

This Opinion is not a
Precedent of the TTAB

Mailed: November 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Ultra Trimmer, L.L.C.

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Serial No. 86479070

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Joseph W. Holland of Holland Law Office P.L.L.C.,
for Ultra Trimmer, L.L.C.

Lindsey Ben, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

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Before Quinn, Masiello, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Ultra Trimmer, L.L.C. (“Applicant”) seeks registration on the Principal Register of the mark ULTRA TRIMMER in standard characters (“TRIMMER” disclaimed) for goods identified as “agricultural machines, namely, a trimming machine for trimming leaves, plants, flowers and buds,” in International Class 7.¹

¹ Application Serial No. 86479070 was filed on December 12, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), on the basis of Applicant’s claim of first use anywhere and first use in commerce since at least as early as August 31, 2013.

The Trademark Examining Attorney has refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, on the ground that Applicant is not making lawful use of its mark in commerce because Applicant's goods are illegal drug paraphernalia under the federal Controlled Substances Act ("CSA"). After the Examining Attorney made the refusal final, Applicant timely appealed. Applicant and the Examining Attorney have filed briefs. We affirm the refusal to register.

I. Prosecution History

On April 14, 2015, the Examining Attorney issued an Office Action refusing registration of Applicant's mark on the ground that Applicant was not making lawful use in commerce of its mark because Applicant's goods were illegal "drug paraphernalia" within the meaning of Section 863 of the CSA. 21 U.S.C. § 863. On October 13, 2015, Applicant filed a response to the Office Action in which it argued against the refusal of registration on various grounds and submitted a declaration by its attorney making of record the various materials described below. On November 20, 2015, the Examining Attorney issued a second Office Action making final the refusal of registration on the ground that Applicant's use of its mark was not lawful under the CSA. This appeal followed.

II. Record on Appeal

The record consists of the following:

- Applicant's specimen of use;
- Pages from Applicant's website showing and describing the use of Applicant's trimming machine (April 14, 2015 Office Action);

- The declaration of Applicant’s counsel Joseph W. Holland (“Holland Decl.”) and the exhibits thereto described below (October 13, 2015 Response to Office Action);
- An article entitled “State Medical Marijuana Laws” by the National Conference of State Legislatures, summarizing state laws that have legalized the possession of marijuana for various purposes (Holland Decl. Ex. A);
- A memorandum dated August 29, 2013 from James M. Cole, Deputy Attorney General, to United States Attorneys and other officials of the Department of Justice regarding enforcement of the CSA (the “Cole Memo”) (Holland Decl. Ex. B);
- An article dated January 26, 2015 entitled “Legal Marijuana is the Fastest Growing Industry in the U.S.” from the Huffington Post (Holland Decl. Ex. C);
- A 2013 article entitled “Why I Changed My Mind on Weed” by Dr. Sanjay Gupta;
- Pages from the Patent and Trademark Office’s TESS database regarding third-party registrations of three marks for goods and services that Applicant contends involve marijuana (Holland Decl. Exs. E-F, H-J, and L);² and

² Registrations No. 3177756 and No. 3325766 for the mark CESAMET for “pharmaceutical preparations for the treatment of nausea, emesis” and “pharmaceutical preparations, namely antiemetics;” respectively; Registrations No. 2966195, No. 3594932, and No. 4281416 for the mark SATIVEX for “pharmaceutical preparations for the treatment of pain, neuropathic pain, cancer pain, multiple sclerosis, spinal cord injury, bladder disfunction, peripheral neuropathy, spasticity, oncology, cancer symptoms, psychiatric illnesses, neurodegenerative diseases and metabolic disorders; plant extracts for pharmaceutical purposes;” various goods and services in International Classes 9, 16, 41, and 44, and “pharmaceutical preparations, namely, herbal extracts, formulas containing herbal extracts, for use in the treatment of multiple sclerosis, neuropathic pain, spinal cord injury, bladder disfunction and peripheral neuropathy;” respectively, and No. 2492964 for the mark MARINOL for “pharmaceutical preparation for treatment of disturbed behavior in Alzheimer patients, europathy.”

- Pages from the websites of entities that Applicant claims own the third-party registrations, describing the products that Applicant claims are sold under the registered marks (Holland Decl. Exs. D, G, and K).

III. Analysis

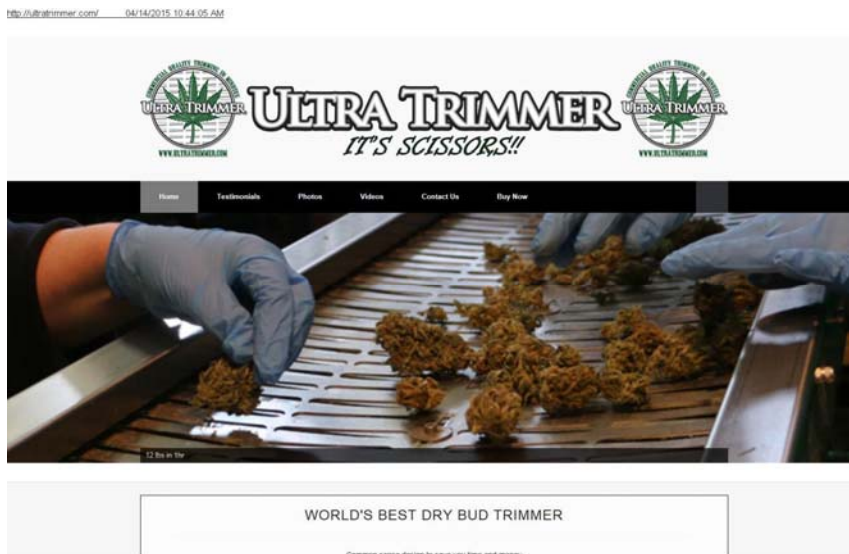
“We have consistently held that, to qualify for a federal . . . registration, the use of a mark in commerce must be ‘lawful.’” *In re JJ206, LLC*, 120 USPQ2d 1568, 1569 (TTAB 2016) (affirming refusal to register POWERED BY JUJU and JUJU JOINTS for cannabis vaporizing and delivery devices for lack of lawful use in commerce) (quoting *In re Brown*, 119 USPQ2d 1350, 1351 (TTAB 2016) (affirming refusal to register HERBAL ACCESS and design for retail store services featuring herbs, including marijuana, for lack of lawful use in commerce)). Thus, for a mark to be eligible for federal registration, “any goods . . . for which the mark is used must not be illegal under federal law’.” *Id.* (quoting *Brown*, 119 USPQ2d at 1351).

Applicant’s “trimming machine for trimming leaves, plants, flowers and buds” is a product that is not unlawful as it is described in the identification of goods in the application. But if the identification of goods or services in an application does not reveal a *per se* violation of the CSA, as in *JJ206*, 120 USPQ2d at 1570 (applicant’s “identified goods fall within the definition of illegal drug paraphernalia under the CSA”), extrinsic evidence may be used to show such a violation. *Brown*, 119 USPQ2d at 1351-52 (applicant’s specimen and website showed that its “retail store services

Registration No. 3594932 expired in February 2016 when it was not renewed. The file histories of the registrations were not made of record.

featuring herbs” included the sale of marijuana). The Examining Attorney has based the refusal of registration on Applicant’s specimen and website, which show that its machine is illegal drug paraphernalia under § 863 of the CSA. 21 U.S.C. § 863.

Applicant does not dispute that its goods are used to trim marijuana buds, 4 TTABVUE 7, and the Examining Attorney’s finding that Applicant’s machine is intended to be used for that purpose is supported by the record, which includes a description of the machine on Applicant’s website as “The Ultra Trimmer Marijuana Trimming Machine” and a photograph of the machine in operation (reproduced below):³



Applicant professes confusion as to the precise basis under the CSA for the refusal, 4 TTABVUE 8-9, but in the April 14, 2015 Office Action, the Examining Attorney cited and quoted from § 863, and there is no doubt that this provision is the statutory

³ April 14, 2015 Office Action.

basis for the Examining Attorney's conclusion that Applicant's goods are unlawful under federal law.

The record supports the conclusion that Applicant's goods are "drug paraphernalia" within the meaning of § 863 of the CSA. The CSA makes it unlawful to sell, offer for sale, or use any facility of interstate commerce to transport "drug paraphernalia," defined in § 863 as "any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under the [CSA]." 21 U.S.C. § 863.⁴ Section 863(e) provides that "[i]n determining whether an item constitutes drug paraphernalia, in addition to all other logically relevant factors, the following may be considered: . . . (2) descriptive materials accompanying the item concerning its use . . . (4) the manner in which the item is displayed for sale . . ." 21 U.S.C. § 863(e).

Applicant's website describes Applicant's machine as "The Ultra Trimmer Marijuana Trimming Machine," displays a marijuana leaf, shows Applicant's machine trimming what is described as "dry bud," and states that the machine "will process as much bud as the competition, if not more, without destroying trichomes." (April 14, 2015 Office Action). The word "bud" in these references means marijuana

⁴ Marijuana is a controlled substance that is unlawful to possess under the CSA. 21 U.S.C. §§ 812(a), (c), 841, 844

flowers.⁵ As described and shown in Applicant's own promotional materials, the processing of marijuana is the primary use for which Applicant's machine is intended and designed, and Applicant concedes that "the agricultural goods defined in the present application" are "intended or designed for use in processing marijuana." 4 TTABVUE 10. Applicant's trimming machine thus falls squarely within the plain language of the definition of "drug paraphernalia" in § 863 as "equipment . . . which is primarily intended or designed for use in . . . processing, [or] preparing . . . [marijuana]." 21 U.S.C. § 863.

On appeal, Applicant challenges the Examining Attorney's conclusion that registration must be refused because Applicant's goods are illegal drug paraphernalia under the CSA on the basis of two arguments addressed to the proper interpretation of the Trademark Act and the CSA, respectively, and a third argument claiming that the refusal to register rises to the level of a constitutional violation. We address these arguments in turn.

Applicant's first argument is that the verification required by Section 1(a)(3)(C) of the Trademark Act, 15 U.S.C. § 1051(a)(3)(C), that a mark is "in use in commerce" does not require that the use be lawful under federal law, and that a requirement of

⁵ We may judicially notice dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1082), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), and we grant the Examining Attorney's request (6 TTABVUE 4, n.3) that we judicially notice entries from the fifth edition of *The American Heritage Dictionary of the English Language* defining "marijuana" as "the cannabis plant" and "the dried flower clusters and leaves of [the cannabis plant]" and "bud" as "flowers from a female cannabis plant" and "a single flower of a cannabis plant."

lawful use is inconsistent with the definition of “commerce” in § 1127 of the Act (“all commerce which may be lawfully regulated by Congress”). 4 TTABVUE 4. Applicant claims that the precedents requiring use of a mark in connection with a legal good or service as a prerequisite to federal registration have placed the Patent and Trademark Office “in the anomalous position of interpreting, enforcing and implementing its own system of penalties for laws that fall under the direct authority of other governmental agencies.” 4 TTABVUE 4.

Applicant’s core argument was made to, and rejected by, the Board nearly 50 years ago in *In re Stellar Int’l, Inc.*, 159 USPQ 48 (TTAB 1968), a case that Applicant calls the “seminal authority” on the lawful use in commerce requirement. 4 TTABVUE 3.

In *Stellar*, the Board held that:

It is true, as applicant urges, that there is no reference to “lawful commerce” in Section 1 of the trademark statute which provides that the owner of a trademark *used in commerce* may register his mark on the Principal Register, and that applicant has in fact used its mark on goods shipped in commerce which may lawfully be regulated by Congress. It seems evident that the term “commerce” whenever and wherever used in the trademark statute must necessarily refer to “lawful commerce”; and that the statute was not intended to recognize under its registration provisions shipments in commerce in contravention of other regulatory acts promulgated under the “commerce clause” of the Constitution. To hold otherwise would be to place the Patent Office in the anomalous position of accepting as a basis for registration a shipment in commerce which is unlawful under a statute specifically controlling the flow of such goods in commerce.

159 USPQ at 51 (emphasis in original).⁶ Following *Stellar*, the Patent and Trademark Office has applied the lawful use in commerce requirement in examining applications for registration. See Trademark Rule 2.69 (“When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application”). 37 C.F.R. § 2.69. The Board has also applied the requirement in a long series of cases, most recently in *Brown* and *JJ206*, which affirmed refusals to register marks for marijuana-related goods and services. We decline Applicant’s invitation to revisit the interpretation of Sections 1 and 45 of the Trademark Act applied in these cases.

Applicant’s second argument is that the sale of its marijuana trimming machine is exempted from the coverage of the CSA. Applicant argues that “§ 863, paragraph (f) of the [CSA] entitled ‘Exemptions,’ provides for certain exemptions to the prohibition set forth [in § 863(a) and] paragraph (f) provides that the prohibitions of § 863 shall not apply to: ‘(1) any person authorized by local, State, or Federal law to manufacture, possess, or distribute such items . . .’” 4 TTABVUE 8-9. According to Applicant, “[t]he noted exemption applies in the instant case as no fewer than 45

⁶ *Stellar* also addressed Applicant’s argument that the lawful use requirement implicates the Patent and Trademark Office’s “own system of penalties for laws that fall under the direct authority of other governmental agencies.” 4 TTABVUE 4. Then, as now, “[w]e are not concerned herein with the imposition of criminal penalties. The question before us is whether or not applicant was entitled to register its mark when the application was filed.” 159 USPQ at 51.

sovereign states and the District of Columbia, have provided a variety of conditions and scenarios under which the sale and use of marijuana and ‘marijuana accessories’ are deemed within the law.” 4 TTABVUE 8-9. Applicant argues that the “use of marijuana including various cannabis based compounds and derivatives, and therefore by rational extension, the use of equipment intended or designed for use in processing marijuana, such as the agricultural goods defined in the present application, has been deemed lawful to some extent in a total of forty-two states and the District of Columbia.” 4 TTABVUE 10.⁷

Applicant further argues that “the ‘lawfulness’ of the various ‘frameworks’ adopted by the noted sovereign states to regulate the sale and use of marijuana and ‘marijuana accessories’ has been recognized by the U.S. Attorney General and the Department of Justice in [the Cole Memo] . . .” 4 TTABVUE 10. Applicant claims that the Cole Memo recognizes “the ‘lawfulness’ of the various ‘frameworks’ adopted by the noted sovereign states to regulate the sale and use of marijuana and ‘marijuana accessories,’” 4 TTABVUE 10, such that “[s]o long as a state or local government’s adopted legal framework addresses the eight primary enforcement objectives of the federal government, then such regulation is deemed acceptable to the federal law enforcement chiefs and ‘should remain the primary means of addressing marijuana related activity.’” 4 TTABVUE 10 (emphasis in original).

⁷ Applicant claims, on different pages in its brief, that either 45 states or 42 states have legalized the use of marijuana. The reason for this discrepancy is not clear, but the exact number is not material to our decision.

In response to these arguments, the Examining Attorney argues that “Applicant has not clarified how these exemptions apply to itself and how they lead to lawful use in commerce. More specifically, Applicant has not established how it, in particular, has been ‘authorized’ to manufacture, possess, or distribute such items. Nor has applicant established whether/how it is authorized to manufacture, possess, or distribute paraphernalia under the law in Idaho, where it is located.” 6 TTABVUE 10. We agree with the Examining Attorney that there is no evidence in the record that Applicant has received a license or other manifestation of authorization from any local, State, or Federal governmental authority to manufacture, possess, or distribute drug paraphernalia that would otherwise be illegal under the CSA, and that Applicant thus has not shown that its goods are exempted from illegality under § 863(f)(1) of the CSA.

Applicant also relies on the Cole Memo, which Applicant claims “recognizes the ‘lawfulness’ of the various ‘frameworks’ adopted by the noted sovereign states to regulate the sale and use of marijuana and ‘marijuana accessories.’” 4 TTABVUE 10. In *JJ206*, the Board explained that the Cole Memo is “a U.S. Department of Justice memorandum to United States Attorneys which addressed the enactment of medical marijuana laws in certain states, affirmed the illegality of marijuana under the CSA, and set out federal ‘enforcement priorities’ ‘to guide the Department’s enforcement of the CSA against marijuana-related conduct.’” *JJ206*, 120 USPQ2d at 1571. The Board found that “‘policy statements, agency manuals, and enforcement guidelines’ all ‘lack the force of law’,” *id.* at n.18 (quoting *Christensen v. Harris County*, 529 U.S.

576, 587 (2000)), and that the Cole Memo “is intended only ‘as a guide to the exercise of investigative and prosecutorial discretion’ and specifically provides that ‘[n]either the guidance herein nor any state or local law provides a defense to a violation of federal law, including any civil or criminal violation of the CSA.’” *Id.* The Cole Memo “thus provides no support for the registration of a trademark used on goods whose sale is illegal under federal law.” *Id.*

Applicant’s final argument alleges that the refusal of registration constitutes a constitutional violation. Applicant bases this argument upon a “search of the world-wide-web for products that contain the active ingredient of marijuana, THC, [that] located at least three products that claim a federally registered trademark.” 4 TTABVUE 11. On the basis of these registrations, “Applicant argues that the requirement of establishing lawful use as a condition precedent to registration is a rule that is not evenly applied as pharmaceutical companies have been allowed to lead the ‘rush to market.’ Applicant is likewise concerned that the promise of fair procedure guaranteed under the Fifth Amendment has been overlooked in what appears to be a two tiered system of granting trademark registrations.” 4 TTABVUE 12.

The procedures followed by the Patent and Trademark Office’s Trademark Examining Attorneys are dictated by the Trademark Act, 15 U.S.C. § 1051, *et seq.*, and the Trademark Rules of Practice, 37 C.F.R. Part 2, *etc.* The Patent and Trademark Office must consider each application on its own merits, and decisions regarding other registrations do not bind either the agency or the Board. *See In re*

The Boulevard Entertainment, Inc., 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). “Even if the PTO had previously allowed a mark similar to [Applicant’s mark] to be registered, that would not give [Applicant] an equal protection right to have its mark registered unless the [PTO] acted pursuant to some impermissible or arbitrary standard.” *Id.* (citing *In re Int’l Flavors & Fragrances*, 183 F.3d 1361, 51 USPQ2d 1513, 1518 (Fed. Cir. 1999)). *See also In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); *JJ206*, 120 USPQ2d at 1570-71 (rejecting argument that applicant was treated unequally when its mark was refused registration in the face of prior registrations and applications allegedly covering marijuana-related goods and services).

Applicant provides no evidence in any event that the products covered by the referenced registrations violated the CSA when the registrations issued. Applicant did not make of record the file histories of the referenced third-party registrations, so we do not know the specific records on which the registrations issued, but each of them covers pharmaceutical preparations for the treatment of various medical conditions and diseases, such as nausea, cancer pain, multiple sclerosis, spinal cord injury, cancer symptoms, psychiatric illnesses, and disturbed behavior in Alzheimer patients. These goods, as identified, are not unlawful, subject to their approval by the United States Food & Drug Administration before they may be sold in the United States. *See Trademark Manual of Examining Procedure* Section 1301.01(b)(vi) (discussing FDA approval process for pharmaceutical preparations for human use).

The product associated with the registrations of the CESAMET mark is described on a website made of record by Applicant as “approved by the US Food and Drug Administration . . .” October 13, 2015 Response to Office Action at 29. The product associated with the registration of MARINOL is described on a website made of record by Applicant, October 13, 2015 Response to Office Action at 48-58, as containing as its active ingredient a Schedule III controlled substance under the CSA, which by definition must have “a currently accepted medical use in treatment in the United States.” 21 U.S.C. § 812(b)(3)(B). Finally, the three registrations of the SATIVEX mark made of record by Applicant issued under Section 44 of the Trademark Act without proof of use of the mark in the United States. There is simply no evidence that the goods covered by these registrations violated the CSA when the registrations issued.

Neither the Examining Attorney nor the Board is bound by the actions of prior examining attorneys in other cases, *Boulevard Entertainment*, 67 USPQ2d at 1480, and Applicant certainly has made no showing that in refusing registration of Applicant’s mark while these registrations were on the Register, “the PTO acted pursuant to some impermissible or arbitrary standard.” *Id.* The refusal was based on well-settled law and was amply supported by the record.

Decision: The refusal to register is affirmed.