

# Tips for Registering Trademarks for Hemp-Derived Skin Care Products

A Lexis Practice Advisor® Article by Gerald E. Helget, Taft Stettinius & Hollister LLP



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This article provides tips on navigating certain aspects of the trademark registration process for marks covering hemp-derived skin care products. Specifically, it provides examples of additional information and documentation to submit if requested by the trademark examiner, sample written responses to commonly asked questions, a proper goods identification, and a declaration of legal compliance.

While this article focuses on trademarks for hemp-derived skin care products, the guidance can be broadly applied to any hemp-derived product or service except foods, beverages, dietary supplements, or pet treats, which remain unlawful under the Federal Food Drug and Cosmetic Act (FDCA). See 21 U.S.C. § 331(II). Anticipating the issues discussed in this article can help speed up the prosecution of relevant trademark applications.

## Background

Prior to December 20, 2018, skin care products that contained non-psychoactive, cannabis-derived ingredients from the hemp plant—such as cannabidiol (CBD), cannabigerol (CBG), and cannabidiolic acid (CBDA)—were unlawful under the federal Controlled Substances Act (CSA), 21 U.S.C. §§ 801–971. Consequently, applications for federal trademark registration for cannabis-derived skin care products from the hemp plant did not have a valid basis

because the goods were not in “lawful use in commerce.” For more on the lawful use requirement, see Gilson on Trademarks § 3.02[9].

However, on December 20, 2018, Congress passed the Agriculture Improvement Act of 2018, 115 Pub. L. No. 334, 132 Stat. 4490 (known as the Farm Bill). Among other things, the Farm Bill amended the CSA to remove hemp from the definition of marijuana and specifically excluded “tetrahydrocannabinols in hemp (as defined under section 297A of the Agricultural Marketing Act of 1946 [7 U.S.C. § 1639o])” from Schedule I. See 21 U.S.C. § 812(c). The U.S. Patent and Trademark Office (USPTO) also issued guidance on the examination of marks for cannabis and cannabis-related goods and services following enactment of the Farm Bill. See USPTO, [Examination Guide 1-19](#) (May 2, 2019); see also [Trademark Protection in the Cannabis Industry: New USPTO Guide for Hemp and CBD](#).

Following these changes, to the extent that skin care products derived from cannabis plants meet the current statutory definition of hemp, trademark applications for such goods are now considered lawful, and registrations may be obtained (if there are no other bars to registration). For guidance on potential bars to registration, see [Trademark Clearance Search Checklist](#). For guidance on the registration process, see [Trademark Examination Process](#).

Note, however, that even if certain goods are currently lawful under the CSA, not all goods for CBD or hemp-derived products are lawful following the Farm Bill. Specifically, the following products remain unlawful under the FDCA if they contain cannabis or cannabis-derived compounds:

- Foods
- Beverages

- Dietary supplements
- Pet treats

USPTO, [Examination Guide 1-19](#) (May 2, 2019).

## Additional Information and Documentation

Applicants seeking trademark registrations for hemp-derived products will likely be asked by the examiner to submit additional information about the goods, such as:

- Fact sheets
- Brochures
- Advertisements

If such materials are not available, the applicant must provide a detailed factual description of the goods, and any information submitted must clearly and accurately indicate the nature of the goods. Importantly, failure to comply with a request for additional information is grounds for refusing registration. See 37 C.F.R. § 2.61(b); 37 C.F.R. § 2.69; Trademark Manual of Examining Procedure (TMEP) 814 (Requesting Additional Information); TMEP 907 (Compliance with Other Statutes).

For hemp-derived skin care products, consider submitting the following types of information (if requested):

- A printout of applicant’s website which advertises and factually describes applicant’s goods (e.g., ingredients, functions within the body chemistry, regimen and uses, benefits, medical indications)
- Google search results for CBD oil
- “The Complete Guide to CBD (Cannabidiol)” (article by Leafly)
- Google search results for CBG oil
- “What Is CBG (Cannabigerol) & What Does this Cannabinoid Do?” (article by Leafly)
- Google search results for CBDA oil
- “What Is CBDA (Cannabidiolic Acid) & What Are the Benefits of this Cannabinoid?” (article by Leafly)

The examiner will also likely require applicant to provide written responses to various questions. Common questions are set forth below, along with sample written responses:

- **Question 1.** Do or will applicant’s identified goods include any oils, extracts, ingredients or derivatives from the plant *Cannabis sativa* L (also known as cannabis, marijuana or hemp)?

- o **Response to Question 1.** Applicant’s identified goods do include oils, extracts, ingredients or derivatives from the plant *Cannabis sativa* L (also known as cannabis, marijuana or hemp), including cannabidiol (CBD), cannabigerol (CBG), and cannabidiolic acid (CBDA).

- **Question 2.** If the answer to Question 1 is “yes,” does the hemp used or to be used in applicant’s goods contain more than 0.3 percent delta-9 tetrahydrocannabinol (THC) on a dry weight basis?

- o **Response to Question 2.** The hemp used in applicant’s goods does not contain more than 0.3 percent delta-9 tetrahydrocannabinol (THC) on a dry weight basis.

- **Question 3.** If applicant has any documentation relating to the THC content of the oils, extracts, ingredients, or derivatives used or to be used in the goods, please submit them with the response.

- o **Response to Question 3.** The actual THC content used in the cannabidiol (CBD), cannabigerol (CBG), and cannabidiolic acid (CBDA) is .01% on a dry weight basis. Applicant has no documentation relating to said THC content at this time.

- **Question 4.** If applicant’s goods do or will contain oils, extracts, ingredients, or derivatives from the plant *Cannabis sativa* L which has more than 0.3 percent delta-9 tetrahydrocannabinol on a dry weight basis, identify the part or parts of the plant used in obtaining the oils, extracts, ingredients, or derivatives.

- o **Response to Question 4.** Applicant’s goods, which include cannabidiol (CBD), cannabigerol (CBG), and cannabidiolic acid (CBDA), do not have more than 0.3 percent delta-9 tetrahydrocannabinol (THC) on a dry weight basis.

- **Question 5.** If the “hemp” is grown in the United States of America, is the hemp used in the goods obtained from an authorized grower or supplier of industrial hemp from the hemp growing pilot program set up under the 2018 Farm Bill?

- o **Response to Question 5.** The “hemp” used in applicant’s goods is grown in the State of Colorado, United States of America. Applicant receives its CBD, CBG, and/or CBDA from ABC Botanicals (ABC). ABC has seed to shelf standards and was one of the 13 CBD companies that was awarded a high-quality seal from the U.S. Hemp Authority. The U.S. Hemp Authority Certified Seal program was established in 2018. ABC is an authorized grower or supplier of industrial hemp from a hemp growing pilot program

set up under the 2018 Farm Bill. Applicant's "hemp" is naturally farmed, 99% pure, pesticide-free, and non-toxic. Applicant uses seed-to-sale tracking and third-party testing to ensure the highest possible quality.

- **Question 6.** Do or will applicant's identified goods include CBD which is derived from oils, extracts, or ingredients from plants other than Cannabis sativa L?
  - **Response to Question 6.** Applicant's identified goods, which include CBD, CBG, and/or CBDA, are not derived from plants other than Cannabis sativa L.

## Proper Goods Identification and Declaration of Compliance

The identification of goods must include the bold portions and look something like as follows:

Skin care products, namely, eye cream with moisturizers, hydrators and protectants for skin in the nature of **non-psychoactive cannabis solely derived from the hemp plant, including cannabidiol (CBD), cannabigerol (CBG) and/or cannabidiolic acid (CBDA), with a delta-9 THC concentration of not more than 0.3% on a dry weight basis** that is paraben free, sulfate free, artificial fragrance free and dye free.

In addition, applicant will need to submit a written statement or declaration of legal compliance indicating whether all the goods identified in the application comply with relevant federal law, including the CSA and the FDCA. Such a

declaration might look like this: "The goods identified in the application comply with relevant federal law, including the Controlled Substances Act and the Food, Drug, and Cosmetic Act. See 21 U.S.C. §§ 801-971; 21 U.S.C. § 331(l); 21 U.S.C. § 321(ff)."

## Related Content

### Practice Notes

[Trademark Strategies for Cannabis Products and Services](#)

[Trademark Applications: Pre-filing Considerations](#)

[Trademark Applications: Drafting the Application](#)

[Trademark Examination Process](#)

[Trademark Applications: Appealing Rejections](#)

### Checklists

[Trademark Protection for Cannabis Products and Services Checklist](#)

[Trademark Application Pre-filing Checklist](#)

[Trademark Application Checklist](#)

[U.S. Trademark Application Flowchart \(Use-Based Application\)](#)

[U.S. Trademark Application Flowchart \(ITU-Based Application\)](#)

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He serves as the chair of the Distressed Company Task Force that was created to assist borrower clients in every way, including in discussions with their lenders and in addressing concerns over suppliers and stakeholders. Please reach out to him with any questions on how he can provide counsel during the COVID-19 pandemic.

Jerry has been practicing in intellectual property since 1983. He has a strong technical background in mechanical, electro-mechanical, digital electronics, communications, biotechnology, medical, automotive, dental, food, heavy equipment, sports, outdoor, toy, building, fluid and air handling, petroleum, jewelry and chemical technologies. He has a special interest in products and services related to the outdoors, hunting and fishing.

Experienced in researching, preparing and prosecuting patent, trademark and copyright applications, Jerry has prosecuted to issuance more than 1,045 patents in the U.S. alone and has prosecuted over 620 trademark registrations. Jerry has successfully enforced the legalities of many U.S. patents for numerous clients. He is astute in contract negotiations and enforcement litigation and has been involved in more than 50 U.S. District Court infringement actions. Jerry also is a successful patent and trademark holder personally, with several commercial business enterprises. Jerry also does significant international patent and trademark prosecution throughout the world. Jerry has prosecuted more than 300 foreign patents and more than 300 foreign trademark registrations with an extensive network of foreign patent and trademark attorneys and agents.

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