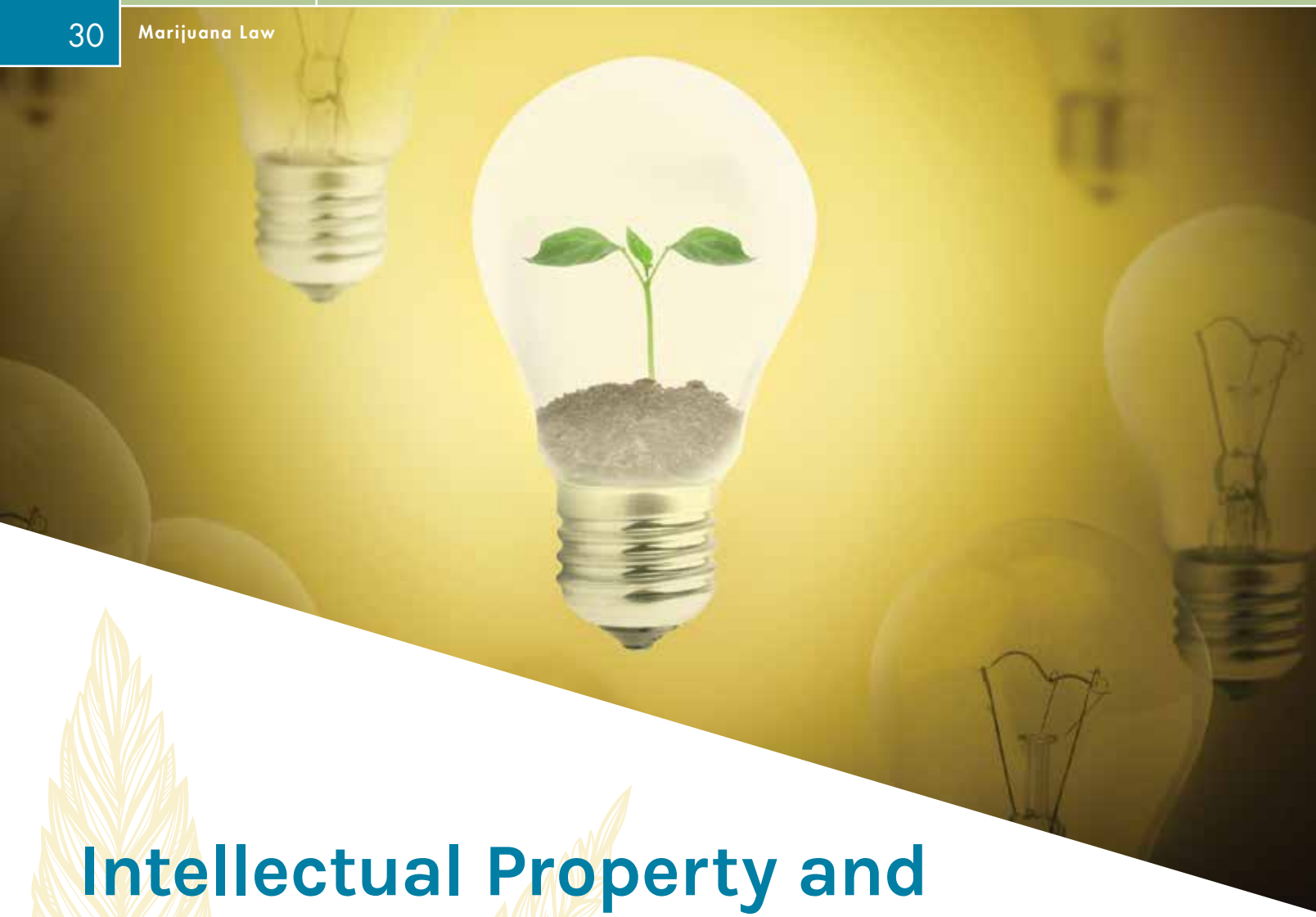

Intellectual Property and the Medical Marijuana Industry

By Diana Olesko and Travis Copenhaver

Intellectual property involves protecting creations of the mind. This can present a challenge for the medical marijuana industry, as many of these "creations" are currently illegal under federal law. While the federal prohibition of marijuana can create significant barriers, there are still many opportunities for the marijuana industry to establish intellectual property protection.

Any industry providing goods or services to consumers understands the importance of trademark protection. A trademark is a word, symbol, or phrase capable of distinguishing the goods and services of one source from those of another. While protection can be established at the state and local levels, federal registration provides the most advantageous form of trademark protection. However, federal protection can only be extended to marks with a lawful use in commerce. The United States Patent and Trademark Office (USPTO) will not issue a registration for any mark involving the manufacture, distribution, dispensing, or possession of marijuana and marijuana-based preparations.[1] Notwithstanding medical marijuana's legal status under state law, federal law provides no exception to allow for the federal registration of a trademark involved in the medical use of marijuana.[2]

Despite these limitations, several participants in the marijuana industry have obtained federal trademark protection. Applicants have successfully registered marks for goods or services associated with, but not directly tied to, medical marijuana. For example, several marks exist for blogs and publications presenting information about the industry.[3] Although the USPTO will not issue registrations for applications identifying goods or services that violate federal law, this prohibition is limited to the goods and services for which protection is sought. Applicants seeking federal registration are not

FAST FACTS

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required to seek protection for all possible goods or services they provide under a mark. Trademark owners can use federal registrations to establish strong, supplementary protection for their brands. By legally reaching across state borders with legal products and services, cannabis trademark owners can promote their brands while still taking advantage of federal trademark protection.

Patent law operates under a different set of rules and guidelines. Unlike trademark law, there is no clear prohibition preventing a patent for an invention involving marijuana. Patentable subject matter can include "anything under the sun that is made by man."[4] While it is still unclear how the USPTO will choose to process marijuana patent applications directly associated with the medical cannabis industry, there are existing patents that encompass marijuana. For example, the United States of America, represented by the Department of Health and Human Services, is the assignee of a patent entitled "Cannabinoids as Antioxidants and Neuroprotectants."[5] This patent "concerns pharmaceutical compounds that are useful as tissue protectants, such as neuroprotectants and cardioprotectants." Many other patents have been granted, such as methods of extraction[6] or a method for detecting cannabinoids in body fluids.[7]

Despite current uncertainty, marijuana inventors have already started pursuing plant patents for different strains of marijuana.[8] A plant patent is granted to "[w]hoever invents or discovers and asexually reproduces any distinct and new variety of plant…."[9] While many cultivators believe they have developed patentable strains of marijuana, protection is limited by several additional requirements of patentability.

To be patentable, for example, a plant must not have been sold or released in the United States for more than one year before the date of the application, creating a real issue for many strains currently on the market. Plant inventions must be developed or discovered in cultivated areas and must display unique characteristics not merely obtained through differences in growing conditions or fertility levels. Many strains of marijuana, while seemingly unique, will fail to meet these minimum requirements.

Other forms of intellectual property protection are less hostile toward marijuana and in some cases may provide the best protection currently available to the medical marijuana industry. Trademark owners may be barred from federal registration, but marks are still used to promote marijuana goods and services in Michigan. In addition to state and local trademark protection, marijuana businesses can establish copyrights for logos or artwork used to promote goods and services. An inventor may not be able to patent a particular strain of marijuana, but the methods for cultivating that strain—such as light exposure, soil and fertilizer composition, and humidity—can be protected through trade secrets. By actively establishing a trade secret, cultivators can prevent theft and misappropriation by employees or competitors. These rights are enforceable under Michigan's Uniform Trade Secret Act.

As science continues to demonstrate the value of medical marijuana, legal barriers will continue to diminish. While not all intellectual property protections are currently available to the industry, the marijuana community can still enjoy significant intellectual property protection. By understanding the boundaries of the law, the marijuana community can continue to innovate. ■

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Travis Copenhaver is an experienced trademark attorney, filing hundreds of federal trademark applications in a variety of industries. Additionally, he has successfully defended numerous applications from office actions issued by the USPTO. He currently concentrates in medical marijuana business law.

ENDNOTES

1. 21 USC 812, 841(a)(1), 844(a); see also 21 USC 802(16) (defining "marijuana").
2. 37 CFR 2.69; Patent and Trademark Office, *Trademark Manual of Examining Procedure* (5th ed), p 907 (citing 21 CFR 1308.11).
3. See Lambert, *Om of Medicine*, US Registration 4684302 (registered February 10, 2015).
4. *Diamond v Chakrabarty*, 447 US 303, 309; 100 S Ct 2204; 65 L Ed 2d 144 (1980).
5. Hampson, et al., *Cannabinoids as antioxidants and neuroprotectants*, US Patent 6630507 B1 (issued October 7, 2003).
6. Webster & Sarna, *Cannabinoid extraction method*, US Patent 6403126 B1 (issued June 11, 2002).
7. Akers & Akers, *Cannabinoid detection method*, US Patent 4816415 A (issued May 28, 1989).
8. See Pending US Patent Applications US 20140259228 A1 and US 20140245495 A1.
9. 35 USC 161.