. See David Downs et al., *Journey of a Tainted Vape Cartridge: From China's Labs to Your Lungs*, LEAFY (Sept. 24, 2019), <https://www.leafly.com/news/politics/vape-pen-injury-supply-chain-investigation-leafly>; Peter Eliopoulos, *DoH Commissioner: 'Just About All' NY Vaping Illnesses Are from Black Market THC Cartridges*, NEWS 10 (Oct. 15, 2019), <https://www.news10.com/news/doh-commissioner-just-about-all-ny-vaping-illnesses-are-from-black-market-thc-cartridges/>; Conor Ferguson et al., *Tests Show Bootleg Marijuana Vapes Tainted with Hydrogen Cyanide*, NBC NEWS (Sept. 27, 2019), <https://www.nbcnews.com/health/vaping/tests-show-bootleg-marijuana-vapes-tainted-hydrogen-cyanide-n1059356>; Neal Levine, *Don't Blame Legal Cannabis for the Vaping Health Crisis, Focus on Black Market THC*, USA TODAY (Nov. 6, 2019), <https://www.usatoday.com/story/opinion/2019/11/06/vaping-illness-death-focus-on-illicit-thc-not-legal-marijuana-column/2490361001/>.

245. See generally David Barnes, *Free Rides and Trademark Law's First Sale Rule*, 27 SANTA CLARA HIGH TECH. L.J. 457, 459 (2011).

C. Commerce Clause and the Laboratories of Democracy

The Court in *Gonzales v. Raich* determined the question of federal supremacy over the states, but the question when it comes to trademarks is not one of the CSA versus state laws; rather it is a question of the commerce clause and the idea of states as “[l]aborato[ries] of [d]emocracy.”²⁴⁶

While *Raich* does touch upon that particular idea in the dissent, the fact remains, in light of *United States v. McIntosh*, that the ban on trademark registration interferes with states’ ability to run businesses that do business between states and legally within these states.²⁴⁷

Ultimately the issue of federal supremacy was decided in *Raich*, but the argument is in many ways the opposite of that made by the petitioners there.²⁴⁸ In balancing the Commerce Clause, the federal Supremacy Clause, and the principle of the laboratories of democracy, the Court held that the CSA was in fact valid.²⁴⁹ However, herein the argument is that the federal government does have a role in regulating intellectual property, which is a power explicitly granted to the federal government in Article I of the Constitution.²⁵⁰

Instead, the argument is for a federal trademark scheme to (effectively) supersede that of the disparate states and their own respective trademarks schemes (*i.e.*, federal supremacy would solve this issue and refusal to do so pushes a federal issue onto the states).

Raich established the issue of federal supremacy with regard to the CSA, but the issue of state medical schemes has been largely left to the states for several years under the Continuing Appropriations Acts.²⁵¹ The laboratories of democracy are working as intended and in order to facilitate interstate commerce, as the *raison d’être* of the Commerce Clause and the nationwide power of the USPTO, trademarks should be granted to these businesses without the fig leaf of calling these companies lifestyle brands or some other legal fiction.

246. *Tenn. Wine & Spirit Retailers Ass’n v. Thomas*, 139 S. Ct. 2449, 2484 (2019) (Gorsuch, J., dissenting) (alteration in original) (quoting *New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J. dissenting)); *see Gonzales v. Raich*, 545 U.S. 1, 42 (2005) (O’Connor, J., dissenting); *United States v. Oakland Cannabis Buyers’ Coop.*, 532 U.S. 483, 502 (2001) (Stevens, J., concurring).

247. *See Raich*, 545 U.S. at 42 (2005) (O’Connor, J., dissenting); *United States v. McIntosh*, 833 F.3d 1163, 1163 (9th Cir. 2016).

248. *Raich*, 545 U.S. at 29 (majority opinion).

249. *Id.* at 9.

250. U.S. CONST. art. I, § 8, cl. 8.

251. *See supra* Section II.B (discussing the Continuing Appropriations Act).

D. Recognition of Reality

These marks exist, registrations or not. Companies around the nation produce products that consumers are purchasing day-in and day-out. The USPTO's stance on "immoral[ity]" is simply absurd.²⁵²

The other side of the house, the Patent Office at the USPTO, got rid of its own morality prohibitions years ago.²⁵³ Just as the issuance of a patent is not a governmental judgment as to efficacy or morality, a trademark is not a governmental approval of the product itself.²⁵⁴

Cases involving conflicting state trademark registrations, like that of the *Harvest* case discussed previously, demonstrate the need for an interstate solution.²⁵⁵ Federal registration will allow companies to police these bootlegs and take care of the issue with minimal taxpayer resources expended on the federal level.²⁵⁶

VII. CONCLUSION

The continued ban on cannabis-related trademarks cannot stand in view of the recent Supreme Court decisions on "immoral" trademarks.²⁵⁷ The First Amendment issues inherent in these decisions logically extend to the issue of cannabis. Furthermore, the public policy issues of consumer protection, fair competition, and a general recognition of the reality of cannabis's own legality demand that cannabis-related trademark registrations be issued by the USPTO. Ultimately these marks exist in commerce in the states; to deny registration is to deny reality. It is well past the time for the United States Patent & Trademark Office to issue federal trademark registrations for cannabis marks.

252. See TMEP § 1203.01 (Oct. 2018), <https://tmap.uspto.gov/RDMS/TMEP/Oct2012#/current/TMEP-1200d1e3054.html>.

253. See Margo A. Bagley, *Patent First, Ask Questions Later: Morality and Biotechnology in Patent Law*, 45 WM. & MARY L. REV. 469, 474 (2003) (explaining how morally dubious the patent granting process can be); see, e.g., Cynthia M. Ho, *Splicing Morality and Patent Law: Issues Arising from Mixing Mice and Men*, 2 WASH. U. J. L. & POL'Y 247, 249 (2000) ("Although courts once relied on 'moral utility' to deny patent protection for inventions used solely for gambling or fraud, no court has relied on this doctrine since the PTO Board of Appeals held that an invention used solely for gambling could be patentable in the 1977 decision of *Ex parte Murphy*.").

254. See Rian Goldstein, *Do You Need a Patent?*, IPWATCHDOG (Mar. 11, 2017), <https://www.ipwatchdog.com/2017/03/11/do-you-need-a-patent/id=79290/>.

255. See *supra* Part II.B.1 (explaining specific instances of conflicting state and federal trademark processes).

256. See *supra* Part V (discussing recent trademark decisions by the U.S. Supreme Court).

257. See TMEP § 1203.01 (Oct. 2018).