

This Opinion is not a
Precedent of the TTAB

Mailed: January 27, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Harbor Hemp Company LLC
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Serial Nos. 88377702 and 88377730¹
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Edward A. Pennington of Smith, Gambrell & Russell, LLP,
for Harbor Hemp Company LLC

Brin A. Desai, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.²
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Before Kuhlke, Shaw and Dunn,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Harbor Hemp Company LLC (“Applicant”) seeks registration on the Principal Register of the marks HARBOR HEMP COMPANY, in standard characters, and

¹ Because the appeals involve the same issues and nearly identical records, we hereby consolidate them and issue a single opinion for both appeals. Citations to the record are to Serial No. 88377730, unless otherwise noted, and refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system’s online database, by page number, in the downloadable .pdf format.

² During examination, these applications were assigned to Trademark Examining Attorney Rachael Dickson. They were reassigned to Brin Desai after they were returned to the Trademark Examining Operation for preparation of the briefs on appeal.



HARBOR HEMP COMPANY and design, , for goods identified as:

Non-medicated topical skin care preparations, namely, creams, lotions, gels, toners, cleansers, salves, and serums; cosmetics, namely, lip gloss and lip balm; all of the foregoing containing legally produced industrial hemp extract, in International Class 3;

Dietary and nutritional supplements in liquid form, powder form, gummy form, capsule form, tablet form, softgel form, and tincture form; medicinal oils; medicated topical skin care preparations, namely, waxes, balms, salves, creams, and lotions; nutritional supplement energy bars; nutritional supplement chocolates; dietary supplement drink mixes; dietary supplements for pets; all of the foregoing containing legally produced industrial hemp extract, in International Class 5; and

Electronic cigarettes; electronic cigarette cartridges; Electronic cigarettes atomizers; Electronic cigarette liquid (e-liquid) comprised of vegetable glycerin; Flavorings, other than essential oils, for use in electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; all of the foregoing containing legally produced industrial hemp extract, in International Class 34.³

Registration was refused to both applications as to the goods in International Class 5 under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127, on the

³ Application Serial Nos. 88377702 and (“the ’702 application”) and 88377730 (“the ’730 application”), both filed on April 9, 2019, based upon Applicant’s allegation of a *bona fide* intention to use the marks in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Applicant has disclaimed the term “COMPANY” in both applications. The ’730 application includes a description that reads “The mark consists of The mark consists of [sic] the words HARBOR HEMP COMPANY and circle light house design, without color.” and a color claim that reads “The color(s) blue is/are claimed as a feature of the mark.”

ground that Applicant does not have a bona fide intent to lawfully use the applied-for marks in commerce on these goods because they are not in compliance with the Federal Food, Drug and Cosmetic Act (“FDCA”), 21 U.S.C. §§ 321(g)(1), 331(d) and 355(a).⁴ Registration also was refused to both applications in their entirety under Trademark Act Section 6(a), 15 U.S.C. § 1056(a) in view of Applicant’s refusal to enter disclaimers of HEMP COMPANY apart from the marks as shown.

Registration was refused to the ’730 application in its entirety pursuant to Trademark Rules 2.37, 2.52(b)(1) and 2.63(b), 37 C.F.R. §§ 2.37, 2.52(b)(1) and 2.63(b), in view of Applicant’s failure to list the colors claimed as a feature of the mark and provide a description of the literal and design elements specifying where each color appears in those elements, or to submit a black and white drawing of the mark.

After the refusals were made final, Applicant appealed. Applicant filed briefs, but the Examining Attorney did not file a brief in either case. Nevertheless, we decide the appeal without the benefit of the Examining Attorney’s brief. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1203.02(b) (2021) (“An examining attorney’s failure to file a brief will not result in the application being approved; the Board will simply decide the appeal without the benefit of the brief.”); *see also In re Tenn. Walking Horse Breeders’ and Exhibitors’ Ass’n*, 223 USPQ 188, 188 n.3 (TTAB 1984) (In finding examining attorney’s statement to be untimely and

⁴ The refusal under Trademark Act Sections 1 and 45 does not apply to the goods in International Classes 3 and 34. *See Examination Guide 1-19, Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill*, dated May 2, 2019.

submitted without cause, the Board did not consider it, but proceeded to consider the merits of the case and to affirm the refusal).

I. No bona fide intent to use the marks in lawful commerce

Trademark Act Section 1(b), 15 U.S.C. §1051(b), states that “a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce” may apply for registration of the mark. Trademark Act Section 45, 15 U.S.C. § 1127, defines “use in commerce” as “the bona fide use of a mark in the ordinary course of trade.” In addition, “[t]he word ‘commerce’ means all commerce which may lawfully be regulated by Congress.” *Id.* The issue in this appeal is simple: whether an applicant for a federal trademark registration can have a bona fide intent to use its mark in commerce on goods that are currently prohibited under federal law but that may, perhaps, become lawful in the future.

For applications based on Section 1(b) of the Trademark Act, such as the present applications, if the record indicates that the identified goods are sufficiently broad so as to include items that are unlawful as of the application filing date, actual lawful use in commerce is not possible, and any intent that applicant has to use the mark on such goods is not the necessary bona fide intent to use the mark in lawful commerce. *See In re PharmaCann LLC*, 123 USPQ2d 1122, 1124 (TTAB 2017); *In re JJ206, LLC*, 120 USPQ2d 1568, 1569 (TTAB 2016).

The Federal Food, Drug, and Cosmetic Act (“FDCA”) prohibits the introduction or delivery for introduction into interstate commerce of a food to which has been added a drug approved under Section 355 of the Act or a biological product licensed under 42 U.S.C. § 262. 21 U.S.C. § 331(ll); *see also* 21 U.S.C. § 321(ff) (indicating that a

dietary supplement is deemed to be a food within the meaning of the FDCA and does not include an article that is approved as a new drug under 21 U.S.C. § 355, certified as an antibiotic under 21 U.S.C. § 357, or licensed as a biologic under 42 U.S.C. § 262). Introduction of an adulterated animal food into interstate commerce is prohibited as well under Section 331(a) of the FDCA, 21 U.S.C. § 331(a). Further, under the FDCA, any product intended to have a therapeutic or medical use, and any product (other than a food) that is intended to affect the structure or function of the body of humans or animals, is a drug. 21 U.S.C. § 321(g)(1). An unapproved new drug cannot be distributed or sold in interstate commerce unless it is the subject of an FDA-approved new drug application (NDA) or abbreviated new drug application (ANDA). 21 U.S.C. §§ 331(d) and 355(a), (b) and (j). Thus, all of Applicant's goods in class 5 are covered by the FDCA.

Cannabidiol (CBD): is derived from cannabis and its components (including hemp);⁵ is an active ingredient in an FDA-approved drug, Epidiolex®;⁶ and was the subject of substantial clinical investigations before it was marketed in foods or as dietary supplements.⁷ In the absence of an NDA or ANDA, drugs containing CBD or

⁵ See Office Action of April 6, 2020, TSDR pp. 10-29, *FDA Regulation of Cannabis and Cannabis-derived Products: Questions and Answers*, <https://www.fda.gov/news-events/public-health-focus/fda-regulation-cannabis-and-cannabis-derived-products-questions-and-answers> (“FDA treats products containing cannabis or cannabis-derived compounds as it does 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 whether the cannabis or cannabis-derived compounds are classified as hemp under the 2018 Farm Bill.”).

⁶ *Id.*

⁷ *Id.*

derived from hemp are unlawful under the FDCA. Nutritional supplements, including animal supplements, containing CBD are unlawful as well under § 301(l) of the FDCA.

The Examining Attorney contends that Applicant's goods, which all contain "legally produced industrial hemp extract," are unlawful because they will contain CBD.⁸ Applicant admits that "industrial hemp contains high levels of cannabidiol (CBD)"⁹ but claims that—at least for now—its "goods are stated to be for products containing 'legally produced industrial hemp extract,' and will not (this is an 'intent-to-use' application) contain either marijuana or CBD."¹⁰ Applicant's identification of goods, however, does not exclude CBD as an ingredient. Indeed, Applicant admits that its products could contain "small amounts of CBD,"¹¹ in which case, "federal labeling requirements would require an approved label that would list active and substantial ingredients." In other words, Applicant says its goods won't contain any CBD, but if they do, Applicant's labels would suffice to advise consumers that they do.

We find Applicant's statements that the goods will not contain CBD to be disingenuous at best. Applicant appears to be using the wording "containing legally produced industrial hemp extract" to obscure the fact that the goods contain CBD, in order to avoid a refusal to register the mark now, while leaving open the possibility

⁸ Office Action of November 5, 2020, TSDR pp. 1.

⁹ Applicant's Br., p. 5, 4 TTABVUE 6.

¹⁰ *Id.* at 1, 4 TTABVUE 2.

¹¹ *Id.*

of adding CBD to its products later. That is, Applicant is seeking to avoid a refusal to register the marks until such time as CBD products are no longer regulated by the FDCA. Applicant admits as much when it states that the wording “legally produced industrial hemp extract” “was deliberately fashioned to account for the fact that, whatever the appellant includes in its product, it will be done ‘legally,’ and pursuant to the rules and regulations of the FDCA at the time use is initiated.”¹²

The fact that Applicant’s goods may be derived from “legally produced industrial hemp extract” does not obviate their unlawfulness under the FDCA. The FDA requires any product marketed with a claim of therapeutic benefit and containing cannabis or cannabis-derived compounds (such as hemp) to be approved for its intended use before it may be introduced into interstate commerce whether hemp-derived or not.¹³ Because Applicant has not made of record an NDA or ANDA for its goods, it was unlawful for Applicant to introduce such goods into interstate commerce as of the application filing dates, and remains so.

Applicant, nevertheless, argues that

There is at least a difference of opinion as to whether states or the federal government will have the final say in legality, so at least for an intent-to-use trademark, the Trademark Office should allow the registration of marks where use in any one state is legal—if it remains illegal in other states, the trademark owner can avoid sales in those states.¹⁴

¹² *Id.* at 3, 4 TTABVUE 4.

¹³ See Office Action of April 6, 2020, TSDR pp. 2-6, *Statement of Commissioner Scott Gottlieb, M.D.*, <https://www.fda.gov/NewsEvents/Newsroom/PressAnnouncements/ucm628988.htm>.

¹⁴ Applicant’s Br., p. 6, 4 TTABVUE 7.

We disagree. Because Applicant's identified goods could not be lawfully introduced into commerce as of the filing date of the applications, Applicant did not have the requisite bona fide intent to use the marks in lawful commerce in connection with such goods. *See JJ206*, 120 USPQ2d at 1569 (“[W]here the identified goods are illegal under the federal Controlled Substances Act (CSA) . . . ‘it is a legal impossibility’ for the applicant to have the requisite bona fide intent to use the mark.”); *In re Stanley Bros. Social Enters., LLC*, 2020 USPQ2d 10658, *9 (TTAB 2020) (where the identified goods are illegal under the FDCA, the applicant's use is not in lawful commerce).

We find that Applicant's goods are per se unlawful under the FDCA, and therefore Applicant does not have a bona fide intent to use the marks in lawful commerce under Sections 1 and 45 of the Trademark Act.

II. Disclaimer requirement

Section 6(a) of the Trademark Act provides that “The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” 15 U.S.C. § 1056(a). *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) (citing *In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662, 665 (CCPA 1979)). If the Applicant does not comply with the disclaimer requirement, the Examining Attorney may refuse registration of the entire mark. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015). Applicant has disclaimed only COMPANY in both applications.

The Trademark Examining Attorney refused registration of Applicant's marks pursuant to Section 6(a) based on Applicant's failure to comply with a requirement to disclaim HEMP COMPANY because it is merely descriptive of Applicant's goods

within the meaning of Trademark Act Section 2(e)(1), and thus an unregistrable component of the mark. 15 U.S.C. § 1052(e)(1).

Merely descriptive terms are subject to disclaimer if the mark in which they appear is otherwise registrable. *See, e.g., In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1934 (TTAB 2012). A term is considered to be merely descriptive under Section 2(e)(1) of the Trademark Act if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods with which it is used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012).

Moreover, words or abbreviations in a trade name designating the legal character of an entity (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) must be disclaimed because an entity designation has no source-indicating capacity. *See In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (finding “PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“PAINT PRODUCTS CO. is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company.”).

The Examining Attorney argues that HEMP COMPANY must be disclaimed because “Applicant’s identification of goods specifically states that its goods contain ‘legally produced industrial hemp extract.’ Thus, the wording merely describes

applicant's goods and/or services because applicant's goods contain extract from hemp."¹⁵ In support of the disclaimer requirement, the Examining Attorney introduced dictionary definitions of "hemp" as "a tall widely cultivated Asian herb (*Cannabis sativa* of the family Cannabaceae, the hemp family)" and "company" as "a business organization that makes, buys, or sells goods or provides services in exchange for money."¹⁶

In response to the refusal, Applicant argues that

The mark is a unitary mark that includes several word and design aspects that all fit together to form a distinctive commercial impression. "Hemp" is not the mark: Harbor Hemp Company is. Hemp is not what the appellant intends to sell, but instead a wide variety of products that include a hemp extract."¹⁷

Based on the dictionary definitions, we agree with the Examining Attorney that HEMP COMPANY conveys knowledge of a quality, feature, function, or characteristic of the goods, namely that they are manufactured by a business organization that makes, buys, or sells goods produced from hemp. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *The Paint Prods. Co.*, 8 USPQ2d at 1866. We find that HEMP COMPANY is at least merely descriptive when used in connection with Applicant's goods, and must be disclaimed as an unregistrable component of the marks.

¹⁵ Office Action dated November 5, 2020, TSDR p. 1.

¹⁶ <https://www.merriamwebster.com>, Office Action of April 6, 2020, TSDR pp. 30-31.

¹⁷ Applicant's Br., p. 6, 4 TTABVue 7.

For the forgoing reasons, we affirm the Examining Attorney's requirement for disclaimer of HEMP COMPANY in both applications.

III. Drawing requirement in the '730 application

“If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.” Trademark Rule 2.52(b)(1), 37 C.F.R. §2.52(b)(1).

As shown on the drawing of the mark, above, Applicant's entire mark appears in the color blue. Applicant's color claim reads: “The color(s) blue is/are claimed as a feature of the mark.” Despite the color drawing and the color claim, Applicant's description of the mark reads: “The mark consists of The mark consists of [sic] the words HARBOR HEMP COMPANY and circle light house design, *without color*.” (Emphasis added). The description of the mark is unacceptable because it 1) conflicts with both the drawing of record and the color claim, 2) does not “name the color(s) [and] describe where the color(s) appear on the mark,” and 3) has a typographical error comprising duplicative wording. 37 C.F.R. § 2.52(b)(1). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 807.07(a) (2021) and the authorities cited therein.

The Examining Attorney issued a final requirement that Applicant either amend the description of the mark to conform to the drawing and color claim already of

record, or file a new black and white drawing and an appropriate description without any reference to color.¹⁸

In response, Applicant argues that it “never claimed color to be a part of the mark. While the specimen showed color, the appellant never claimed it to be a part of the mark.”¹⁹ This is clearly incorrect inasmuch as Applicant entered the color claim and revised description of the mark in its October 6, 2020 response to the Examining Attorney’s first office action.²⁰ Nor are there any specimens in this intent-to-use application.

We affirm the refusal to register the mark in the ’730 application in light of Applicant’s failure to either amend the description of the mark to conform to the drawing and color claim already of record or to file a new black and white drawing and an appropriate description without any reference to color.²¹

Decision: The unlawful use refusals under Sections 1 and 45 of the Trademark Act, based on the FDCA, are affirmed in both applications as to the goods in International Class 5. The disclaimer requirement under Section 6(a) of the Act also is affirmed as to both applications.²²

¹⁸ Office Action of November 8, 2020, TSDR p. 1.

¹⁹ Applicant’s Br., p. 7, 4 TTABVUE 8.

²⁰ Applicant’s October 6, 2020 Response to Office Action, TSDR p. 1.

²¹ Applicant’s drawing also includes the letter “TM” after the word “COMPANY.” In the event this refusal is reversed on appeal, Applicant should delete the letters “TM” from a revised drawing. See TMEP § 807.02 (“The drawing may not include extraneous matter such as the letters ‘TM,’ ‘SM,’ the copyright notice ©, or the federal registration notice ®.”).

²² In the ’702 application, if Applicant submits to the Board the required disclaimer of HEMP COMPANY, within thirty days, the affirmance of the requirement for a disclaimer will be set aside as to this application, which will then proceed as to the goods in International Classes

The requirement in the '730 application that Applicant either amend the description of the mark to conform to the drawing and color claim already of record, or submit a new black and white drawing and an appropriate description without any reference to color is affirmed.

3 and 34. *See* Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). A properly worded disclaimer reads: “No claim is made the exclusive right to use HEMP COMPANY apart from the mark as shown.”

In the '730 application, the affirmance of the requirement to correct the description of the mark or provide a substitute black and white drawing is a complete bar to registration of the mark. *See* Trademark Rule 2.142(g); *In re Carlton Cellars, LLC*, 2020 USPQ2d 10150, at *5 (TTAB 2020) (applicant’s failure to comply with requirements for acceptable identification and to pay required application filing fees cannot be remedied after final decision issues).