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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88979768

Mark: UNCLE BUD'S INDUSTRIAL HEMP

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Reference/Docket No. 116242.00015

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's¹ refusal to register the mark UNCLE BUD'S INDUSTRIAL HEMP NATURE'S ORIGINAL MADE WITH CANTATREX + A TRUSTED FAMILY FORMULA (design plus words) for the goods “topical analgesics; analgesic balms; all of the foregoing containing ingredients naturally occurring in industrial hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3% on a dry weight basis” in Class 5, pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, on the ground that applicant does not have a bona fide intent to lawfully use the mark in commerce.

FACTS

On July 1, 2019, applicant, CBH International, LLC, filed an intent to use application pursuant to Section 1(b) of the Trademark Act for the mark UNCLE BUD'S INDUSTRIAL HEMP NATURE'S ORIGINAL MADE WITH CANTATREX + A TRUSTED FAMILY FORMULA (design plus words) (hereinafter “UNCLE BUD’S”) for the goods “cosmetics and cleaning

¹ This application was originally assigned to examining attorney Eric Sable, was reassigned to examining attorney [redacted] on 11/26/2021, and then to examining attorney [redacted] on 1/5/2022.

preparations; skincare; skincare products; cosmetic products; tropical pain relief” in Class 3 and “pharmaceuticals; hemp powder; hemp capsules; topical analgesics; analgesic balm; topical gel for medical and therapeutic treatment of minor aches and pains of muscles and joint” in Class 5.

On June 18, 2020, the examining attorney refused registration pursuant to Sections 1 and 45 of the Trademark Act due to the applicant not having a bona fide intent to lawfully use the mark in commerce due to the goods not being lawful under the Food, Drug and Cosmetic Act (FDCA). The examining attorney also partially refused registration pursuant to Section 2(d) of the Trademark Act for the goods in Class 3; required a Disclaimer of the wording “INDUSTRIAL HEMP”, “ORIGINAL” and “FAMILY FORMULA”; required amendments to the Identification of Goods; and required amendments to the Mark Description.

On October 2, 2020, applicant filed a Request to Divide, maintaining only the goods in Class 5 in the instant application. On December 10, 2020 applicant filed a Response in which applicant provided arguments against the Sections 1 and 45 refusal based on the FDCA. Applicant also amended the Identification of Goods, provided a Disclaimer, and amended the Mark Description. On April 30, 2021, the examining attorney issued an Office Action in which the Sections 1 and 45 Refusal based on the Food, Drug, and Cosmetic Act was maintained and continued. The examining attorney informed applicant that the Section 2(d) Refusal was obviated and requirements to amend the Identification of Goods, provide a Disclaimer, and amend the Mark Description were all satisfied.

On October 19, 2021, applicant filed a Response in which applicant provided additional arguments against the Sections 1 and 45 Lawful Use in Commerce Refusal based on the FDCA. On October 28, 2021, the examining attorney issued a Final Refusal based on the Sections 1 and 45 Refusal.

On April 28, 2022, applicant filed a Request for Reconsideration in which applicant made further arguments regarding the Sections 1 and 45 Lawful Use Refusal, in conjunction with filing applicant's Notice of Appeal. The examining attorney denied reconsideration on May 23, 2022.

On July 20, 2022, applicant filed its brief, which was forwarded to the examining attorney for statement on the same day.

ISSUE

The sole issue on appeal is whether the applicant had a bona fide intent to lawfully use its mark in commerce on the goods in Class 5, pursuant to Sections 1 and 45 of the Trademark Act, based on prohibitions in the Federal Food, Drug, and Cosmetic Act (FDCA).

ARGUMENT

APPLICANT DOES NOT HAVE A BONA FIDE INTENT TO LAWFULLY USE THE MARK IN COMMERCE BECAUSE THE GOODS TO WHICH THE MARK WILL BE APPLIED ARE UNLAWFUL UNDER THE FOOD, DRUG AND COSMETIC ACT

Applicant does not have a bona fide intent to lawfully use its mark, UNCLE BUD'S, in commerce for the goods "topical analgesics; analgesic balms; all of the foregoing containing ingredients naturally occurring in industrial hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3% on a dry weight basis" in Class 5. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; see TMEP §907. Applicant's goods are a per se violation of the Food, Drug and Cosmetic Act (FDCA), 21 U.S.C. §321(g)(1) because applicant's analgesic goods are for the cure, mitigation, treatment or prevention of disease and/or are intended to affect the structure of or any function of the body and contain CBD.

To qualify for federal trademark registration, the use of a mark in commerce must be lawful. *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 526, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (stating that "[a] valid application cannot be filed at all for registration of a mark without

‘lawful use in commerce’”); TMEP §907; *see In re Stellar Int’l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968); *Coahoma Chemical Co., Inc. v. Smith*, 113 USPQ 413 (Com’r Pat. & Trademarks 1957) (concluding that “use of a mark in connection with unlawful shipments in interstate commerce is not use of a mark in commerce which the [Office] may recognize.”). Thus, the goods to which the mark is applied must comply with all applicable federal laws. *See In re Brown*, 119 USPQ2d 1350, 1351 (TTAB 2016) (citing *In re Midwest Tennis & Track Co.*, 29 USPQ2d 1386, 1386 n.2 (TTAB 1993) (noting that “[i]t is settled that the Trademark Act’s requirement of ‘use in commerce,’ means a ‘lawful use in commerce’”)); *In re Pepcom Indus., Inc.*, 192 USPQ 400, 401 (TTAB 1976); TMEP §907.

Here, the goods to which the proposed mark are intended to be applied are unlawful under the Food, Drug and Cosmetic Act (FDCA), 21 U.S.C. §321(g)(1) because applicant’s goods include items that are intended for use in the cure, mitigation, treatment or prevention of disease and/or are intended to affect the structure of or any function of the body. Specifically, applicant’s identification specifies analgesics,² goods for relieving pain, and indicates that the goods “contain[] ingredients naturally occurring in industrial hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3% on a dry weight basis”. CBD is derived from and is naturally occurring in hemp. *See* evidence from Healthline.com, attached to June 18, 2020 Office Action, page 82 in TSDR; evidence from Medicalnewstoday.com, *id.*, page 92 in TSDR (stating CBD is

² *See* attached definition from MerriamWebster.com, defining “analgesic” as “an agent producing diminished sensation to pain without loss of consciousness : a drug that is used to relieve pain and produce analgesia”. <https://www.merriam-webster.com/dictionary/analgesic>. The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. *See In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1747 n.15 (TTAB 2018) (taking judicial notice of definition from Dictionary.com because it was from *The Random House Unabridged Dictionary*), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (taking judicial notice of definitions from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition from *Encarta Dictionary* because it was readily available in specifically denoted editions via the Internet and CD-ROM); TBMP §1208.04; TMEP §710.01(c); *see also* Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

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