

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pioneer IP Interests LLC

Serial No. 88637739

Daan G. Erikson, Kris Kappel of Husch Blackwell LLP
for Pioneer IP Interests LLC.

Tasneem Hussain, Trademark Examining Attorney, Law Office 118,
Michael Baird, Managing Attorney.

Before Wellington, Heasley and Larkin
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Applicant, Pioneer IP Interests LLC, seeks registration on the Principal Register
of the standard character mark LOVA for goods ultimately identified as:

Non-medicated facial serum; body oil; non-medicated body balm; hemp-
infused cosmetic and bath products, namely, bath bombs; any hemp and
CBD in the goods being solely derived from hemp with a delta-9
tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on
a dry weight basis, in International Class 3;

Hemp-infused candles containing hemp with a delta-9
tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on
a dry weight basis, in International Class 4; and

Oral vaporizer pen for smoking purposes containing hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis, in International Class 34.¹

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with these goods, so resembles the registered mark LOVA NATURALS (in standard characters, with "NATURALS" disclaimed) for "dietary supplements; nutritional supplements" in International Class 5, as to be likely to cause confusion, to cause mistake, or to deceive.²

I. Prosecution History

The Application, as originally filed in October 2019, also identified goods in International Class 5: "Medicated body balm containing federally-lawful hemp with a THC concentration of not more than .03% on a dry weight basis; Herbal tinctures for medical purposes; hemp-infused hand wash, all of the foregoing containing federally-lawful hemp with a THC concentration of not more than .03% on a dry weight basis."

¹ Application Serial No. 88637739 was filed on October 1, 2019, based on Applicant's claim of first use on or in connection with its Class 3 goods anywhere and in commerce since at least as early as February 28, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and based on Applicant's declared intention to use the mark in commerce on or in connection with its Class 4 and 34 goods under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). According to the Applicant's translation statement, "[t]he wording 'LOVA' has no meaning in a foreign language."

Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system and identify the documents by title, date, and page in the downloadable .pdf version. Citations to the briefs and other materials in the appeal record refer to the Board's TTABVue online docket system.

² Registration No. 5909245 issued on the Principal Register on November 12, 2019.

The Examining Attorney's first Office Action not only refused registration based on likelihood of confusion with LOVA NATURALS, but also partially refused registration as to Applicant's Class 5 goods on the ground that they were unlawful. Specifically, the Examining Attorney stated, Applicant's Class 5 goods were broad enough to encompass products containing cannabidiol (CBD), a chemical constituent of the cannabis plant. Applicant's website offered these products as a "pain relief balm," meaning that they were intended for use as a drug. But new drugs undergoing clinical investigation may not be legally introduced without prior approval from the Food and Drug Administration (FDA), and since Applicant's Class 5 goods lacked this approval, their distribution and use would be unlawful under the federal Food, Drug, and Cosmetic Act (the FDCA). Consequently, the Examining Attorney stated, "[r]egistration of the mark is accordingly refused pursuant to Sections 1 and 45 of the Trademark Act because the applied-for mark is not in lawful use in commerce." This partial refusal applied to International Class 5 only.³ The Office Action also required Applicant to furnish information about the goods' CBD content and Applicant's compliance with the FDCA, as well as the Controlled Substances Act (CSA).⁴

³ July 15, 2020 Office Action at TSDR 6-7.

⁴ "To permit proper examination of the application, applicant must provide written responses to the following questions:

1. Do or will the goods include cannabidiol (CBD)?
2. If so, will there be more than a trace amount of CBD in the goods, e.g., more than 50 parts per million (PPM)?
3. Do or will applicant's identified goods include CBD which is derived from, oils, extracts or ingredients from plants other than Cannabis sativa L (also known as hemp, marijuana or cannabis)? If so, please specify.
4. Is applicant currently seeking FDA approval of the marketing of its goods identified in the application? If so, please provide a copy of such application.

To resolve the partial refusal, Applicant requested that its Class 5 goods be deleted in their entirety from the Application.⁵ This deletion, it contended, would also obviate any likelihood of confusion with the cited Registration:

The LOVA NATURALS registration is registered in connection with dietary supplements in Class 005 and does not include the required language to specify that it is for CBD products. Therefore, Applicant presumes that this dietary supplement does not, in fact, contain CBD. Applicant's Mark, on the other hand, is specifically limited to CBD products.

Given the current limitations on the sale of products containing CBD, and the subsequent ability to obtain trademark registrations as outlined by the Trademark Office, Applicant [and Registrant] in fact **cannot** lawfully include any goods or services in Class 005, nor apparently have lawful use in Class 005 for CBD-infused goods. Given that Applicant cannot provide medical products containing CBD, it is therefore impossible for Applicant to provide product in the same channels of trade.⁶

The Examining Attorney accepted Applicant's deletion of its Class 5 goods, but maintained and made final her refusal under Section 2(d) of the Trademark Act, reasoning, in pertinent part, that "registrant's goods have no limitation as to the ingredients and thus **could encompass CBD-based supplements as well as non-CBD-based supplements.**"⁷ Thus "[a] consumer encountering the mark LOVA in connection with applicant's hemp-based cosmetic, candle, and vape goods will incorrectly believe that the goods originate from the same source as registrant's

5. Upon information and belief, do applicant's goods comply with the Controlled Substances Act?

6. Upon information and belief, do applicant's goods comply with the Federal Food, Drug, and Cosmetic Act?" July 15, 2020 Office Action at 9. *See* Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b) (requests for information).

⁵ January 15, 2021 Response to Office Action at 8.

⁶ *Id.* at 7-8 (emphasis in **boldface** originally in *italics*).

⁷ January 21, 2021 Office Action at 5 (emphasis added).

LOVA NATURALS supplements.”⁸ The Examining Attorney also continued the requirement for information, which Applicant had not answered.⁹

Applicant filed this appeal, accompanied by a request for reconsideration. In the request for reconsideration, Applicant answered the Examining Attorney’s requirement for information,¹⁰ indicating that its goods would include CBD, and further argued that the dietary and nutritional supplements identified in the cited Registration, in contrast, could not contain CBD:

Importantly, dietary supplements like the goods under the Cited Mark cannot contain THC or CBD under federal law. 21 U.S.C. § 321(ff)(3)(B). The U.S. Food and Drug Administration (“FDA”) released information and guidance about cannabis-derived products, which the Examining Attorney reproduced in the Office Action dated July 15, 2020, stating that dietary supplements (like the goods under the Cited Mark) cannot contain THC or CBD under federal law. See Exhibit A (FDA webpage on Regulation of Cannabis and Cannabis-Derived Products, Including Cannabidiol (CBD); “Can THC or CBD products be sold as dietary supplements? A. No.”) and Exhibit B (FDA Fact Sheet on FDA Regulation of Dietary Supplement & Conventional Food Products Containing Cannabis and Cannabis-Derived Compounds).

In contrast, as stated in the answers to the requested information above and in Applicant’s goods description as amended, Applicant’s goods under the Application may contain federally-legal amounts of THC or CBD.¹¹

⁸ *Id.* at 6.

⁹ *Id.*

¹⁰ “(1) Yes (2) No, less than the .03% (3) No (4) No (5) Yes (6) Yes.” July 21, 2021 Response to Office Action (request for reconsideration) at 5-6.

¹¹ *Id.* at 7 (citing FDA Regulation of Cannabis and Cannabis-Derived Products, Including Cannabidiol (CBD) [FDA.gov/news-events/public-health-focus/fda-regulation-cannabis-and-cannabis-derived-products-including-cannabidiol-cbd](https://www.fda.gov/news-events/public-health-focus/fda-regulation-cannabis-and-cannabis-derived-products-including-cannabidiol-cbd) 7/21/2021, Exhibit A, July 21, 2021 Response to Office Action (Request For Reconsideration) at 15 et seq., *see also* July 15, 2020 Office Action at TSDR 62 et seq. and *FDA Regulation of Dietary Supplement & Conventional Food Products Containing Cannabis and Cannabis-derived compounds* July 21, 2021, Exhibit B, Response to Office Action (Request For Reconsideration) at 37 et seq.).

The Examining Attorney noted the resolved information requirement and, based on Applicant's answer that its goods included CBD, issued a new partial refusal that the CBD-based goods would violate the CSA unless Applicant supplied an acceptable identification of goods specifying that they contained "hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis."¹² The Examining Attorney also maintained the Section 2(d) refusal, noting that:

Applicant argues that its goods are limited to CBD products but (a) a closer look at the recitation reveals that the goods are limited to hemp, but not CBD, products and (b) registrant's goods have no limitation as to the ingredients and **thus could encompass CBD-based supplements as well as non-CBD-based supplements.**¹³

Applicant complied with the Examining Attorney's requirement that it specify the low THC concentration in its identification of goods, and maintained its position that the respective goods were distinct, such that there was no likelihood of confusion.¹⁴

The Examining Attorney found that Applicant's amendment of its identification of goods resolved the new issues, but maintained the refusal under Section 2(d), repeating in pertinent part that "registrant's goods have no limitation as to the ingredients and **thus could encompass CBD-based supplements as well as non-CBD-based supplements.** Applicant cannot place limitations on registrant's goods. Although federal registration is not granted for supplements containing CBD, many companies do offer **CBD-based supplements as well as non-CBD-based**

¹² Aug. 9, 2021 Office Action at 7-8.

¹³ *Id.* at 5 (emphasis added).

¹⁴ February 9, 2022, Response to Office Action.

supplements [as the Examining Attorney’s proffered third-party evidence purports to show].”¹⁵ The Examining Attorney also noted, as above, that Applicant’s identified goods are limited to hemp, not just CBD.¹⁶ (CBD with a low THC level is a form of hemp, but not the only one.) Relying on the third-party evidence, the Examining Attorney further maintained, more broadly, that “[t]his evidence shows that the goods listed therein, namely, hemp-based cosmetic products, candles, and vaporizer pens as well as supplements are of a kind that may emanate from a single source under a single mark.”¹⁷

This appeal then proceeded.

II. Analysis of Likelihood of Confusion

The Trademark Act prohibits registration of a mark that “so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....” 15 U.S.C. § 1052(d). To determine whether there is a likelihood of confusion between marks under Section 2(d), we analyze the evidence and arguments under the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (the “*DuPont* factors”). As the Court of Appeals for the Federal Circuit has declared:

In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002). The Board is required to consider each factor for which it has evidence, but it can focus its analysis on dispositive factors. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-

¹⁵ February 17, 2022 Office Action at 4; 4 TTABVUE 4 (emphasis added).

¹⁶ *Id.*

¹⁷ *Id.* at 3.

07 (Fed. Cir. 1997). A single *DuPont* factor may, for example, be dispositive of the likelihood of confusion analysis. *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991). The weight given to each factor depends on the circumstances of each case. *Dixie Restaurants, Inc.*, 105 F.3d at 1407.

In re Charger Ventures LLC, 64 F.4th 1375, 2023 USPQ2d 451, at *4 (Fed. Cir. 2023).

“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

A. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Again, Applicant's mark is LOVA, and Registrant's mark is LOVA NATURALS, with “NATURALS” disclaimed.

Applicant argues that even where, as here, two marks contain an identical term, they must be compared in their entireties, and slight differences in their appearance or sound may preclude a likelihood of confusion.¹⁸ “Further,” Applicant argues, “there

¹⁸ Applicant's brief, 6 TTABVUE 13-15.

Applicant also “notes that it in fact has priority over this registrant based on its prior use of Applicant's Mark in commerce.” Applicant's brief, 6 TTABVUE 8. Its point is unavailing, however, as it amounts to an impermissible collateral attack on a cited registration. *In re*

are many cases holding that the addition of another term distinguishes marks that contain one of the same words, even when the first word is the same.”¹⁹

We agree with the Examining Attorney, however, that the marks are similar.²⁰

Both marks feature the identical term LOVA, the first word in Registrant’s mark and the entirety of Applicant’s mark. Although the marks are compared in their entireties, LOVA is more significant or dominant in creating a commercial impression. It is fanciful, creating an inherently distinct impression.²¹ *In re Soc’y of Health & Physical Educators*, 127 USPQ2d 1584, 1587 (TTAB 2018) (“Generally, a component that is fanciful or arbitrary in the context of the goods and services at issue tends to contribute substantial distinctiveness to the mark as a whole....”). And it comes first in Registrant’s trademark, attracting consumers’ attention. *In re Detroit Athletic Co.*, 128 USPQ2d at 1049 (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first”) *cited in Monster Energy v. Lo*, 2023 USPQ2d 87, at *21 (TTAB 2023).

Detroit Athletic Co., 903 F.3d 1297, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1410 (TTAB 2018) (“[Applicant’s argument constitutes] a collateral attack on the registration, which we cannot entertain on this appeal because of the statutory presumptions that we must accord the registration under Section 7(b) of the Trademark Act.”). 15 U.S.C. § 1057(b).

¹⁹ 6 TTABVUE 15 (citing inter alia *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (finding no likelihood of confusion between RITZ and THE RITZ KIDS due to the differences in appearance, sound, connotation, and commercial impression of the two marks)).

²⁰ Examining Attorney’s brief, 8 TTABVUE 3-5.

²¹ The Application states that “[t]he wording ‘LOVA’ has no meaning in a foreign language.” Applicant further “confirms that the Mark does not have any meaning or significance, nor is it considered to be a term of art in Applicant’s industry. Similarly, the Mark has no meaning or significance as applied to Applicant’s goods.” Jan. 15, 2021 Response to Office Action at TSDR 9.

The disclaimed suffix NATURALS is less significant. It comes last in Registrant's mark, trailing the dominant term LOVA. *See In re Int'l Fruit Genetics, LLC*, 2022 USPQ2d 1119, at *30 (TTAB 2022) (because it is last, it is "less likely to be impressed upon a purchaser's memory and to be used in calling for the goods."). It describes Registrant's goods as natural, containing no artificial ingredients. "It is well settled that, while the question of confusing similarity of marks is to be determined from the marks as a whole, it is also proper to note that if a part of the mark is descriptive in nature, and has little or no trade-mark significance, it cannot be regarded as dominant and will generally be given less weight than more arbitrary portions of the marks." *Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 109 USPQ 313, 314 (CCPA 1956) *quoted in Soc'y of Health & Physical Educators*, 127 USPQ2d at 1587. And it could apply just as readily to some of Applicant's goods, especially cosmetics with natural ingredients. The suffix NATURALS thus fails to distinguish the marks, which contain the identical dominant term LOVA. *See Charger Ventures*, 2023 USPQ2d 451, at *5 ("So, while the Board must consider the disclaimed term, an additional word or component may technically differentiate a mark but do little to alleviate confusion.").

For these reasons, the marks are similar, and the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. The Goods, Channels of Trade, and Consumers

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration...." *DuPont*, 177 USPQ at 567. This factor considers whether "the consuming public may perceive

them as related enough to cause confusion about the source or origin of the goods....” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). The third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels,” and the fourth concerns the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Applicant argues that its goods may contain “federally-legal amounts of THC or CBD,” whereas Registrant’s goods cannot; and that makes all the difference in distinguishing the respective goods.²² The Examining Attorney, on the other hand, argues that “registrant’s goods have no limitation as to the ingredients and thus could encompass CBD- or hemp-based supplements as well as non-CBD- or hemp-based supplements.”²³

Applicant’s three Classes of identified goods expressly include hemp “with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis.” This language quoted from Applicant’s identification of goods derives from the Agriculture Improvement Act of 2018, Pub. L. 115-334 (the “2018 Farm Bill”), which defines “hemp” as “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 concentration of not more than 0.3 percent on a dry weight basis.” 7 U.S.C. § 1639o(1). The 2018 Farm Bill removed hemp from the definition of

²² Applicant’s brief, 6 TTABVUE 9-10.

²³ Examining Attorney’s brief, 8 TTABVUE 9.

“marijuana” under the CSA. 21 U.S.C. § 802(16)(B)(i).

After enactment of the 2018 Farm Bill, the Trademark Examination Operation issued guidance on examination of applications involving cannabis and cannabis-related goods and services.²⁴ In pertinent part, Examination Guide 1-19 explains that if an applicant’s goods contain ‘hemp’ as defined in the 2018 Farm Bill, the identification of goods must specify that they contain less than 0.3% THC. Thus, the scope of the resulting registration will be limited to goods compliant with federal law.”²⁵ *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 907 (July 2022). Applicant complied with this requirement, indicating that the hemp-infused products it identifies in Classes 3, 4, and 34 are lawful, and its mark for those goods is therefore eligible for registration.²⁶

A key issue framed by the prosecution history, as well as the briefs, is whether Registrant’s identified “dietary supplements” and “nutritional supplements” may be construed to contain CBD or other forms of hemp, similar to that included in

²⁴ Examination Guide 1-19 *Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill*. (May 2, 2019), <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%201-19.pdf>

²⁵ *Id.* at 2.

²⁶ Some of the cosmetic items Applicant identifies in Class 3 do not necessarily contain hemp (or, more specifically, CBD); the Application also identifies “non-medicated facial serum; body oil; non-medicated body balm,” none of which identifies hemp as an ingredient. Using semicolons, the Application separates these goods from its “hemp-infused cosmetic and bath products, namely, bath bombs.” *See Monster Energy v. Lo*, 2023 USPQ2d 87, at *15 n.35 (semicolons in an identification separate distinct categories of goods). The Class 3 identification ends with: “any hemp and CBD in the goods being solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis.” We infer from this part of the identification of goods that Applicant’s non-medicated facial serum, body oil, and non-medicated body balm may contain hemp or, more specifically, CBD, whereas the bath bombs always contain hemp, including CBD.

Applicant's cosmetic products, candles, and vape pens.²⁷

1. Whether Registrant's Identified Goods Can Be Construed to Contain CBD

The changes in the law resulting from the 2018 Farm Bill did not render all uses of CBD lawful. *Id.* As Exam Guide 1-19 further explains:

[E]ven if the identified goods are legal under the CSA, not all goods for CBD or hemp-derived products are lawful following the 2018 Farm Bill. Such goods may also raise lawful-use issues under the Federal Food Drug and Cosmetic Act (FDCA). The use in foods or **dietary supplements** of a drug or substance undergoing clinical investigations without approval of the U.S. Food and Drug Administration (FDA) violates the FDCA. 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).

...

CBD is an active ingredient in FDA-approved drugs and is a substance undergoing clinical investigations. ... Therefore, registration of marks for foods, beverages, **dietary supplements**, or pet treats containing CBD will still be refused as unlawful under the FDCA, even if derived from hemp, as such goods may not be introduced lawfully into interstate commerce. 21 U.S.C. §331(ll).

Exam Guide 1-19 at 2 (emphasis added)²⁸ quoted in *Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *45 n.60 (TTAB 2022).

The Board addressed the precise issue of whether “hemp oil extracts sold as an integral component of **dietary and nutritional supplements**” are lawful in *In re Stanley Bros. Soc. Enters., LLC*, 2020 USPQ2d 10658, at *1-2 (TTAB 2020) (emphasis

²⁷ See Applicant's response to the Examining Attorney's requirement to furnish information: “1. Do or will the goods include cannabidiol (CBD)?” [Applicant: “Yes”]
2. If so, will there be more than a trace amount of CBD in the goods, e.g., more than 50 parts per million (PPM)?” [Applicant: “No, less than the .03%”]. July 15, 2020 Office Action at 9; July 21, 2021 Response to Office Action (request for reconsideration) at 5-6.

²⁸ Citing statement of former FDA Commissioner Scott Gottlieb, M.D., on signing of the Agriculture Improvement Act and the agency's regulation of products containing cannabis and cannabis-derived compounds. FDA.gov/news-events/press-announcements/statement-fda-commissioner-scott-gottlieb-md-signing-agriculture-improvement-act-and-agencys 6/8/2020, July 15, 2020 Office Action at 83 et seq.

added). There, as here, the record showed that the applicant's goods contained "cannabidiol ('CBD'), an extract of the cannabis plant, that is regulated under the Food, Drug & Cosmetics Act ('FDCA') as a drug." *Id.* at *1. And there, as here, the applicant's responses to information requests indicated that its goods had a THC concentration of not more than 0.3 percent. *Id.* at *6. In light of the recent amendments to the law effected by the 2018 Farm Bill, which became law on December 20, 2018, the Board found that the goods were not per se unlawful under the CSA. *Id.* at *8-9. But because the applicant's CBD-containing goods were "an integral component of dietary and nutritional supplements" they were "deemed to be a food" subject to the FDCA. *Id.* at *14 (citing 21 U.S.C. § 321(ff) ("a dietary supplement shall be deemed to be food within the meaning of this chapter")). "The CBD in Applicant's goods qualifies as a 'drug or biological product for which substantial clinical investigations have been instituted and for which the existence of such investigations has been made public' under 21 U.S.C. § 331(ll)," the Board found, which rendered their introduction into interstate commerce without FDA approval unlawful. *Id.* at *11, 13-15 (citing 21 U.S.C. § 331(ll)). The Board concluded that distribution or sale in commerce of the dietary and nutritional supplements containing CBD was per se unlawful under the FDCA, and accordingly affirmed the refusal to register the applicant's mark. *Id.* at *16.

Stanley Bros. informs our resolution of the present case. Here, as there, the record indicates that all three Classes of Applicant's goods include CBD. Registrant's identification of goods, "dietary supplements; nutritional supplements," contains no express limitation as to their content. Ordinarily, "[i]f an application or registration

describes goods or services broadly, and there is no limitation as to their nature, it is presumed that the ‘registration encompasses all goods or services of the type described.’ *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013) quoting TMEP § 1207.01(a)(iii)....” *Monster Energy v. Lo*, 2023 USPQ2d 87, at *15-16.

But this principle runs up against another well-settled principle: that “to qualify for a federal... registration, the use of a mark in commerce must be ‘lawful.’” *Stanley Bros.*, 2020 USPQ2d 10658, at * 9 (quoting *In re JJ206, LLC*, 120 USPQ2d 1568, 1569 (TTAB 2016) cited in *In re Nat’l Concessions Grp., Inc.*, 2023 USPQ2d 527, at *2 (TTAB 2023)). And CBD would be unlawful in dietary or nutritional supplements.

The Board has previously declined to construe a registrant’s identification of goods to encompass unlawful goods. For example, in *Satinine Societa v. P.A.B. Produits*, 209 USPQ 958 (TTAB 1981), a cancellation proceeding, the petitioner argued that the challenged registration’s identification of cosmetics was unrestricted, such that the registrant could change its future marketing in a way that could violate federal labeling requirements. The Board rejected this argument that the registration’s identification of goods, lawful on its face, should be construed to encompass unlawfully marketed goods, and dismissed the cancellation petition. *Id.* at 966, cited in *In re Brown*, 119 USPQ2d 1350, 1352 (TTAB 2016). To quote one of the Board members concurring in *Satinine Societa*, “it 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.” *Satinine Societa*, 209 USPQ at 967 (Kera, concurring) quoted in *In*

re Brown, 119 USPQ2d at 1351.

The same principle holds true here. Registrant’s identification of goods cannot be construed to extend to unlawful types of dietary and nutritional supplements.²⁹ Any attempt to add CBD to its supplements would run afoul of the law—the CSA if they contained more than 0.3% THC, or the FDCA if they contained less than 0.3% THC. We therefore cannot impute to Registrant’s identified supplements a hypothetical

²⁹ The Examining Attorney likens this appeal to a nonprecedential Board decision, *In re Charlie’s Chalk Dust, LLC*, Serial No. 88417905, 2022 WL 486614 (TTAB Feb. 1, 2022), an ex parte appeal of a refusal based on Section 2(d). The issues in that nonprecedential decision resemble those in the present appeal in some respects, and differ in others.

In that case, the application originally identified, *inter alia*, supplements and food to which CBD had been added, which rendered these goods unlawful under the FDCA. The Board sua sponte remanded the application to the Examining attorney to address this issue, and the applicant agreed to amend its application to delete the supplements and food.

When the appeal resumed, the Board compared certain of the applicant’s goods—its Class 5 “herbal tinctures ... containing naturally occurring trace amounts of CBD derived from hemp and less than .3% THC,” and its Class 3 goods, “essential oils; non-medicated topical skin care preparations ... containing naturally occurring trace amounts of CBD derived from hemp and less than .3% THC,” to the cited registration’s goods, “dietary and nutritional supplements made of herbs; herbal tinctures for use as nutritional supplements; herbal tinctures for use in healing” in Class 5. Even though the registrant’s identified goods did not expressly contain CBD or other forms of hemp, they were unrestricted as to ingredients, so the Board found them legally identical and otherwise related to certain of the applicant’s goods. *Id.* at *6. *See* Examining Attorney’s brief, 8 TTABVUE 9-10.

The decision is similar to the present case, in that we find Registrant’s dietary and nutritional supplements similar to Applicant’s Class 3 cosmetics. It differs in that we do not construe Registrant’s supplements so broadly as to contain CBD. The Board in *Charlie’s Chalk Dust* did not address whether the registrant’s hypothesized goods would be lawful or unlawful under applicable federal law. “The Board must decide each case on its own merits,” *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Charlie’s Chalk Dust also resembles our present decision in another respect. There, the Examining Attorney did not refuse registration of the applicant’s mark as to its goods in Class 34: “CBD vape oil, namely, electronic cigarette liquid (e-liquid) and flavorings, other than essential oils, for use in electronic cigarettes containing naturally occurring trace amounts of CBD derived from hemp and less than .3 percent THC.” Here, we find Applicant’s “oral vaporizer pen for smoking purposes containing hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis, in International Class 34” dissimilar from and unrelated to Registrant’s supplements.

interpretation that would include CBD ingredients. Rather, we compare the goods without presuming that Registrant's goods, like Applicant's, may contain CBD.

2. Whether Registrant's Identified Goods Should Be Construed to Contain Forms of Hemp Other Than CBD

The Examining Attorney also contends that Registrant's dietary and nutritional supplements, as identified, may be non-CBD "potentially hemp-based supplements."³⁰ Applicant rejoins that Registrant's identification of goods does not have the required language specifying (as Applicant has) that the goods contain "hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis."³¹ See Examination Guide 1-19.³²

Registrant applied for registration of its mark in May 2018, and its application was still pending on December 20, 2018, when the 2018 Farm Bill became law. On May 2, 2019, the Trademark Examination Operation issued Examination Guide 1-19, pertaining to "Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill." The Examination Guide provides, in pertinent part, that applications filed before the effective date of the Farm Bill identifying goods encompassing CBD or other cannabis products would be refused registration as unlawful; however, the examining attorney would provide such applicants the option of amending their filing dates to December 20, 2018 and

³⁰ Examining Attorney's brief, 8 TTABVUE 10.

³¹ Applicant's brief, 6 TTABVUE 16.

³² Again, CBD is but one form of hemp. "Hemp" is statutorily defined as "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 concentration of not more than 0.3 percent on a dry weight basis." 7 U.S.C. § 1639o(1) (emphasis added).

adding the required low-THC limiting language quoted above, providing that its goods lawfully contained hemp, as defined in the statute. If an applicant elected to amend the application, the examining attorney would conduct a new search of the USPTO records for conflicting marks based on the later application filing date. Exam Guide 1-19 at 2.³³ Applications filed on or after December 20, 2018 would also have to add the required limiting language. Registrant, in this case, had not indicated that its dietary and nutritional supplements would encompass cannabis products. Had it done so, the Exam Guide would have come into play and the examining attorney responsible for that application would have presumably then required insertion of the “not more than 0.3%” language in the identification. Registrant filed its statement of use in September 2019, claiming first use of its mark in commerce as of March 25, 2019. Its identification does not contain the key limiting language.³⁴

Although the registration’s identification of goods does not contain the term “hemp” nor does it contain the “not more than 0.3%” THC language, Registrant’s supplements may be construed to contain lawful non-CBD hemp ingredients. Before the Farm Bill became law, the CSA contained an exception to the definition of “marijuana” (or “marihuana”):

The term ‘marihuana’ means all parts of the plant *Cannabis sativa* L., whether growing or not; the seeds thereof; the resin extracted from any

³³ For example, in *Shenzhen v. Fancy Pants*, applicant Fancy Pants originally filed its application on March 29, 2018, but since the application identified cannabis-based cigarettes, Fancy Pants complied with Exam Guide 1-19 and amended its filing date to December 20, 2018. *Shenzhen v. Fancy Pants*, 2022 USPQ2d 1035, at *2 n.1.

³⁴ It is doubtful that the Registration could now be amended to add the limiting language for hemp under the 2018 Farm Bill and the Exam Guide, as that would require amending its filing date, undergoing a new search for conflicting marks, and republishing the application underlying the cited Registration, which is prohibited. Trademark Rule § 2.173(e), 37 C.F.R. § 2.173(e).

part of such plant; and every compound, manufacture, salt, derivative, mixture, or preparation of such plant, its seeds or resin. **Such term does not include the mature stalks of such plant, fiber produced from such stalks, oil or cake made from the seeds of such plant, any other compound, manufacture, salt, derivative, mixture, or preparation of such mature stalks (except for the resin extracted therefrom), fiber, oil, or cake, or the sterilized seed of such plant which is incapable of germination.**

21 U.S.C. § 802(16) (1999) (emphasis added).

This exception covered non-psychoactive products derived from the stalks and seeds of the *Cannabis sativa* L. plant. It was, in consequence, sometimes referred to as the “stalks and seeds” exception, and the excepted non-psychoactive products were sometimes informally referred to as “hemp.” *See Hemp Indus. Ass’n. v. DEA.*, 357 F.3d 1012 (9th Cir. 2004):

The non-psychoactive hemp in Appellants’ products is derived from the “mature stalks” or is “oil and cake made from the seeds” of the *Cannabis* plant, and therefore fits within the plainly stated exception to the CSA definition of marijuana. ... it also made an exception to the exception, and included “resin extracted from” the excepted parts of the plant in the definition of marijuana, despite the stalks and seeds exception. 21 U.S.C. § 802(16). Congress knew what it was doing, and its intent to exclude non-psychoactive hemp from regulation is entirely clear.

Id. at 1017-18 cited in *Innovative Nutraceuticals, LLC v. United States*, 2019 WL 3017672, at *3 (C.D. Cal. 2019).

The 2018 Farm Bill retains the “stalks and seeds” exception to what constitutes “marijuana” and expands the exceptions by way of the following definitions:

- (A) Subject to subparagraph (B), the terms “marihuana” and “marijuana” mean all parts of the plant *Cannabis sativa* L., whether growing or not; the seeds thereof; the resin extracted from any part of such plant; and every compound, manufacture, salt, derivative, mixture, or preparation of such plant, its seeds or resin.
- (B) The terms “marihuana” and “marijuana” do not include—

(i) hemp, as defined in section 1639o of Title 7;
[“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 concentration of not more than 0.3 percent on a dry weight basis.” 7 U.S.C. § 1639o]

or

(ii) the mature stalks of such plant, fiber produced from such stalks, oil or cake made from the seeds of such plant, any other compound, manufacture, salt, derivative, mixture, or preparation of such mature stalks (except the resin extracted therefrom), fiber, oil, or cake, or the sterilized seed of such plant which is incapable of germination.

21 U.S.C. § 802(16) (current).

Thus, Cannabis-derived products meeting the “stalks and seeds” exception were lawful under the CSA before and after the Farm Bill became law. They also pass muster under the FDCA. As of 2018, the FDA (using the old, informal term “hemp”) determined that “hulled hemp seed, hemp seed protein powder, and hemp seed oil ... can be legally marketed in human foods.”³⁵ The FDA explains that “some of the intended uses for these ingredients include adding them as source of protein, carbohydrates, oil, and other nutrients.”³⁶ More importantly, the FDA states that these products are “generally recognized as safe (GRAS)” because, in part, “[t]he seeds of the plant do not naturally contain THC or CBD.”³⁷

Because Cannabis-derived products meeting the “stalks and seeds” exception were lawful both before and after the Farm Bill became law, the cited Registration can be

³⁵ “FDA Regulation of Cannabis and Cannabis-Derived Products, Including Cannabidiol (CBD)” (issued July 21, 2021), www.fda.gov. Copy attached to Applicant’s July 21, 2021 Request for Reconsideration, TSDR at 27-28. *Cited supra* note 11.

³⁶ *Id.*

³⁷ *Id.*

construed to contain those non-CBD “hemp” ingredients lawfully, without changing its application filing date or adding the “not less than 0.3% THC” language.³⁸

3. Whether the Respective Goods are Related

We compare the respective goods, so construed.

The Examining Attorney relies on third-party evidence to show that the respective goods are related. She claims that a score of third-party websites “clearly illustrated the relatedness of the parties’ goods as it showed that companies who commonly provide cosmetic products, candles, and vaping products also provide supplements under the same mark.”³⁹

Applicant argues that the mere fact that two items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for finding that the goods are related.⁴⁰ (Citing *inter alia Federated Foods v. Fort Howard Paper*, 192 USPQ at 29. But as the Examining Attorney observes, “[t]his probative evidence focuses on small retailers that sell the same products identified by the parties herein rather than large retailers that sell a wide variety of unrelated

³⁸ For example, one of the third-party registrations cited by the Examining Attorney, Reg. No. 5987318 for CANNAFLORIA, matured from an application, Serial No. 87751948, filed in January 2018. After the 2018 Farm Bill became law, the examining attorney and the applicant recognized the need to comply with Exam Guide 1-19, so the applicant divided its application, leaving its low-THC hemp goods, including vape pens, in its original (“parent”) application, which it eventually abandoned, and creating a “child” application, Serial No. 87982081, covering goods it described, somewhat incongruously, as “containing or derived only from hemp seed oil, and not from cannabis.” That “child” application retained the original January 2018 filing date, and matured into the third-party Registration No. 5987318.

³⁹ Examining Attorney’s brief, 8 TTABVUE 6 (citing to the July 15, 2020 Office Action at TSDR 13-56; January 21, 2021 Office Action at TSDR 23-52; August 9, 2021 Office Action at TSDR 10-53).

⁴⁰ Applicant’s brief, 6 TTABVUE 12.

products.”⁴¹ The Board has stated, “[t]his evidence is not from ‘big box’ retail stores or online retailers selling a wide variety of goods, but rather from specialty retailers. This targeted type of retailing is narrower in scope....” *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *6 (TTAB 2020). Third-party website evidence is probative when it shows that customers can expect to find an applicant’s and registrant’s respective goods offered by a common source. *See In re Detroit Athletic*, 128 USPQ2d at 1051; *Ox Paperboard*, 2020 USPQ2d 10878, at *6 (“This evidence shows that consumers may expect to find both Applicant’s and Registrant’s goods as identified in the involved application and cited registration as emanating from a common source.”).

Here, however, the third-party website evidence focuses nearly exclusively on CBD-based goods. As discussed above, Applicant’s goods in all three classes may contain CBD; however, Registrant’s goods cannot be so construed as including CBD. In other words, as discussed further below, the third-party evidence does not relate to Registrant’s goods, thus making any analysis of relatedness of the involved goods nearly impossible.

For example:

- **CBDfx.com** offers topicals, tinctures, bath bombs, vaporizer pens, gummies and capsules, all with CBD. (July 15, 2020 Office Action at TSDR 30-43.)
- **OrganicHempBotanicals.com** offers tinctures, creams, salves and roll-ons, bath bombs, candles, oils and incense, capsules and gummies (marked “HEMP BOTANICALS”), advertising “high amounts of cannabidiols [CBD]....” (July 15, 2020 Office Action at TSDR 44-46.)
- **IndustrialHempFarms.com** offers “CBD & Hemp Products” such as CBD roll-on sticks and sports creams and body butter and tinctures, CBD bath

⁴¹ Examining Attorney’s brief, 8 TTABVUE 6.

bombs, CBD vaporizer pens, CBD gummies and gel capsules. (July 15, 2020 Office Action at TSDR 51-56.)

- **PapaAndBarkleyCBD.com** offers Releaf CBD capsules, CBD skincare cream and lotion. (August 9, 2021 Office Action at TSDR 13 - 14.)
- **JustCBDStore.com**, true to its name, offers CBD tinctures, topicals, bath bombs, vaporizer cartridges, vaporizer pens, capsules and gummies. (August 9, 2021 Office Action at TSDR 26-28.)
- **CBII-CBD.COM** offers CBD pills & capsules, “the feel good capsules”, CBD candles, CDB skincare oils, balms. (August 9, 2021 Office Action at TSDR 51 - 53.)

The supplements—pills, capsules, and the like—tout CBD as the allegedly “active” ingredient. For example:



BUY CBD PRODUCTS

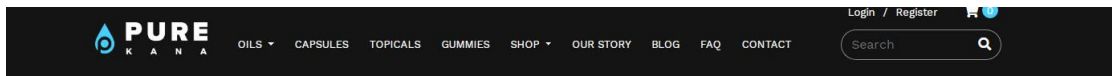
Looking to buy the best CBD online? You've come to the right place! At CBDfx, our mission is to provide as many different full-spectrum and broad-spectrum CBD products for sale as possible, so that you have ultimate flexibility in the way you provide your body with CBD. We're so confident in our CBD, we pay for public batch-level lab reports conducted by third party laboratories, so you can see exactly what's in your bottle.

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⁴² CBDfx.com, 7/15/2020 July 15 2020 Office Action at 30.



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OUR COLLECTIONS



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43 GardenofLife.com, 1/21/2021, Jan. 21, 2021 Office Action at 30.

44 PureKana.com 7/15/2020 July 15, 2020 Office Action at TSDR 47.

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OUR PRODUCTS

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<p>IDEAL CBD HEMP OIL 25MG EXTRA STRENGTH</p> <p>\$41.98 - \$53.98 Price Details</p>	<p>SERIOUSLY DELICIOUS® CBD LEMON DROP 25MG</p> <p>\$47.98</p>	<p>SERIOUSLY DELICIOUS® CBD CHOCOLATE MINT 25MG</p> <p>\$47.98</p>
<p>CBD MORE! 25MG DROPS</p> <p>\$47.98</p>	<p>CBD MORE! SOFTGELS 25MG CBD</p> <p>\$47.98</p>	<p>IDEAL CBD HEMP OIL 15MG</p> <p>\$41.98</p>


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⁴⁵ Store.Barleans.com 1/21/2021, Jan. 15, 2021 Office Action at 23-24.


Premium CBD Oil Softgels & Pills

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Our softgels come in three formulas specially crafted for everyday health, muscle and joint health, and sleep support. All three softgel formulas contain premium broad spectrum CBD oil that has gone through the additional process of nano technology to enhance absorption, making these some of the most effective CBD products available.



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CBD Softgels with Melatonin & CBN for Sleep
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The third-party candles and vape pens follow suit, focusing on this key ingredient:

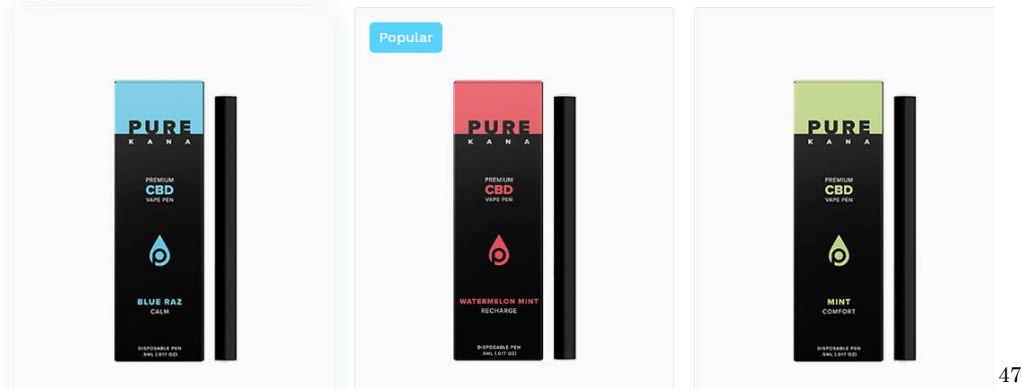
⁴⁶ JoyOrganics.com 8/9/2021, Aug. 9, 2021 Office Action at 12. The existence of third-party websites offering CBD supplements does not mean these supplements are lawful. The FDA has stated that it is aware of the proliferation of products containing cannabis-derived substances. It emphasizes that selling unapproved products with unsubstantiated therapeutic claims is a violation of the law. [FDA.gov/news-events/press-announcements/statement-fda-commissioner-scott-gottlieb-md-signing-agriculture-improvement-act-and-agencys](https://www.fda.gov/news-events/press-announcements/statement-fda-commissioner-scott-gottlieb-md-signing-agriculture-improvement-act-and-agencys) 6/8/2020, July 15, 2020 Office Action at 84-86.

CBD VAPE PEN

Available in four invigorating flavors, our line of premium-grade CBD vape pens here at PureKana has been described by more than one happy customer as 'the best on the market.' Delivering over 200mg of pure CBD per unit, these disposable pens are functional, affordable, delicious, and most importantly -- effective. Try all four formulas (Composed, Calm, Recharge, and Comfort) and decide for yourself which one is best for your needs.

CBD VAPE PEN FOR SALE

Category: CBD (mg): Flavor: [Clear Filters](#) Showing 4 results



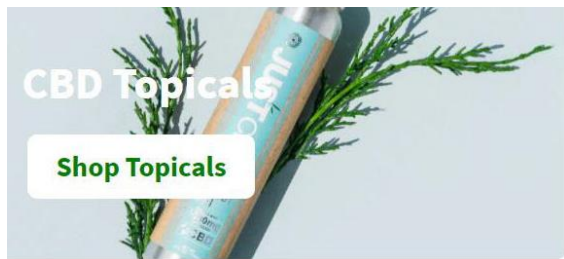
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⁴⁷ GardenofLife.com, 1/21/2021, Jan. 21, 2021 Office Action at 49.



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⁴⁸ JustCBDStore.com Aug. 9, 2021 Office Action at 26-27.

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The third-party website evidence thus centers on products containing a common ingredient, CBD, that cannot lawfully be imputed to Registrant’s dietary and nutritional supplements. This tends to weaken the probative value of this third-party evidence.

The Examining Attorney also cites five third-party registrations, claiming that “[t]his evidence shows that the goods listed therein, namely, hemp-based cosmetic

⁴⁹ CBDLiveNatural.com 8/9/2021, Aug. 9, 2021 Office Action at 48.

⁵⁰ CBII-CBD.com 8/9/2021 Aug. 9, 2021 Office Action at 52.

products, candles, and vaporizer pens as well as supplements, are of a kind that may emanate from a single source under a single mark.”⁵¹ The Board has stated: “As a general proposition, third-party registrations that cover goods ... from both the cited registration and an Applicant’s application are relevant to show that the goods ... are of a type that may emanate from a single source under one mark.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *8-9 (TTAB 2019).

But these third-party registrations are very few in number and cover goods that are, for the most part, only tangentially related, if at all, to those identified in the present cited Registration and involved Application. Their evidence of relatedness is mixed, and their probative value minimal.

The first third-party registration was cancelled and thus has no probative value.⁵² *See Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, *26-27 (TTAB 2022) (a cancelled registration is evidence of nothing but the fact that it once issued). A second registration solely concerns hemp-based supplements, which are not identified in the subject Application.⁵³ The third registration identifies supplements—some hemp-based, some not—but not cosmetics, candles, or vape pens.⁵⁴ The fourth registration bears a superficial resemblance to Applicant’s goods, covering essential oils and fragrances used in skin care and aromatherapy; but it does not cover dietary or nutritional supplements, much less candles or vape pens.⁵⁵

⁵¹ Examining Attorney’s brief, 8 TTABVUE 6-7.

⁵² Reg. No. 4867767, POWERED BY HEMPMEDS, cancelled June 24, 2022.

⁵³ Reg. No. 4981394, HEMPCHOICE.

⁵⁴ Reg. No. 5261718, ALIVE & SERIOUS.

⁵⁵ CANNAFLORIA Reg. No. 5987318.

The fifth third-party registration identifies goods similar to those covered by the subject Registration and Application: massage oil and body lotion, some containing hemp and some not; herbal supplements, some “not containing cannabis or CBD,” and other herbal supplements “for sublingual use only” derived from hemp; and e-liquid for vaporizer cartridges, all solely derived from hemp.⁵⁶ This single third-party registration is relevant to relatedness of the goods, but its probative value is limited. We have no evidence of the extent to which this third-party registrant’s goods are marketed together in the marketplace. The “existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) *aff’d*, 777 F. Appx. 516 (Fed. Cir. 2019).

a. Applicant’s Class 3 Goods vis-à-vis Registrant’s Supplements

Applicant offers CBD-based cosmetics, such as the bath balms, oils and serums identified in the Application, for skin care:

⁵⁶ Reg. No. 6234389, LAMP BOTANICALS, identifying massage oil, body lotion; all of the foregoing either not containing hemp derivatives or containing hemp derivatives solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis, in Class 3; herbal supplements not containing cannabis or CBD, and herbal supplements for sublingual use only solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis and not containing CBD, in Class 5; and electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges, namely, hemp oil made from industrial hemp; cartridges sold filled with hemp oil from industrial hemp for electronic cigarettes; all of the foregoing solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis, in Class 34.



Everything Body Balm 250MG

\$55.00

QUANTITY

- 1 +

ADD TO CART

BUY IT NOW

For your daily needs. Moisturize, soften and soothe your skin with the everything body balm.

57



Body Oil 100MG

\$45.00

QUANTITY

- 1 +

ADD TO CART

BUY IT NOW

For your daily needs: moisturize, soften and soothe your skin with the everything body oil.

100MG Hemp Extract

58



Ageless Face Serum 500MG

\$75.00

QUANTITY

- 1 +

ADD TO CART

BUY IT NOW

For your daily needs: repair, rejuvenate and hydrate your skin with the ageless face serum.

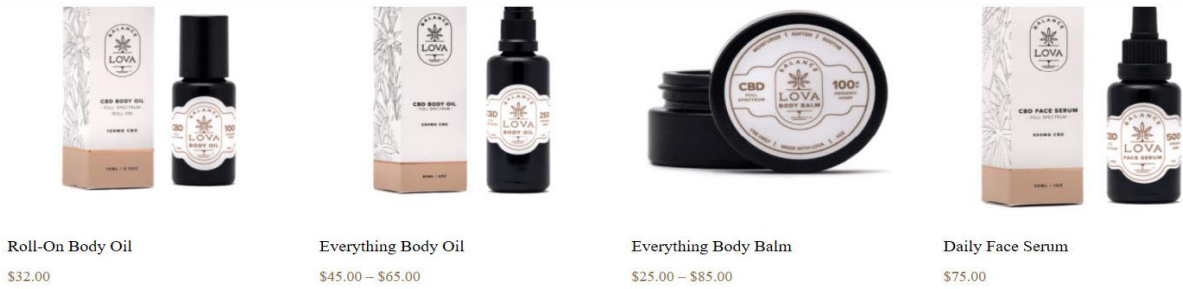
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⁵⁷ Applicant's specimen, Oct. 1, 2019 at TSDR 1.

⁵⁸ *Id.* at TSDR 2.

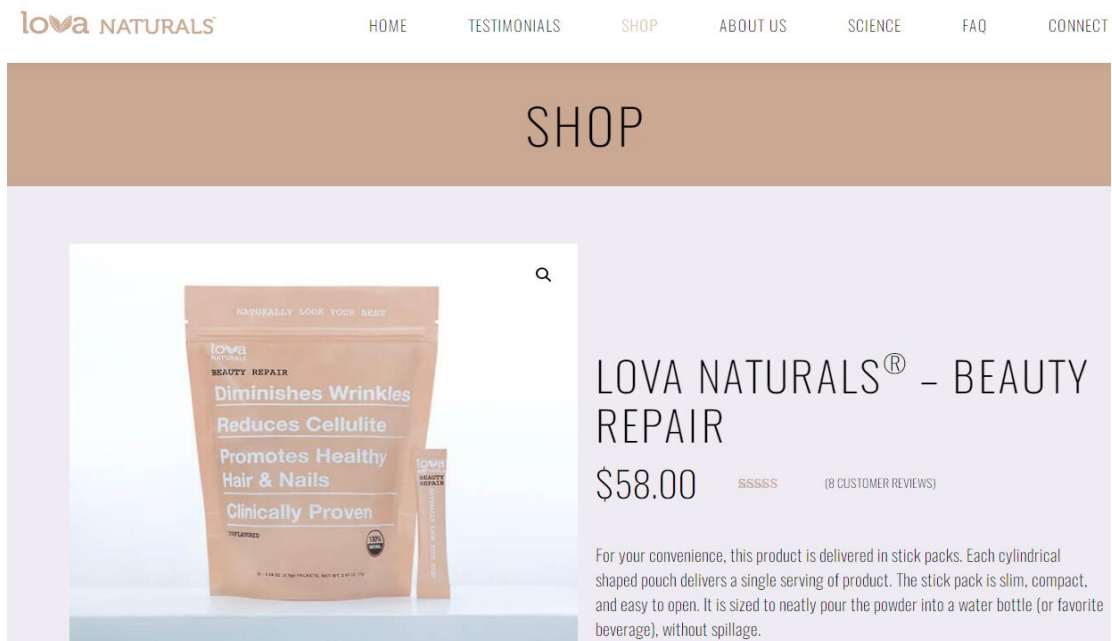
⁵⁹ *Id.* at TSDR 3.

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Supplements may serve the same purpose. Indeed, the record shows that Registrant offers its supplements for “beauty repair,” claiming that its product diminishes wrinkles and reduces cellulite, among other skincare benefits:



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The identified goods thus have shared cosmetic purposes. *See Shenzhen v. Fancy Pants*, 2022 USPQ2d 1035, at *48 (finding goods related because they could be used for same purpose); *see also In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69,

⁶⁰ July 15, 2020 Office Action at TSDR 61, Lovaco.com 7/15/20.

⁶¹ Feb. 9, 2022 Response to Office Action, Ex. A, at TSDR 12, LovaNaturals.com 4/7/23.

1271-72 (TTAB 2009) (finding MRI and ultrasound medical diagnostic devices related, based in part on their complementary purposes, as they may be used by the same medical personnel to detect the same disease in the same patients) *cited in In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012).

Applicant argues that consumers “would be keenly aware of the differences in Applicant’s products and the products sold under the Cited Registration, as one is meant to [be] ingested while the other is a topical product.”⁶² But cosmetics may be applied by either means: “The term ‘cosmetic’ means (1) articles intended to be rubbed, poured, sprinkled, or sprayed **on, introduced into, or otherwise applied to the human body or any part thereof** for cleansing, beautifying, promoting attractiveness, or altering the appearance, and (2) articles intended for use as a component of any such articles; except that such term shall not include soap.” 21 U.S.C. § 321(i) (emphasis added). *Cf. L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1440-41 (TTAB 2012) (applicant’s mark, L’OREAL PARIS for “aloe vera drinks,” confusingly similar to opposer’s L’OREAL PARIS mark for cosmetic, skin care and hair care products, some containing aloe vera). Applicant’s cosmetics and Registrant’s supplements serve a common function or purpose of promoting skin care.

There is also some overlap in channels of trade: two of the third-party websites offer both CBD-based cosmetics and non-CBD based supplements,⁶³ as does one of the third-party registrations.⁶⁴

⁶² Applicant’s brief, 6 TTABVUE 16.

⁶³ GardenofLife.com, and IrwinNaturals.com. January 21, 2021 Office Action at TSDR 30-51, August 9, 2021 Office Action at TSDR 41-42. Examining Attorney’s brief, 8 TTABVUE 8-9.

⁶⁴ LAMP BOTANICALS, Reg. no. 6234389.

Consequently, when we compare Applicant's cosmetics with Registrant's supplements, we find that "the respective products are related ... and ... the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Tiger Lily v. Barclays*, 2022 USPQ2d 513, at *8.

The same cannot be said for Applicant's candles and vape pens in Classes 4 and 34.

b. Applicant's Goods in Classes 4 and 34 vis-à-vis Registrant's Supplements

In contrast to our relatedness finding concerning Applicant's Class 3 goods, it is difficult to discern how consumers would consider candles and vape pens related to dietary and nutritional supplements. Based on their respective identifications, the involved goods are manifestly dissimilar, with no obvious or demonstrated shared purpose.. See *Bertini v. Apple, Inc.*, 63 F. 4th 1373, 2023 USPQ2d 407, at *5 n.3 (Fed. Cir. 2023) (proper for Board to focus on identification of goods in application and registration) quoting *Stone Lion Cap. v. Lion Cap.*, 110 USPQ2d at 1162.

The third-party evidence is not probative on the question of whether the respective goods are related because, again, that evidence almost exclusively concerns goods with a common key ingredient: CBD. In *L'Oreal*, cited above, the Board found aloe vera drinks similar to cosmetic and hair care products, some containing aloe vera, partly because "consumers are aware that aloe or aloe vera is often prominently listed as a beneficial ingredient..." *L'Oreal v. Marcon*, 102 USPQ2d at 1440. That case involved common ingredients that were promoted and recognized as the primary beneficial or appealing ingredient of the respective products. Here, Applicant's and

Registrant's key ingredients differ to the extent the former may contain CBD while the latter cannot be construed as such. All of Applicant's goods in these two classes identify hemp as an ingredient and may include CBD, which by Applicant's own statement they do.⁶⁵ Registrant's identified dietary and nutritional supplements, on the other hand, cannot be construed to contain CBD. Because the third-party evidence focuses on goods having a key ingredient, CBD, there is insufficient evidence from which to infer that consumers would perceive Applicant's goods in Classes 4 and 34 are related to Registrant's supplements.

"If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e., a customer or purchaser." *Astra Pharm. Prods., Inc. v. Beckman Instr., Inc.*, 718 F.2d 1201, 220 USPQ 786, 790 (1st Cir. 1983) *quoted in Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391-92 (Fed. Cir. 1992).

Overall, neither the rationales nor the third-party evidence advanced by the Examining Attorney establish that Applicant's candles and vape pens are related to Registrant's dietary and nutritional supplements in the mind of the purchasing public, or that the same purchasing public would shop for them and encounter them in the same channels of trade.

On this record, then, we find that the Examining Attorney has shown a sufficient relationship between Applicant's cosmetic goods in Class 3 and Registrant's supplements in Class 5 to support a likelihood of confusion under the second and

⁶⁵ July 21, 2021 Response to Office Action (request for reconsideration) at 5-6; August 9, 2021 Office Action at TSDR 54-58.

third *DuPont* factors. However, the evidence does not suffice to establish that Applicant's Class 4 candles or Class 34 vape pens are similar or related to Registrant's supplements, or travel in the same channels of trade to the same classes of consumers.

III. Balancing the Factors

“As so often said, each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases.” *DuPont*, 177 USPQ at 567. We have considered all of the evidence of record and all of the arguments as they pertain to the relevant *DuPont* likelihood of confusion factors. *See Charger Ventures*, 2023 USPQ2d 451, at *7.

We find that the marks are similar, that Registrant's supplements are related to Applicant's Class 3 cosmetic goods, and that these goods sometimes travel in the same channels of trade to the same classes of consumers, who would use them for a similar skincare purpose.

The evidence does not establish, however, that Registrant's supplements are related to Applicant's candles in Class 4 or vape pens in Class 34, or that these goods would tend to travel in the same channels of trade. This “dissimilarity of the goods due to their nature, the manners in which they are sold or distributed, and the circumstances under which consumers would encounter them, is a dispositive factor in this case.” *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1143 (TTAB 2009). “The Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is

insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.” *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 USPQ 222, 224 (TTAB 1983) cited in *Shenzhen v. Fancy Pants*, 2022 USPQ2d 1035, at *50 n.75. In this case, “[a]lthough the marks are virtually the same, ... there is nothing in this record which convinces us that these purchasers are the same or that anything about the products themselves or the way they are promoted or sold would cause these purchasers to mistakenly assume that the goods of [A]pplicant and [Registrant] share a common source.” *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669-70 (TTAB 1986). See also *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (“The board placed the greatest weight on its findings that the goods in question were not related and that the channels of trade and purchasers are different. Because of the dominant role these factors play in this case, we find no error in the weight the board accorded them.”).

In sum, on this record, our weighing of all relevant *DuPont* factors under Section 2(d) leads us to conclude that the record evidence establishes a likelihood of confusion between Registrant’s mark and Applicant’s mark with respect to its Class 3 goods, but not with respect to its Class 4 and 34 goods. 15 U.S.C. § 1052(d). In making this determination, we note the limited resources of the Office in acquiring evidence, and hasten to point out that a different and more complete record, such as might be adduced in an inter partes proceeding, might warrant a different result. See *L’Oreal v. Marcon*, 102 USPQ2d at 1435-36.

Decision: The refusal to register Applicant’s mark under Section 2(d) is affirmed

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as to Class 3 and reversed as to Classes 4 and 34.