

NOTES & COMMENTS

BRANDED BUD OR GENERIC GANJA? TRADEMARKS FOR MARIJUANA IN WASHINGTON

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Marijuana is legal under Washington State law but illegal under United States federal law. This Paper assumes that marijuana will remain legal in Washington. Springing from that assumption, a crucial question is, what shall a merchant call her marijuana? This Paper explores that question first by describing the benefits and costs of allowing trademark protection for marijuana, concluding that trademark law should protect marijuana products. Second, this Paper identifies possible methods of seeking trademark protection for marijuana. Third, this Paper explains how the law should determine whether proposed marijuana trademarks are distinctive and protectable, or unprotectable for being descriptive or generic. Ultimately, this Paper argues that an understanding of marijuana’s various genetic strains and slang terms is necessary to properly assess marijuana trademark rights and to prevent unfair competition in the marijuana industry.

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## INTRODUCTION

In November 2012, Washington voters passed Initiative 502,<sup>1</sup> authorizing the state liquor control board to regulate and tax marijuana.<sup>2</sup> On December 6, 2012, it became legal under Washington law for adults over the age of 21 to carry marijuana and marijuana-infused products for personal use.<sup>3</sup> In March 2014, Sean Green became the first licensed recreational-marijuana grower in Washington.<sup>4</sup> In July 2014, licensed marijuana retail stores began operating legally around the state.<sup>5</sup> In November 2014, Washington, D.C., Oregon, and Alaska voters chose to join Colorado and Washington by legalizing marijuana for non-medical use among responsible adults.<sup>6</sup>

However, under federal law and specifically the Controlled Substances Act, “Marihuana” is a Schedule I drug and its sale and possession

<sup>1</sup> Jonathan Martin, *Voters Approve I-502 Legalizing Marijuana*, SEATTLE TIMES (Nov. 6, 2012), [http://seattletimes.com/html/localnews/2019621894\\_elexmarijuana07m.html](http://seattletimes.com/html/localnews/2019621894_elexmarijuana07m.html). Colorado also legalized recreational marijuana in November 2012. Sadie Gurman, *Coloradans Say Yes to Recreational Use of Marijuana*, DENVER POST, Nov. 7, 2012, at 8A.

<sup>2</sup> WASH. REV. CODE ANN. §§ 69.50.301–69.50.369 (West Supp. 2014); Initiative Measure No. 502, § 1(3) (filed July 8, 2011), available at [http://sos.wa.gov/\\_assets/elections/initiatives/i502.pdf](http://sos.wa.gov/_assets/elections/initiatives/i502.pdf).

<sup>3</sup> WASH. REV. CODE ANN. § 69.50.4013; Jonah Spangenthal-Lee, *Marijwhatnow? A Guide to Legal Marijuana Use in Seattle*, SPD BLOTTER (Nov. 9, 2012), <http://spdblotter.seattle.gov/2012/11/09/marijwhatnow-a-guide-to-legal-marijuana-use-in-seattle/>.

<sup>4</sup> Bob Young, *Spokane Entrepreneur Now State’s First Legal Pot Grower*, SEATTLE TIMES (Mar. 5, 2014), [http://seattletimes.com/html/localnews/2023057620\\_firstlicensexml.html](http://seattletimes.com/html/localnews/2023057620_firstlicensexml.html).

<sup>5</sup> Bob Young et al., *Legal Pot Stores Open to Joyous Shoppers*, SEATTLE TIMES (July 8, 2014), [http://seattletimes.com/html/localnews/2024022679\\_storesopen2xml.html](http://seattletimes.com/html/localnews/2024022679_storesopen2xml.html).

<sup>6</sup> Andrea Noble, *Marijuana Legalization Measure Passes Easily in D.C.*, WASHINGTON TIMES (Nov. 4, 2014), <http://www.washingtontimes.com/news/2014/nov/4/dc-marijuana-legalization-measure-on-track-for-eas/>; Noelle Crombie, *Recreational Marijuana Passes in Oregon: Oregon Election Results 2014*, OREGONIAN (Nov. 4, 2014), [http://www.oregonlive.com/politics/index.ssf/2014/11/recreational\\_marijuana\\_passes.html](http://www.oregonlive.com/politics/index.ssf/2014/11/recreational_marijuana_passes.html); Suzanna Caldwell & Laurel Andrews, *Alaskans Vote To Legalize Marijuana*, ALASKA DISPATCH (Nov. 4, 2014), <http://www.adn.com/article/20141104/alaskans-vote-legalize-marijuana>.

is illegal.<sup>7</sup> It is well established that the Commerce Clause<sup>8</sup> and Supremacy Clause,<sup>9</sup> grant the federal government ultimate authority over commercial goods like marijuana.<sup>10</sup> This means that growing, selling, or possessing any amount of marijuana remains illegal under U.S. law, for now.<sup>11</sup>

Federal law-enforcement officials have responded cautiously when asked about their approach towards marijuana. The Obama Administration and the Office of National Drug Control Policy “remain committed to drug use prevention, treatment, support for recovery, and innovative criminal justice strategies to break the cycle of drug use and associated crime.”<sup>12</sup> The U.S. Department of Justice has indicated that it is committed to enforcing federal marijuana laws despite conflicting state legislation.<sup>13</sup> Its focus, however, is “guided” by limited priorities that include preventing distribution to minors, keeping revenues away from criminals, and preventing violence.<sup>14</sup> Beyond the identified priorities, “the federal government has traditionally relied on states and local law enforcement

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<sup>7</sup> 21 U.S.C. § 812 (2012). To be classified under Schedule I, there must be a finding that “(A) [t]he drug or other substance has a high potential for abuse”; “(B) [t]he drug or other substance has no currently accepted medical use in treatment in the United States”; and “(C) [t]here is a lack of accepted safety for use of the drug or other substance under medical supervision.” *Id.* Heroin is also a Schedule I drug while Cocaine is a Schedule II drug. *Id.*

<sup>8</sup> U.S. CONST. art. I, § 8, cls. 1, 3 (“The Congress shall have Power . . . [t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes . . .”).

<sup>9</sup> U.S. CONST. art. VI, cl. 2 (“This Constitution, and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.”).

<sup>10</sup> *See Gonzales v. Raich*, 545 U.S. 1 (2005) (holding that Congressional marijuana prohibition supersedes state legislature’s approval of medical marijuana); *Wickard v. Filburn*, 317 U.S. 111 (1942) (holding that Congress can regulate intrastate agricultural products grown for personal use).

<sup>11</sup> Members of Congress have begun introducing legislation to loosen federal marijuana restrictions. *See, e.g.*, Marijuana Businesses Access to Banking Act of 2013, H.R. 2652, 113th Cong. (2013); Respect State Marijuana Laws Act of 2013, H.R. 1523, 113th Cong. (2013); Truth in Trials Act, H.R. 710, 113th Cong. (2013); States’ Medical Marijuana Patient Protection Act, H.R. 689, 113th Cong. (2013); Industrial Hemp Farming Act of 2013, H.R. 525, 113th Cong. (2013); Marijuana Tax Equity Act of 2013, H.R. 501, 113th Cong. (2013); Ending Federal Marijuana Prohibition Act of 2013, H.R. 499, 113th Cong. (2013).

<sup>12</sup> Office of Nat’l Drug Control Policy, *Response to the New York Times Editorial Board’s Call for Federal Marijuana Legalization*, WHITE HOUSE (July 28, 2014), <http://www.whitehouse.gov/blog/2014/07/28/response-new-york-times-editorial-marijuana-legalization>.

<sup>13</sup> Memorandum from James M. Cole, Deputy Att’y Gen., U.S. Dep’t of Justice, for all United States Attorneys 1 (Aug. 29, 2013), *available at* <http://www.justice.gov/iso/opa/resources/3052013829132756857467.pdf>.

<sup>14</sup> *Id.* at 1–2.

agencies to address marijuana activity.”<sup>15</sup> Gil Kerlikowske, Commissioner of U.S. Customs and Border Protection and former director of the Office of National Drug Control Policy, indicated that federal enforcement will continue.<sup>16</sup> At the same time, Kerlikowske recognized that “we’re in the midst of a serious national conversation about marijuana.”<sup>17</sup>

Legalized recreational marijuana presents a new “vice” industry and poses serious concerns for public health and welfare.<sup>18</sup> Although some suggest that using marijuana may be safer than drinking alcohol, including President Obama, this does not mean that marijuana is safe.<sup>19</sup> Marijuana use carries numerous health risks and can lead to dependence or addiction.<sup>20</sup> The drug is especially harmful for teenagers,<sup>21</sup> who enter substance abuse treatment for marijuana more frequently than for any other drug problem, including alcohol.<sup>22</sup>

Nevertheless, as Sharon Foster, chair of the Washington State Liquor Control Board, said, “there’s one heckuva lot of interest in [Initiative]

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<sup>15</sup> *Id.* at 2.

<sup>16</sup> Brian Witte, *Drug Czar: Pot Legalization Won’t Change Mission*, DENVER POST (Apr. 25, 2013), [http://www.denverpost.com/breakingnews/ci\\_23094783/nations-drug-czar-outline-drug-policy-reform](http://www.denverpost.com/breakingnews/ci_23094783/nations-drug-czar-outline-drug-policy-reform); *The U.S. Drug Czar Weighs in on Canada’s Pot Habit*, MACLEAN’S (Feb. 11, 2013), <http://www.macleans.ca/politics/on-the-perils-of-pot-legalization-and-how-canada-creates-drug-problems-for-the-u-s/>.

<sup>17</sup> Gil Kerlikowske, *Addressing the Legalization of Marijuana*, WHITE HOUSE, <https://petitions.whitehouse.gov/response/addressing-legalization-marijuana>.

<sup>18</sup> See *Introduction to Part Two*, in THE POT BOOK 136, 136–37 (Julie Holland ed., 2010); PAMELA E. PENNOCK, ADVERTISING SIN AND SICKNESS 222–23 (2007).

<sup>19</sup> JONATHAN P. CAULKINS ET AL., MARIJUANA LEGALIZATION: WHAT EVERYONE NEEDS TO KNOW 77 (2012); see also PAUL ARMENTANO, NAT’L ORG. FOR THE REFORM OF MARIJUANA LAWS, CANNABIS AND DRIVING: A SCIENTIFIC AND RATIONAL REVIEW 2 (Sept. 12, 2011), available at <http://norml.org/library/item/cannabis-and-driving-a-scientific-and-rational-review>; *Introduction to Part Two*, *supra* note 18, at 136; David Remnick, *Going the Distance: On and off the Road with Barack Obama*, NEW YORKER, Jan. 27, 2014, at 40, 52; Eric W. Dolan, *Deputy Drug Czar Reluctantly Admits Marijuana Is Less Deadly Than Alcohol*, RAW STORY (Feb. 4, 2014), <http://www.rawstory.com/rs/2014/02/deputy-drug-czar-reluctantly-admits-marijuana-is-less-deadly-than-alcohol/>; Eric A. Morris, *Is It Safe to Be High on the Highway?*, FREAKONOMICS (Nov. 8, 2010), <http://www.freakonomics.com/2010/11/08/is-it-safe-to-be-high-on-the-highway/>.

<sup>20</sup> ROBIN ROOM ET AL., CANNABIS POLICY: MOVING BEYOND STALEMATE 152 (2010); CAULKINS ET AL., *supra* note 19, at 54, 59, 65–67; William Holubek, *Medical Risks and Toxicology*, in THE POT BOOK, *supra* note 18, at 141, 146–51; Caroline B. Marvin & Carl L. Hart, *Cannabis and Cognition*, in THE POT BOOK, *supra* note 18, at 161, 169–70; Cheryl Corcoran, *Mental Health Risks Associated with Cannabis Use*, in THE POT BOOK, *supra* note 18, at 178, 185–86; Ryan Vandrey & Margaret Haney, *How Real Is the Risk of Addiction?*, in THE POT BOOK, *supra* note 18, at 187, 195.

<sup>21</sup> ROOM ET AL., *supra* note 20, at 152.

<sup>22</sup> Leslie Walker & Inga Manskopf, *Marijuana Legalization: What Parents Can Say to Their Children*, SEATTLE CHILD. HOSP. RES. FOUND. (Dec. 5, 2012), <http://teenology101.seattlechildrens.org/marijuana-legalization-what-parents-can-say-to-their-children/>.

502.”<sup>23</sup> Support for legalization has steadily increased and more than half of Americans now believe that marijuana should be legalized.<sup>24</sup> In July 2014, The New York Times editorial board called upon Congress to legalize and regulate marijuana.<sup>25</sup> Lawmakers have been taking a serious look at legalization<sup>26</sup> while the marijuana industry has intensified its lobbying efforts.<sup>27</sup> Meanwhile, entrepreneurs around the country are planning to capitalize on this budding business.<sup>28</sup>

Economic estimates are unreliable given uncertainty about price, consumption rates, and state licensing revenues.<sup>29</sup> However, 25 to 30 million Americans<sup>30</sup> consume anywhere between 2,500<sup>31</sup> and 24,000<sup>32</sup> metric

<sup>23</sup> Bob Young, *Packed Hearing on New Pot Law*, SEATTLE TIMES (Jan. 24, 2013), [http://seattletimes.com/html/localnews/2020208834\\_potforumxml.html](http://seattletimes.com/html/localnews/2020208834_potforumxml.html).

<sup>24</sup> PEW RESEARCH CTR., MAJORITY NOW SUPPORTS LEGALIZING MARIJUANA 1 (Apr. 4, 2013), available at <http://www.people-press.org/files/legacy-pdf/44-13%20Marijuana%20Release.pdf>; CNN Poll: *Support for Legal Marijuana Soaring*, CNN (Jan. 6, 2014), <http://politicalticker.blogs.cnn.com/2014/01/06/cnn-poll-support-for-legal-marijuana-soaring/>; CAULKINS ET AL., *supra* note 19, at 140–42.

<sup>25</sup> *Repeal Prohibition, Again*, Editorial, N.Y. TIMES, SUNDAY REVIEW, July 27, 2014, at 1.

<sup>26</sup> See *supra* note 11 and accompanying text.

<sup>27</sup> See, e.g., Chris Moody, *A Day in the Life of a Marijuana Lobbyist*, YAHOO NEWS (Mar. 17, 2014), <http://news.yahoo.com/a-day-in-the-life-of-a-marijuana-lobbyist-023347656.html>; *Pot Lobby Is Growing in Olympia*, KING5.COM (Feb. 4, 2013), <http://www.king5.com/news/marijuana/PoP-lobby-is-growing-in-Olympia-189754531.html>.

<sup>28</sup> See, e.g., Keith Coffman, *Colorado Supreme Court Lets Lawyers Work with Marijuana Businesses*, REUTERS (Mar. 24, 2014), <http://www.reuters.com/article/2014/03/25/us-usa-marijuana-colorado-idUSBREA2O02920140325>; Tony Dokoupil, *Will Pot Barons Cash in on Legalization?*, NEWSWEEK (Oct. 22, 2012), <http://www.newsweek.com/will-pot-barons-cash-legalization-65259>; Andrew Tangel, *Wall Street Sees Opportunity in Marijuana*, L.A. TIMES (Mar. 23, 2013), <http://articles.latimes.com/2013/mar/23/business/la-fi-0324-wall-street-marijuana-20130324>; Bob Young, *Getting in on the Ground Floor of the Pot Business*, SEATTLE TIMES (Jan. 26, 2013), [http://seattletimes.com/html/localnews/2020222787\\_potinvestorsxml.html](http://seattletimes.com/html/localnews/2020222787_potinvestorsxml.html).

<sup>29</sup> Further complicating economic estimates, the cost of lost productivity due to marijuana legalization could end up being comparable to that of alcohol. See, e.g., Merle G. Paule et al., *Chronic Marijuana Smoke Exposure in the Rhesus Monkey II: Effects on Progressive Ratio and Conditioned Position Responding*, 260 J. PHARMACOLOGY & EXPERIMENTAL THERAPEUTICS 210, 210, 220 (1992). “The estimated economic cost of excessive drinking was \$223.5 billion in 2006 (72.2% from lost productivity, 11.0% from healthcare costs, 9.4% from criminal justice costs, and 7.5% from other effects).” Ellen E. Bouchery et al., *Economic Costs of Excessive Alcohol Consumption in the U.S., 2006*, 41 AM. J. PREVENTATIVE MED. 516, 516, 518–19 (2011). This drag on the economy could therefore dampen economic benefits that may result from legalization.

<sup>30</sup> CAULKINS ET AL., *supra* note 19, at 16; Eric Blumenson & Eva Nilson, *No Rational Basis: The Pragmatic Case for Marijuana Law Reform*, 17 VA. J. SOC. POL’Y & L. 43, 48 (2009).

<sup>31</sup> CAULKINS ET AL., *supra* note 19, at 23.

<sup>32</sup> ROOM ET AL., *supra* note 20, at 59.

tons of marijuana per year. Annual sales of marijuana are worth anywhere from \$10.5 billion<sup>33</sup> to \$46 billion<sup>34</sup> in the United States. Washington officials estimated state tax revenues as high as \$1,943,936,000 over five fiscal years.<sup>35</sup> Tax revenues in the first month of legal sales exceeded one million despite dwindling inventory.<sup>36</sup> Meanwhile, Colorado is on track to collect between \$30 million and \$40 million in 2014 through its taxed-and-regulated marijuana regime.<sup>37</sup> Oregon, Alaska, and Washington, D.C. voters decided to legalize marijuana in November 2014.<sup>38</sup> Given the figures and trends, national marijuana legalization is a realistic possibility.

Assuming that marijuana remains legal in Washington, what should a marijuana business call its particular product? Marijuana? Weed? Grass? Dope? Maui Wowie? White Widow? AK-47? Bob's Best Buds? This Paper helps answer this question by exploring the relevant policies, legal frameworks, and industry concerns around trademarks for marijuana in Washington.

To begin with, should a marijuana merchant even have trademark rights? Part I identifies the benefits and costs of trademark protection for marijuana. Trademark protection encourages healthy competition and consistent products, while reducing consumer search costs.<sup>39</sup> However, trademark protection entails drawbacks like encouraging advertising and

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<sup>33</sup> *Id.*

<sup>34</sup> Jonathan Martin, *Legal Marijuana: A \$46 Billion Industry?*, SEATTLE TIMES BLOG (Dec. 3, 2012), <http://blogs.seattletimes.com/politicsnorthwest/2012/12/03/legal-marijuana-a-46-billion-industry/>; see also CAULKINS ET AL., *supra* note 19, at 30; Chris Walsh, *Exclusive: US Medical Marijuana Sales to Hit \$1.5B in 2013, Cannabis Revenues Could Quadruple by 2018*, MARIJUANA BUS. DAILY (Mar. 21, 2013), <http://mmjbusinessdaily.com/us-medical-marijuana-sales-estimated-at-1-5b-in-2013-cannabis-industry-could-quadruple-by-2018/>.

<sup>35</sup> OFFICE OF FIN. MGMT., INITIATIVE 502 FISCAL IMPACT THROUGH FISCAL YEAR 2017 at 1 (Aug. 10, 2012), available at [http://www.ofm.wa.gov/ballot/2012/502\\_fiscal\\_impact.pdf](http://www.ofm.wa.gov/ballot/2012/502_fiscal_impact.pdf). But see Robert A. Mikos, *State Taxation of Marijuana Distribution and Other Federal Crimes*, 2010 U. CHI. LEGAL F. 223, 260–63 (arguing that state enforcement of marijuana taxation will be exceedingly difficult and will not solve budget problems); Bob Young, *Consultant: Tax Revenues on Pot Won't Be Half of What's Projected*, SEATTLE TIMES BLOG (Mar. 29, 2013), <http://blogs.seattletimes.com/today/2013/03/consultant-tax-revenues-on-pot-wont-be-half-of-whats-projected/>.

<sup>36</sup> David Wasson, *Pot Taxes Top \$1 Million in First Month*, SPOKESMAN-REVIEW (Aug. 8, 2014), <http://www.spokesman.com/stories/2014/aug/08/pot-taxes-top-1-million-first-month/>.

<sup>37</sup> See Kelly Phillips Erb, *It's No Toke: Colorado Pulls in Millions in Marijuana Tax Revenue*, FORBES (Mar. 11, 2014), <http://www.forbes.com/sites/kellyphillipserb/2014/03/11/its-no-toke-colorado-pulls-in-millions-in-marijuana-tax-revenue/>; Daniel Wallis, *Six Months After Marijuana Legalization: Colorado Tax Revenue Skyrockets as Crime Falls*, RAWSTORY.COM (July 3, 2014), <http://www.rawstory.com/rs/2014/07/03/six-months-after-marijuana-legalization-colorado-tax-revenue-skyrockets-as-crime-falls/>.

<sup>38</sup> *Supra* note 6.

<sup>39</sup> See *infra* Part I.A.

restricting competitors' use of trademarked terms.<sup>40</sup> Despite the drawbacks, Part I concludes that if marijuana is legal, then the benefits of marijuana trademark protection outweigh the costs.

Assuming trademark protection is allowed, how does a merchant acquire such protection with a product that is illegal under federal law? Part II identifies how Washington marijuana producers, processors, and retailers might acquire trademark protection. Although federal trademark protection is currently unavailable for marijuana products,<sup>41</sup> Washington recognizes both common-law and registration-based trademark protection.<sup>42</sup> While a businessperson may be reluctant to file a public document announcing that she sells marijuana, public disclosures are required to legally operate a marijuana business<sup>43</sup> and will be necessary to enforce marijuana trademark rights in a lawsuit.<sup>44</sup> Anyone serious about entering the marijuana business should already expect to make her whereabouts well known to the authorities. State trademark registration is therefore a prudent option for merchants seeking trademark protection.<sup>45</sup>

So what shall a marijuana merchant call its products? Part III explores arguments about what sorts of marijuana trademarks could be protectable, given the colorful history of this controversial plant. An official catalogue of recognized marijuana plant varieties would be invaluable in preventing unfair competition among marijuana merchants. Ultimately, this Paper argues that an understanding of marijuana species, genetic strains, and slang is necessary to properly assess trademark rights and establish brands in the new marijuana marketplace.

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<sup>40</sup> See *infra* Part I.B.

<sup>41</sup> See *infra* Part II.A.

<sup>42</sup> See *infra* Part II.B–C.

<sup>43</sup> WASH. ADMIN. CODE §§ 314-55-015 to 314-55-155 (West, WestlawNext through Dec. 2013).

<sup>44</sup> See, e.g., WASH. CT. C.R. 10(a).

<sup>45</sup> The risk of federal enforcement is real. Federal officers have shown no hesitation seeking state medical-marijuana records for prosecutorial purposes in states where medical marijuana is legal. See, e.g., David Downs, *Feds' Marijuana Fishing Expedition Called off in Mendocino County*, EAST BAY EXPRESS (Apr. 10, 2013), <http://www.eastbayexpress.com/LegalizationNation/archives/2013/04/10/feds-marijuana-fishing-expedition-called-off-in-mendocino-county>; Jake Ellison, *Feds Scoop Up Medical Marijuana Patient Records in Oregon Investigation*, SEATTLE PI (Apr. 11, 2013), <http://blog.seattlepi.com/marijuana/2013/04/11/feds-scoop-up-medical-marijuana-patient-records-in-oregon-investigation/>; Stuart Taylor, Jr., *Marijuana Policy and Presidential Leadership*, GOVERNANCE STUD. BROOKINGS 11–12 (Apr. 2013), [http://www.brookings.edu/~media/research/files/papers/2013/04/11%20marijuana%20legalization%20taylor/marijuana%20policy%20and%20presidential%20leadership\\_v27.pdf](http://www.brookings.edu/~media/research/files/papers/2013/04/11%20marijuana%20legalization%20taylor/marijuana%20policy%20and%20presidential%20leadership_v27.pdf).

## I. BENEFITS AND COSTS OF TRADEMARK PROTECTION FOR MARIJUANA

A trademark is any word, name, symbol, device, or combination thereof that identifies and distinguishes goods in commerce, and indicates the source of goods.<sup>46</sup> Trademarks are valuable to consumers because trademarks can signal that goods originate from a common source and are of consistent quality, which lowers the search costs associated with locating desired goods.<sup>47</sup> Trademark protections are valuable to merchants because they give merchants exclusive rights to use marks that consumers may recognize and prefer.<sup>48</sup> Receiving exclusive rights over recognized marks rewards merchants for producing quality products and cultivating good will.<sup>49</sup>

So why should trademark law apply to marijuana products? The legal framework for recreational marijuana sales and business competition is undeveloped because marijuana is a unique and partly illegal product. There are costs and benefits with trademark protections that deserve consideration before presuming that trademark protections should apply to any undeveloped industry. This Section contends that, similar to other industries, the benefits of trademark protection outweigh the costs when considering policy goals surrounding the marijuana industry.

### A. *Benefits of Trademark Protection for Marijuana*

The positive functions of trademark law will benefit the marijuana industry and marijuana consumers in two primary ways. First, trademarks will encourage healthy competition among marijuana merchants because trademarks allow merchants to cultivate brand recognition around the quality of their trademarked products. Second, as consumers recognize trademarked marijuana, those consumers face fewer search costs when they seek familiar quality marijuana.

#### 1. *Trademark Protection Encourages Healthy Competition*

Trademark law's identifying and distinguishing functions are valuable to a merchant because they allow her to distinguish her goods from

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<sup>46</sup> 15 U.S.C. § 1127 (2012); WASH. REV. CODE § 19.77.010(10) (2012).

<sup>47</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 2:14–15 (4th ed. 2014).

<sup>48</sup> *Id.* §§ 3:2, 3:5. “A finding of unfair competition or false designation of origin under the Lanham Act, 15 U.S.C. § 1125(a), may entitle the plaintiff to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.” *Nat'l Prods., Inc. v. Aqua Box Prods., LLC*, No. C12-0605-RSM, 2013 WL 1399346, at \*2 (W.D. Wash. Apr. 5, 2013) (order denying defendants' motion for summary judgment). Remedies for trademark infringement in Washington provide a similar standard for relief, WASH. REV. CODE § 19.77.150, and courts treat the analysis the same. *Id.* § 19.77.930.

<sup>49</sup> 1 MCCARTHY, *supra* note 47, §§ 3:2, 3:5.

those sold by others.<sup>50</sup> If a merchant cannot distinguish her goods in the marketplace, then satisfied consumers have no easy way of finding that merchant's goods again for repeat purchases.<sup>51</sup> Meaningful competition does not exist in an undifferentiated market because every unbranded product appears the same.<sup>52</sup> Without trademarks, merchants have no reliable mechanism for standing out and therefore have less incentive to produce goods of consistent quality.<sup>53</sup>

If merchants can distinguish their goods through trademarks, then consumers can make more-informed choices about the goods they purchase.<sup>54</sup> As consumers associate a trademark with certain consistent qualities, word-of-mouth spreads, the trademark develops good will, and consumers purchase additional goods bearing that trademark.<sup>55</sup> When a merchant receives exclusive trademark rights, she receives the exclusive right to reap financial- and reputation-related rewards for having developed good will around her trademark.<sup>56</sup> This encourages merchants to produce consistent desirable qualities in goods bearing their trademark.<sup>57</sup>

In the marijuana industry, as in other industries, trademark protection will allow merchants to enjoy rewards from expending resources to develop consumer good will. Given the varieties of distinct marijuana plants and growers, it will be difficult for merchants to establish themselves if they sell undifferentiated marijuana.<sup>58</sup> However, if marijuana merchants can enjoy profits from establishing good will with their trademarked marijuana brands, then merchants have an economic incentive to improve their marijuana. Such healthy competitive motivation will tend to improve the consistency and desirable qualities of marijuana.

There are many variables in marijuana production and many ways to alter marijuana's quality.<sup>59</sup> These include but are not limited to seeds,<sup>60</sup> breeding,<sup>61</sup> growing medium, fertilizer, light, pest control,<sup>62</sup> sustainable or

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<sup>50</sup> *Id.*

<sup>51</sup> William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987).

<sup>52</sup> *Smith v. Chanel, Inc.*, 402 F.2d 562, 566 (9th Cir. 1968).

<sup>53</sup> Landes & Posner, *supra* note 51, at 270.

<sup>54</sup> *Id.* at 269.

<sup>55</sup> *Id.* at 270.

<sup>56</sup> 1 MCCARTHY, *supra* note 47, §§ 2:14–15; *Qualitex Co. v. Jacobson Prods. Co. Inc.*, 514 U.S. 159, 163–64 (1995).

<sup>57</sup> 1 MCCARTHY, *supra* note 47, §§ 3:2, 3:5.

<sup>58</sup> CAULKINS ET AL., *supra* note 19, 154–55.

<sup>59</sup> As in all agriculture, the seeds, soil, nutrients, fertilizer, light, and pruning affect the final qualities of different crops. TOMMY MCCARTHY, *GROWING MARIJUANA* 14, 28, 36, 58 (2011).

<sup>60</sup> *Id.* at 14.

<sup>61</sup> See, e.g., 1 CANNABIS SATIVA: THE ESSENTIAL GUIDE TO THE WORLD'S FINEST MARIJUANA STRAINS ix–x (S. T. Oner ed., 2012) [hereinafter 1 CANNABIS SATIVA].

<sup>62</sup> JORGE CERVANTES, *MARIJUANA HORTICULTURE: THE INDOOR/OUTDOOR MEDICAL GROWER'S BIBLE* 137, 143, 170 (2002); MCCARTHY, *supra* note 59, at 105–11.

organic growing practices,<sup>63</sup> improved delivery, refined packaging, and cultivating reliable potency.<sup>64</sup> Granting trademark protection for marijuana will encourage merchants to develop consistent desirable qualities to increase their good will and profits.

Encouraging marijuana merchants to develop consistent quality will also advance the policy goal of improving our understanding of marijuana's effects.<sup>65</sup> Lack of consistency has made it difficult for researchers to determine the health risks of marijuana among longitudinal studies.<sup>66</sup> The product consistency that trademark protection encourages will help researchers to more accurately study marijuana and the health effects of marijuana use.<sup>67</sup>

Furthermore, trademarks that indicate consistent-quality marijuana can help consumers gauge marijuana intoxication. While marijuana may not impair individuals as severely as alcohol, driving stoned is dangerous.<sup>68</sup> With more consistent trademarked marijuana, consumers will be better able to predict impairment and less likely to make bad decisions by miscalculating potency.

It is important to note that trademark law encourages, but does not require, good or consistent quality. Instead, regulated quality assurance and laboratory testing programs can help ensure reliable quality and potency.<sup>69</sup> Nevertheless, trademark law does create incentives for merchants to establish consistent-quality marijuana products.

## 2. *Trademarks Help Consumers by Reducing Search Costs*

Trademarks are valuable because they can signal to consumers that certain goods originate from a common merchant and are of equal quality to goods with the same mark.<sup>70</sup> If merchants demonstrate consistent quality with their trademarked goods, then consumers can rely on the trademark as a shorthand proxy for more-detailed information about those goods.<sup>71</sup> Such informed consumers can easily find the qualities that they seek when shopping for goods. Thus, trademarks reduce consumer

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<sup>63</sup> See generally SEYMOUR KINDBUD, *GREEN WEED: THE ORGANIC GUIDE TO GROWING HIGH QUALITY CANNABIS* (2010).

<sup>64</sup> See CAULKINS ET AL., *supra* note 19, at 28; Julie Holland, *The Government's Pot Farm*, in *THE POT BOOK*, *supra* note 18, at 266, 269–71.

<sup>65</sup> CAULKINS ET AL., *supra* note 19, at 55.

<sup>66</sup> *Id.* at 54–56.

<sup>67</sup> See *id.* at 55; Matthew G. Kirkpatrick & Carl L. Hart, *The Subjective Effects of Cannabis*, in *THE POT BOOK*, *supra* note 18, at 9, 11–16.

<sup>68</sup> ARMENTANO, *supra* note 19, at 2; CAULKINS ET AL., *supra* note 19, at 77–79; MORRIS, *supra* note 19.

<sup>69</sup> See WASH. ADMIN. CODE § 314-55-102 (West, WestlawNext through Dec. 2013); see also 1 JAMES T. O'REILLY, *FOOD AND DRUG ADMINISTRATION* § 13:1 (3d ed. 2007). To become acceptable as medicine under federal law, marijuana must become even more reliable: chemistry must be known and reproducible and controlled studies of efficacy and safety must be available and evaluated by experts. 21 U.S.C. § 355 (2012).

<sup>70</sup> 1 MCCARTHY, *supra* note 47, § 3:2.

<sup>71</sup> See Landes & Posner, *supra* note 51, at 269.

“search costs” or the time and effort required to find a desired good.<sup>72</sup> For example, if a certain size of pants with the X trademark fit the consumer, and if X brand pants are of consistent quality, then the consumer need not waste time searching for pants that fit. The consumer may instead rely on the X trademark as a signal of desirable qualities for his size. This saves the search costs of driving to the store, comparing different fits, inadvertently choosing an inferior pair, and then needing a refund for undesirable pants.

The search costs for marijuana consumers—and medical-marijuana patients in particular—are more serious than for other goods because marijuana is a drug of variable potency that consumers put into their bodies. Cannabis contains many chemicals and at least 85 different cannabinoids that produce different physical and psychological effects. Scientists believe that the main source of potency causing a marijuana “high” is the psychoactive ingredient delta-9-tetrahydrocannabinol (“THC”).<sup>73</sup> However, further research is necessary to understand the chemical interactions and complex effects of different types of marijuana on different people. Potency varies greatly depending upon species, genetic strains, growing conditions, THC content, and other cannabinoids.<sup>74</sup> Unexpectedly potent marijuana can catch both new and experienced users off guard, causing intense anxiety and panic attacks.<sup>75</sup> Without a trustworthy signal of consistency, there is no truly reliable way of judging potency,<sup>76</sup> and consumers must absorb the search costs associated with selecting unfamiliar marijuana. Again, some sort of regulated testing and labeling regime could more effectively establish consistency for consumers. However, with trademarks for marijuana, consumer search costs will certainly be reduced.

Additionally, regardless of one’s view on marijuana and its effects, one must concede that millions of people derive pleasure and enjoyment from using marijuana.<sup>77</sup> Pleasure and enjoyment therefore deserve considerable weight when discussing marijuana policy. Just as pleasure and enjoyment shapes regulations for risky activities like professional football, skiing, mountain climbing, motorcycle racing, or drinking alcohol, so too should pleasure and enjoyment shape our reception of marijuana laws.<sup>78</sup>

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<sup>72</sup> *Id.*

<sup>73</sup> CAULKINS ET AL., *supra* note 19, at 6–7; Gregory L. Gerdeman & Jason B. Schechter, *The Endocannabinoid System*, in THE POT BOOK, *supra* note 18, at 52, 53.

<sup>74</sup> CAULKINS ET AL., *supra* note 19, at 8–9.

<sup>75</sup> *Id.* at 6; Kirkpatrick & Hart, *supra* note 67, at 9; *Cannabis Effects*, EROWID (Mar. 24, 2014), [http://www.erowid.org/plants/cannabis/cannabis\\_effects.shtml](http://www.erowid.org/plants/cannabis/cannabis_effects.shtml); see also Maureen Dowd, *Don’t Harsh Our Mellow*, *Dude*, N.Y. TIMES (June 3, 2014), [http://www.nytimes.com/2014/06/04/opinion/dowd-dont-harsh-our-mellow-dude.html?\\_r=0](http://www.nytimes.com/2014/06/04/opinion/dowd-dont-harsh-our-mellow-dude.html?_r=0).

<sup>76</sup> CAULKINS ET AL., *supra* note 19, at 11.

<sup>77</sup> *Id.* at 91; see also Jeremy Wolff, *Thots on Pot*, in THE POT BOOK, *supra* note 18, at 387–94.

<sup>78</sup> CAULKINS ET AL., *supra* note 19, at 92.

Given this, it is important to note that different strains of marijuana can lead to different psychoactive “highs.”<sup>79</sup> Some strains of the plant give users soothing or relaxing feelings.<sup>80</sup> Other strains may cause clear thinking or productivity.<sup>81</sup> Given the lack of scientific studies on the non-medical benefits of marijuana, little is known about mechanisms behind the psychoactive pleasures that millions of users enjoy.<sup>82</sup>

With these variable effects in mind, trademarks offer one method for consumers to reduce the search costs associated with selecting a marijuana product.<sup>83</sup> For example, if a marijuana merchant establishes a consistent reputation for cheerful effects under its trademark HAHA, and consumers learn of that reputation, then consumers have fewer search costs when seeking those cheerful effects. Consumers thereby avoid the undesirable costs of selecting a marijuana variety that causes drowsiness instead.

### *B. Costs of Trademark Protection for Marijuana*

While allowing trademark protection offers substantial benefits, it also entails certain costs. First, trademarks will encourage marijuana advertising. Such ads could be a nuisance and may lead to increased marijuana usage by young people. Second, trademarks will restrict the scope of merchants’ vocabulary for labeling marijuana products. This could have particularly profound anticompetitive effects in the long-existing, but newly-legal market for marijuana.

#### *1. Trademarks Encourage Advertising*

Businesses with trademarked marijuana will advertise to develop good will and loyal consumers for their brand.<sup>84</sup> As with other industries, advertising will have undesirable consequences. Marijuana ads could be obnoxious, just like the multitude of ads that we see every day for beer, fast food, and other unhealthy products. Additionally, because advertising attracts new consumers,<sup>85</sup> unrestricted marijuana ads may increase marijuana use.

It is nevertheless possible to maintain the benefits of trademarks while avoiding the worst consequences of advertising through education programs and thoughtful regulations for marijuana ads. Regulating

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<sup>79</sup> *Id.* at 5.

<sup>80</sup> *Id.*; MCCARTHY, *supra* note 59, at 18; *Indica Cannabis Strains*, LEAFLY (2014), <http://www.leafly.com/indica>.

<sup>81</sup> CAULKINS ET AL., *supra* note 19, at 5; MCCARTHY, *supra* note 59, at 19; *Sativa Cannabis Strains*, LEAFLY (2014), <http://www.leafly.com/sativa>; *see also* 1 CANNABIS SATIVA, *supra* note 61, at 190; 2 CANNABIS SATIVA: THE ESSENTIAL GUIDE TO THE WORLD’S FINEST MARIJUANA STRAINS 134, 138 (S. T. Oner ed., 2013).

<sup>82</sup> CAULKINS ET AL., *supra* note 19, at 82.

<sup>83</sup> *See* Jeffrey Hergenrather, *Prescribing Cannabis in California*, in *THE POT BOOK*, *supra* note 18, at 416, 425.

<sup>84</sup> CAULKINS ET AL., *supra* note 19, at 169.

<sup>85</sup> PENNOCK, *supra* note 18, at 84, 86.

“vice” industries generates policy tensions between free speech, government overregulation, temperance, public health, and morality.<sup>86</sup> The decades-old controversy over cigarette and alcohol marketing exemplifies Americans’ wavering discomfort with advertising in general and questions about how society compartmentalizes its hedonism and consumption of intoxicants.<sup>87</sup> Regardless of the policy challenges, balanced legal intervention through regulation and education has become an acceptable way to limit the negative consequences of cigarette and alcohol advertising.<sup>88</sup>

Advertising restrictions and education programs could apply analogously to marijuana. Indeed, Washington has placed strict size-and-location limitations on retail marijuana signage, prohibiting the public display of useable marijuana.<sup>89</sup> Retailers are allowed no more “than a single sign no larger than one thousand six hundred square inches identifying the retail outlet by the licensee’s business or trade name.”<sup>90</sup> While not prohibited altogether, marijuana ads are not allowed within 1,000 feet of certain places where young people congregate, including public transit, public property, school grounds, playgrounds, recreation centers, child care centers, public parks, libraries, and “any game arcade admission to which is not restricted to persons aged twenty-one years or older,”<sup>91</sup> “through any medium whatsoever.”<sup>92</sup> Health warnings are required on all marijuana advertising.<sup>93</sup> Advertising cannot promote overconsumption, consumption for “curative” effects, or consumption by minors.<sup>94</sup> While the exact parameters of advertising restrictions are debatable, sensible regulations can alleviate the negative side effects from advertising while maintaining the benefits of trademark rights.

## 2. Trademark Protection Restricts the Use of Trademarked Terms

Merchants who first acquire rights to marijuana trademarks will be able to prevent later merchants from using those marks for marijuana

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<sup>86</sup> *Id.* at 4–5.

<sup>87</sup> *Id.* at 222.

<sup>88</sup> *Id.* at 224–25.

<sup>89</sup> WASH. REV. CODE ANN. § 69.50.357 (West Supp. 2014).

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* § 69.50.369. These advertising restrictions may be vulnerable to Constitutional challenges for unfairly restricting free speech. *See Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 565 (2001) (holding state law prohibiting tobacco advertising within 1,000 feet of playgrounds, parks, and schools violated the First Amendment). *But see Discount Tobacco City & Lottery, Inc. v. United States*, 674 F.3d 509, 518 (6th Cir. 2012) (upholding restrictions on the marketing and packaging of tobacco products), *cert. denied sub nom. Am. Snuff Co. v. United States*, 133 S. Ct. 1996 (2013).

<sup>92</sup> WASH. ADMIN. CODE § 314-55-155 (West, WestlawNext through Dec. 2013).

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

and related products or services.<sup>95</sup> This could give earlier merchants an unfair advantage. In particular, because marijuana is not legal nationally, businesses in Washington (and Colorado) have a head start in branding their marijuana products before merchants in other states.

There is also a strong likelihood that merchants will attempt to trademark existing marijuana slang terms or genetic strains. To permit exclusive trademark rights over a descriptive or generic name “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”<sup>96</sup> The risk of such monopolies on descriptive or generic terms for marijuana is especially high because of marijuana’s deep cultural penetration,<sup>97</sup> robust slang lexicon,<sup>98</sup> and the panoply of silly names selected by breeders for discrete strains of the cannabis plant.<sup>99</sup> For example, if a business can own the trademark for a commonly known slang term like “ganja,”<sup>100</sup> then it can monopolize preexisting cultural recognition of that term and prevent competitors from calling their marijuana products “ganja.” Alternatively, a marijuana merchant could trademark a genetic strain or species of the genus can-

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<sup>95</sup> A trademark owner can prevent others from using a mark if there is a likelihood of confusion between the owner’s use of the mark and the others’ unauthorized use of the mark. *See Goto.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000). Upon weighing factors including: (1) “the similarity of the marks”; (2) the relatedness of the products or services; (3) “the marketing channels used”; (4) the strength of the mark; (5) defendant’s intent; (6) “evidence of actual confusion”; (7) “the likelihood of expansion into other markets”; and (8) “the degree of care likely to be exercised by purchasers,” courts have the power to enjoin and impose damages for trademark use that confuses customers about the source of the products. *Id.*

<sup>96</sup> *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975) (Judge Friendly explaining the policy reasons for disallowing trademark protection of generic terms).

<sup>97</sup> Cannabis has been used by humans for over 4,000 years. CAULKINS ET AL., *supra* note 19, at 18; *see also* JAMES H. MILLS, CANNABIS BRITANNICA 1 (2003) (citing references to “Bangué,” “Bang,” and “Ganja,” in English language publications from 1745 and 1804). Open cannabis consumption in western society has become relatively common. *See, e.g.*, JACK KEROUAC, ON THE ROAD (Penguin Books 1999) (1957); HUNTER S. THOMPSON, FEAR AND LOATHING IN LAS VEGAS (2d Vintage Books ed. 1998); A CHILD’S GARDEN OF GRASS: A PRE-LEGALIZATION COMEDY (Elektra 1971); CHEECH AND CHONG’S UP IN SMOKE (Paramount Pictures 1978); DR. DRE, THE CHRONIC (Death Row Records 1992); PINEAPPLE EXPRESS (Sony Pictures 2008).

<sup>98</sup> *See, e.g.*, *Drug Fact Sheet: Marijuana*, DRUG ENFORCEMENT ADMIN. (2012), available at [http://www.justice.gov/dea/druginfo/drug\\_data\\_sheets/Marijuana.pdf](http://www.justice.gov/dea/druginfo/drug_data_sheets/Marijuana.pdf).

<sup>99</sup> A small selection of apparently distinct strains includes “Alaskan Thunder Fuck,” “Green Crack Extreme,” “Willie Nelson,” “Afghani Bullrider,” “Afgooye,” “Cheese Quake,” “Hog’s Breath,” “Blueberry Cheesecake,” “Exodus Cheese,” “Green Monster,” “Martian Mean Green,” “Strawberry Diesel,” “Tiger Woods,” and “Warlock.” *Sativa Cannabis Strains*, *supra* note 81; *Indica Cannabis Strains*, *supra* note 80; *Hybrid Cannabis Strains*, LEAFLY (2014), <http://www.leafly.com/hybrid>.

<sup>100</sup> *Marijuana*, DRUGFREE.ORG (2014), <http://www.drugfree.org/drug-guide/marijuana>.

nabis, such as “Indica,”<sup>101</sup> thereby monopolizing the name of the plant itself.

This monopolization problem can be avoided while preserving the benefits of trademark rights if examiners and courts formally recognize marijuana slang, species, and genetic strains as generic and descriptive terms.<sup>102</sup> Under existing trademark doctrine, generic terms, descriptive terms, and plant varietal names are not protectable.<sup>103</sup> Thus, if courts and examiners learn to recognize when trademark applicants claim such unprotectable marijuana-related terms, then no trademark applicant can unfairly monopolize the existing marijuana vocabulary.

### C. *The Benefits of Trademark Protection Outweigh the Costs*

Merchants should be able to obtain protection for the trademarks that distinguish their goods. The policies of encouraging fair competition and lowering search costs are as compelling for marijuana products as for any other vice industry.<sup>104</sup> The negative consequences of trademark protection can and should be addressed in other ways. While concerns about marijuana advertising are substantial, other vice advertisements and media portrayals of marijuana already pervade American society.<sup>105</sup> Marijuana ads will not change that. Advertising can certainly be regulated in a manner analogous to cigarette and alcohol industries. The potential for monopolies on marijuana terms can also be avoided. With more information about marijuana, trademark examiners and courts can easily prevent businesses from unfairly monopolizing marijuana-related terms. On balance, the benefits of incentivizing consistent quality and reducing search costs outweigh the negative side effects of allowing trademarks for marijuana.

## II. ACQUIRING TRADEMARK PROTECTION FOR MARIJUANA IN WASHINGTON

Granting that marijuana should be subject to trademark law, how can a marijuana merchant secure trademark rights for his product? This Section will present the various possibilities for securing trademark protection. Currently, federal trademark applications for marijuana products will be rejected because marijuana remains illegal under federal law. If a

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<sup>101</sup> *Indica Cannabis Strains*, *supra* note 80.

<sup>102</sup> *See infra* Part III.A.

<sup>103</sup> *In re Pennington Seed, Inc.*, 466 F.3d 1053, 1057 (Fed. Cir. 2006) (quoting *In re Hilltop Orchards & Nurseries, Inc.*, 206 U.S.P.Q. (BNA) 1034, 1036 (T.T.A.B. 1979)).

<sup>104</sup> Washington House Representative Jeff Morris recognized the likelihood of marijuana trademarks by proposing a bill to specifically tax trademarks and other intellectual property “related to marijuana.” H.B. 1976, 63d Leg., 2013 Reg. Sess. (Wash. 2013).

<sup>105</sup> PENNOCK, *supra* note 18, at 3–4; *see also supra* note 97 and accompanying text.

mark is used in commerce without violating the Controlled Substances Act and if the mark meets all requirements of the Lanham Act, then the applicant may trademark products related to marijuana but they cannot secure national trademark protection for marijuana itself. While marijuana merchants cannot protect marijuana trademarks nationally, they can acquire state trademark protection. For many industries in today's interstate and international economy, single-state trademark registrations "do not add significant value . . . when compared to other civil enforcement options."<sup>106</sup> However, in Washington, marijuana merchants can acquire valuable state-wide rights to marijuana trademarks by using those marks in legal, state-wide commerce. Finally, if a marijuana merchant is willing to risk informing the state that she sells marijuana, as required to legally sell marijuana in Washington, then the merchant would be wise to also seek the benefits of state trademark registration.

A. *Federal Law Does Not Protect Marijuana Trademarks*

The Lanham Trademark Act can protect any word, name, symbol, or device used to identify and distinguish goods in commerce.<sup>107</sup> A federal application for trademark registration requires the applicant to list the goods on which the mark is used,<sup>108</sup> the classification of the goods,<sup>109</sup> and the date on which the merchant first used the trademark in commerce in association with the goods or services.<sup>110</sup> However, a merchant's use of the trademark must be in *lawful* commerce.<sup>111</sup> To allow registration of marks used in unlawful commerce would put the federal government in the "anomalous position" of extending the benefits of trademark protection for commerce that violates federal law.<sup>112</sup>

If a trademark applicant's use of the mark in commerce is not lawful, then registration will be denied.<sup>113</sup> When the United States Patent and

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<sup>106</sup> Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 CARDOZO ARTS & ENT. L.J. 597, 598 (2011).

<sup>107</sup> 15 U.S.C. § 1125(a) (2012).

<sup>108</sup> 37 C.F.R. § 2.32(a) (2013).

<sup>109</sup> *Id.*

<sup>110</sup> 15 U.S.C. § 1051(a)(2).

<sup>111</sup> TMEP § 907 (5th ed. Sept. 2007); *see* 37 C.F.R. § 2.69; *see also* *CreAgri, Inc. v. USANA Health Scis., Inc.*, 474 F.3d 626, 630–31, 634 (9th Cir. 2007) (denying protection for a dietary supplement trademark, "Olivenol," because of federal labeling law violations).

<sup>112</sup> *CreAgri*, 474 F.3d at 630; *see also* 37 C.F.R. § 2.69; TMEP, *supra* note 111, § 907.

<sup>113</sup> *See, e.g., CreAgri*, 474 F.3d at 634 ("Olivenol" dietary supplement violated federal labeling laws.); *In re* Midwest Tennis & Track Co., 29 U.S.P.Q.2d (BNA) 1386, 1386–87 (T.T.A.B. 1993) ("OLYMPIAN GOLDE" name for athletic track and field surface constituted unlawful use of the Olympic symbol.); *Clorox Co. v. Armour-Dial, Inc.*, 214 U.S.P.Q. (BNA) 850, 851–52 (T.T.A.B. 1982) ("ALIVE" toilet soap violated federal labeling laws.); *In re* Pepcom Indus., Inc., 192 U.S.P.Q. (BNA) 400, 401–02 (T.T.A.B. 1976) ("JIN.SENG" failed to prove compliance with federal labeling laws.);

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Trademark Office (USPTO) evaluates trademark applications, the USPTO's examining attorney "may inquire about compliance with federal laws to confirm that the applicant's use of the mark in commerce is lawful."<sup>114</sup> Usually the USPTO "presumes that an applicant's use is . . . lawful" unless some evidence "shows a clear violation of law, such as the sale or transportation of a controlled substance."<sup>115</sup>

On April 1, 2010, the USPTO created a trademark classification for, "[p]rocessed plant matter for medicinal purposes, namely medical marijuana."<sup>116</sup> It apparently was not an April Fool's prank<sup>117</sup> because the classification was removed three months later, and a USPTO spokesman said, "[i]t was a mistake."<sup>118</sup> The Director of the Trademark Office does have authority to establish classifications of goods for the USPTO's convenience.<sup>119</sup> However, there is no record of this marijuana classification on the USPTO website,<sup>120</sup> the federal register,<sup>121</sup> or the Code of Federal regulations.<sup>122</sup> The official list of international trademark classifications<sup>123</sup> was updated in 2007<sup>124</sup> and 2012<sup>125</sup> without intervening evidence of a new trademark classification for marijuana. At least one other researcher was also unable to confirm further details about the medical-marijuana classification.<sup>126</sup> However, while the classification existed, the USPTO appar-

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*In re Stellar Int'l, Inc.*, 159 U.S.P.Q. (BNA) 48, 52 (T.T.A.B. 1968) ("JETFRESH" aerosol mouth freshener violated federal labeling laws.).

<sup>114</sup> TMEP, *supra* note 111, § 907.

<sup>115</sup> *Id.*

<sup>116</sup> Justin Scheck, *Patent Office Raises High Hopes, Then Snuffs Them Out*, WALL ST. J., July 19, 2010, at A1 (internal quotation marks omitted); see also Jacob Goldstein, *From Acapulco Gold to Albino Rhino: The Marijuana Trademark Land Rush*, NPR PLANET MONEY (July 19, 2010), <http://www.npr.org/blogs/money/2010/07/19/128616585>.

<sup>117</sup> Laurel Sutton, *Don't Bogart That Name: Medical Marijuana Trademarks*, FAST COMPANY (Aug. 5, 2010), <http://www.fastcompany.com/1677722/dont-bogart-name-medical-marijuana-trademarks>.

<sup>118</sup> Scheck, *supra* note 116, at A1 (internal quotation marks omitted).

<sup>119</sup> 15 U.S.C. § 1112 (2012).

<sup>120</sup> This was determined by performing a Google search for "site:uspto.gov medical marijuana trademark."

<sup>121</sup> This was determined by performing an advanced article search for either "marijuana" or "cannabis," limited to the Patent and Trademark Office, through <https://www.federalregister.gov>.

<sup>122</sup> This was determined by performing searches for either "marijuana" or "cannabis," within the Code of Federal Regulations, through the WestlawNext and Legal Information Institute, <http://www.law.cornell.edu/>, databases.

<sup>123</sup> 37 C.F.R. § 6.1 (2013).

<sup>124</sup> International Trademark Classification Changes, 72 Fed. Reg. 28,610, 28,611 (May 22, 2007) (codified at 37 C.F.R. pt. 6).

<sup>125</sup> International Trademark Classification Changes, 77 Fed. Reg. 47,528, 47,529 (Aug. 9, 2012) (codified at 37 C.F.R. pt. 6).

<sup>126</sup> Sutton, *supra* note 117.

ently received 250 marijuana-related trademark applications, and 57 applications listing the new class.<sup>127</sup>

Regardless of marijuana's ongoing illegality, audacious applicants have tried or are trying to register marijuana trademarks with the federal government.<sup>128</sup> These are currently doomed to fail, given the USPTO's lawful-commerce requirement and marijuana's Schedule I status under the Controlled Substances Act.<sup>129</sup>

Merchants also continue to file marijuana-related trademark applications, with varying success, for goods and services aside from marijuana itself.<sup>130</sup> In many of these cases, the USPTO examining attorney requires applicants to "submit a written statement indicating whether the goods and/or services identified in the application comply with the Controlled Substances Act."<sup>131</sup> Failure to comply with the examining attorney's re-

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<sup>127</sup> Scheck, *supra* note 116; *see, e.g.*, U.S. Trademark Application Serial No. 85,049,702 (filed May 27, 2010) ("MAUI WOWIE" application abandoned); U.S. Trademark Application Serial No. 85,082,010 (filed July 10, 2010) ("420 HONEY" application abandoned); U.S. Trademark Application Serial No. 85,084,214 (filed July 14, 2010) ("GANJA" application abandoned); U.S. Trademark Application Serial No. 85,083,994 (filed July 14, 2010) ("MAUI WAUI" application abandoned).

<sup>128</sup> *See, e.g.*, U.S. Trademark Application Serial No. 77,654,053 (filed Jan. 22, 2009) ("MARIJUANA" application abandoned); U.S. Trademark Application Serial No. 86,054,742 (filed Sept. 3, 2013) ("WASHINGTON'S FINEST CANNABIS" application abandoned for "Marijuana, Marijuana Infused Products, Cannabis, Cannabis Infused Products").

<sup>129</sup> 21 U.S.C. § 812 (2012).

<sup>130</sup> Brett Trout, *Marijuana Trademarks*, BLAWGIT (July 27, 2010), <http://blawgit.com/2010/07/27/marijuana-trademarks/>. For successful registrations *see, e.g.*, MEDICAL MARIJUANA, Registration No. 4,024,120 ("[m]agazines about marijuana serving medicinal purposes"); MEDICAL CANNABIS CUP, Registration No. 4,259,895 ("[o]rganization and arrangement of educational and instructional seminars and conferences regarding legal, medical and political developments and societal attitudes about medical marijuana"); MJFREEWAY, Registration No. 4,330,124 ("[c]omputer services, namely, providing on-line non-downloadable web-based computer software for patient documentation and history, inventory control, and inventory management for use among medical marijuana centers, dispensaries, collectives, and patients"); BUDRUZ, Registration No. 4,550,100 ("[p]roviding a searchable on-line advertising website featuring the services of other vendors via the Internet, namely, featuring services of medical marijuana dispensaries"). For pending registrations, *see, e.g.*, U.S. Trademark Application Serial No. 85,850,934 (filed Feb. 15, 2013) ("WOKE SMEED" notice of allowance issued for "[n]on-downloadable electronic publications in the nature of an online journal, namely, a blog in the field of the medicinal and recreational uses of marijuana"); U.S. Trademark Application Serial No. 85,602,048 (filed Apr. 19, 2012) ("REEFER MADNESS" published for opposition for "[e]ntertainment in the nature of an on-going special variety, news, music or comedy show featuring cannabis, hemp, pot, marijuana, 420, weed, mary jane broadcast over television, satellite, audio, and video media").

<sup>131</sup> *See, e.g.*, Office Action (Official Letter) About Applicant's Trademark Application (Apr. 9, 2013), U.S. Trademark Application Serial No. 85,850,934 (filed Feb. 15, 2013) ("WOKE SMEED"); Office Action (Official Letter) About Applicant's Trademark Application (Mar. 22, 2013), U.S. Trademark Application Serial No. 85,602,048 (filed Apr. 19, 2012) ("REEFER MADNESS"); Office Action (Official

quirements results in rejection.<sup>132</sup> However, if a merchant attests to compliance with federal law, then registration is possible.<sup>133</sup>

Applicants dare not lie to the USPTO if they attempt to file a trademark for marijuana. Falsely representing that a mark is used in lawful commerce when its use actually violates the Controlled Substances Act entails fraud upon the Trademark Office.<sup>134</sup> This could result in various civil liabilities and invalidation of the trademark registration.<sup>135</sup>

A further potential barrier to federal registration is the prohibition on scandalous or immoral trademarks. At least one trademark examiner has refused a trademark application for the mark MARIJUANA on the grounds that it comprised immoral or scandalous matter.<sup>136</sup> Indeed, immoral or scandalous marks are ineligible for federal registration.<sup>137</sup> However, this morality standard is murky, hinging upon whether the mark is “shocking to the sense of truth, decency, or propriety; disgraceful, offensive; disreputable, as scandalous conduct.”<sup>138</sup> Questions about whether a mark is scandalous or immoral are considered in relation to the goods and marketplace for which the mark is used.<sup>139</sup> Morality is, therefore, judged in the context of the mark’s use and is often a subjective process.<sup>140</sup> Nevertheless, humorous or prurient subject matter can be registrable.<sup>141</sup> The trademark office’s stance on marijuana’s propriety, as indi-

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Letter) About Applicant’s Trademark Application (Mar. 8, 2013), U.S. Trademark Application Serial No. 85,364,644 (filed July 6, 2011) (“THCBIZ”); Office Action (Official Letter) About Applicant’s Trademark Application (Jan. 14, 2013), U.S. Trademark Application Serial No. 85,727,284 (filed Sept. 12, 2012) (“420”).

<sup>132</sup> TMEP, *supra* note 111, § 814.

<sup>133</sup> *See, e.g.*, Response to Office Action (June 9, 2011), MEDICAL MARIJUANA, Registration Nos. 4,024,120 & 4,133,282.

<sup>134</sup> 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:51 (4th ed. 2014); *see also* Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int’l N.V., 425 F. Supp. 2d 458, 467–68 (S.D.N.Y. 2006).

<sup>135</sup> 15 U.S.C. § 1120 (2012); 3 MCCARTHY, *supra* note 134, § 19:51; TMEP, *supra* note 111, § 720.

<sup>136</sup> Supplemental Office Action (Oct. 12, 2006), U.S. Trademark Application Serial No. 78,401,566 (filed Apr. 14, 2004) (“MARIJUANA”).

<sup>137</sup> 15 U.S.C. § 1052(a); TMEP, *supra* note 111, § 1203.01.

<sup>138</sup> *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (emphasis omitted) (internal quotation marks omitted); *see also In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

<sup>139</sup> *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003); *see also In re Hepperle*, 175 U.S.P.Q. (BNA) 512, 512 (T.T.A.B. 1972) (finding that “ACAPULCO GOLD” was not scandalous for use as suntan lotion, despite being a potential synonym for marijuana).

<sup>140</sup> Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?*, 54 OHIO ST. L.J. 331, 400 (1993).

<sup>141</sup> *Id.* at 400–01.

cated by its willingness to accept marijuana-related marks, suggests that those marks are not immoral and are therefore registrable.<sup>142</sup>

*B. State Law Protects Marijuana Trademarks in Washington*

Washington law provides that the first person to use a trademark “in the ordinary course of trade”<sup>143</sup> will acquire common law rights to that trademark, regardless of registration,<sup>144</sup> while registration entails additional statutory rights.<sup>145</sup> Anyone using a trademark in the ordinary course of trade in Washington, therefore, has trademark rights. Despite federal drug laws, and despite a statutory provision that implies deference to federal trademark law,<sup>146</sup> a marijuana merchant has state trademark rights over his marijuana trademarks because the marijuana trade is legal under Washington law.

One might argue that Washington trademark rights do not exist for marijuana because the federal government outlaws marijuana trademarks. A specific statutory-guidance provision provides, “[i]t is the intent of the legislature that, in construing [Washington’s trademark statute], the courts be guided by the interpretation given by the federal courts to the federal trademark act of 1946.”<sup>147</sup> One may argue that if federal trademark law guides Washington courts through this guidance provision, then Washington trademark law should prohibit marijuana trademarks because federal trademark law prohibit them. However, the legislative history of the guidance provision invalidates this argument.

A provision’s legislative history can be a helpful guide to legislative interpretation.<sup>148</sup> Here, by choosing the word “guide,” the legislature signaled that Washington courts retain independence from the federal government when construing Washington’s state trademark laws.

Washington’s legislature first discussed a federal guidance provision for Washington’s trademark statute in 1989.<sup>149</sup> The provision’s purpose was to “clarif[y]” Washington law to make it “more compatible with the Model Trademark Act and the federal Lantham [sic] Act”<sup>150</sup> and to

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<sup>142</sup> See, e.g., MEDICAL MARIJUANA, Registration Nos. 4,024,120 & 4,133,282 (“magazines about marijuana serving medicinal purposes”); MEDICAL CANNABIS CUP, Registration No. 4,259,895 (“organization and arrangement of educational and instructional seminars and conferences regarding legal, medical and political developments and societal attitudes about medical marijuana”).

<sup>143</sup> WASH. REV. CODE § 19.77.910(11) (2012).

<sup>144</sup> *Id.*

<sup>145</sup> See, e.g., *Id.* §§ 19.77.040 (evidentiary value), 19.77.140 (entitlement to damages for likelihood of confusion), 19.77.150 (remedies for infringement).

<sup>146</sup> WASH. REV. CODE § 19.77.930.

<sup>147</sup> *Id.*

<sup>148</sup> *Baker v. Snohomish Cnty. Dept. of Planning & Cmty. Dev.*, 841 P.2d 1321, 1324 (Wash. Ct. App. 1992).

<sup>149</sup> Trademark Registration and Protection, S.B. 5733, 51st Leg., Reg. Sess. § 13, Wash. Sess. Laws ch. 72 (1989).

<sup>150</sup> H.B. REP., S.B. 5733 (Wash. Apr. 4, 1989).

“modernize” Washington’s state trademark statute.<sup>151</sup> The earliest Senate Bill Report from February 1989 stated the proposed statute’s effect as follows: “The courts of this state are *required to consider* the federal courts’ interpretation of the federal Trademark Act when construing provisions of the Washington Trademark Registration Act.”<sup>152</sup> However, a later House Bill Report from April 1989 stated that “[c]ourts are to be *guided by* the federal courts’ interpretation of the Federal Trademark Act.”<sup>153</sup> The Final Senate Report from July 1989 reverted to the prior language, stating that “courts of this state are *required to consider* the federal courts’ interpretation of the federal Trademark Act.”<sup>154</sup> Despite the legislative reports’ waffling, the final language of the statute provides that Washington courts be “guided” by federal law. Under the maxim of statutory construction, *expressio unius est exclusio alterius*, omissions are deemed to be exclusions,<sup>155</sup> so Washington courts should be “guided” by federal law but not “required to consider” it. Furthermore, even if the legislative history’s “requirement” language is given weight, Washington courts would only be required to “consider” federal interpretation. Therefore, Washington courts are not required to follow the federal prohibition on marijuana trademarks when construing Washington trademark law. By this logic, Washington courts can and should grant state trademark protection for marijuana trademarks used in lawful trade under Washington law.

### C. State Common Law and Statutory Protections Are Valuable

Washington grants valuable rights to anyone using a trademark in ordinary trade. Common law grants the original trademark user the right to seek injunctive and equitable relief against those who use her trademark without permission.<sup>156</sup> Registering a trademark with Washington’s Secretary of State provides the registrant with additional statutory rights and remedies relating to the trademark.<sup>157</sup> Registration authorizes the trademark owner to seek damages and to enjoin unauthorized use of the registered mark, similar to common law rights.<sup>158</sup> Registration also proves that the registrant was using the mark at a certain date, which grants an advantage when asserting priority rights in a trademark-infringement case.<sup>159</sup> Furthermore, registration constitutes prima facie evidence of the registrant’s ownership of the trademark and the registrant’s exclusive

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<sup>151</sup> S.B. REP., S.B. 5733 (Wash. Mar. 6, 1989); FINAL B. REP., S.B. 5733 (Wash. July 23, 1989).

<sup>152</sup> S.B. REP., S.B. 5733 (Wash. Feb. 24, 1989) (emphasis added).

<sup>153</sup> H.B. REP., S.B. 5733 (Wash. Apr. 4, 1989) (emphasis added).

<sup>154</sup> FINAL B. REP., S.B. 5733 (Wash. July 23, 1989) (emphasis added).

<sup>155</sup> *Adams v. King Cnty.*, 192 P.3d 891, 896 (Wash. 2008).

<sup>156</sup> *Woodcock v. Guy*, 74 P. 358, 359 (Wash. 1903).

<sup>157</sup> WASH. REV. CODE § 19.77.900 (2012); 31 WASHINGTON PRACTICE SERIES: BUSINESS LAW § 19.77.900 cmt. (2014).

<sup>158</sup> WASH. REV. CODE § 19.77.150.

<sup>159</sup> 3 MCCARTHY, *supra* note 134, § 22:1.

right to use the trademark throughout the state.<sup>160</sup> In Washington, trademark registration also serves as state-wide constructive notice of the registrant's ownership claim over the trademark.<sup>161</sup> Such state-wide notice forecloses later unauthorized users from arguing good-faith use of the mark,<sup>162</sup> allowing registrants to seek enhanced damages in a trademark-infringement lawsuit.<sup>163</sup>

For a merchant to register a Washington state marijuana trademark, the merchant must make a public statement<sup>164</sup> that she is selling marijuana.<sup>165</sup> Given the threat of federal enforcement, this will make marijuana businesspeople uneasy. However, if a merchant seeks to enforce her common-law trademark rights in court, then she must make a public disclosure anyway through court filings during the lawsuit.<sup>166</sup> Moreover, in light of the Washington State Liquor Control Board's rigorous licensing-and-regulatory system for recreational marijuana, legal marijuana businesses will already be identifiable by the government.<sup>167</sup>

Individuals and businesses in Washington have already succeeded in registering marijuana and marijuana-related trademarks with the Secretary of State,<sup>168</sup> demonstrating Washington's willingness to grant these registrations. Given that the benefits of registration exceed common law protections and that licensed marijuana merchants will already be vulnerable to federal enforcement, state trademark registration is well advised.

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<sup>160</sup> WASH. REV. CODE § 19.77.040.

<sup>161</sup> *Id.*

<sup>162</sup> 3 MCCARTHY, *supra* note 134, § 22:1; Lockridge, *supra* note 106, at 623.

<sup>163</sup> WASH. REV. CODE § 19.77.140.

<sup>164</sup> *Id.* § 19.77.070.

<sup>165</sup> *Id.* § 19.77.030 (“[Applicant must list t]he particular goods or services in connection with which the trademark is used . . .”).

<sup>166</sup> *See, e.g.*, WASH. CT. C.R. 10(a).

<sup>167</sup> *See, e.g.*, *FAQs on I-502*, WASH. ST. LIQUOR CONTROL BOARD (2014), [http://liq.wa.gov/marijuana/faqs\\_i-502](http://liq.wa.gov/marijuana/faqs_i-502).

<sup>168</sup> *See, e.g.*, DIEGO PELLICER, Washington Trademark Registration No. 55,713 (“Marijuana for recreational use; retail services for sale of recreational marijuana”); LOCAL ROOTS, Washington Trademark Registration No. 55,884 (“We provide safe easy access for medical marijuana patients to get there [sic] meds.”); THE 4.20 BAR, Washington Trademark Registration No. 55,937 (“pharmaceuticals . . . [and] medicinal/herbal extracts”); NORTHWEST MEDICINALS, Washington Trademark Registration No. 55,938 (“pharmaceuticals . . . [and] medicinal/herbal extracts”); SUBTLE TEA, Washington Trademark Registration No. 55,939 (“pharmaceuticals . . . [and] medicinal/herbal extracts”); EH EVERGREEN HERBAL, Washington Trademark Registration No. 55,941 (“pharmaceuticals . . . [and] medicinal/herbal extracts”); SWEET LEAF BAKERY, Washington Trademark Registration No. 55,920 (“Candy, cakes, cookies, confections made w/ cannabis in accordance w/ WA State RCW[] 69.51A, custom orders.”); DOCTOR OTIS MEDICINE, Washington Trademark Registration No. 55,812 (“Medical marijuana having varying content of tetrahydrocannabinol (“THC”) in wafer form.”).

## III. GUIDELINES FOR PROTECTABLE MARIJUANA TRADEMARKS

For trademark registration or protection, a name must be distinctive.<sup>169</sup> The most distinctive names are “fanciful, arbitrary, [or] suggestive.”<sup>170</sup> Less-distinctive descriptive names are only protectable if they acquire secondary meaning or distinctiveness.<sup>171</sup> Generic names are not protectable.<sup>172</sup>

Individuals in states with legal marijuana will play leading roles in establishing marijuana trademark standards. In Washington, the Secretary of State has authority to examine and reject trademark applications.<sup>173</sup> However, state examination procedures are not rigorous, compared to federal trademark examination.<sup>174</sup> With the looming growth of the marijuana industry, Washington’s Secretary of State should take special care with applications for marijuana trademarks given the potential for businesses gaining an unfair advantage by monopolizing existing marijuana industry terms.<sup>175</sup> Registration “does not constitute prima facie evidence that a mark is not merely descriptive [and unprotectable without secondary meaning].”<sup>176</sup> Thus, while state registration is useful for trademark litigants,<sup>177</sup> it will not assure a trademark’s validity. The responsibility, therefore, falls upon courts and practitioners to educate themselves about marijuana terminology in order to competently evaluate whether any given marijuana name is a protectable trademark.

Rather unsurprisingly, marijuana products are in the same position as other products when evaluating distinctiveness. Outside the hazy territory of descriptive and generic terms, discussed below, the most distinctive suggestive, arbitrary, and fanciful marks are protectable. Suggestive marks only suggest a good’s characteristics.<sup>178</sup> Arbitrary and fanciful marks bear no relation to the goods themselves.<sup>179</sup> Such marks are sufficiently distinctive so that granting exclusive trademark rights to them en-

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<sup>169</sup> *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979); *see also* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:1 (4th ed. 2014).

<sup>170</sup> *Seattle Endeavors, Inc. v. Mastro*, 868 P.2d 120, 124 (Wash. 1994).

<sup>171</sup> A descriptive mark is protectable if it has become distinctive as applied to the applicant’s goods or services in commerce such that the primary significance of the mark is the producer, rather than the product. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983).

<sup>172</sup> *Id.* at 790.

<sup>173</sup> WASH. REV. CODE § 19.77.020 (2012).

<sup>174</sup> *Id.*; *see also* Andrew L. Goldstein, *Bringing the Model State Trademark Bill into the 90s and Beyond*, 83 TRADEMARK REP. 226, 232 (1993); Lockridge, *supra* note 106, at 650.

<sup>175</sup> *See supra* Part I.B.2.

<sup>176</sup> WASH. REV. CODE § 19.77.020.

<sup>177</sup> *See supra* Part II.C.

<sup>178</sup> *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983); *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

<sup>179</sup> *Zatarains*, 698 F.2d at 791.

courages rather than inhibits fair competition, effectively balancing the rights of competitors.<sup>180</sup>

Aside from those most distinctive types of marks, the conceptual boundaries for descriptive and generic marijuana marks are unknown and untested. Marijuana's long history and over 75 years of illegality<sup>181</sup> have generated an extensive lexicon that poses new questions for trademark law. Indeed, marijuana has been recognized for its medicinal and psychoactive properties for over 4,000 years.<sup>182</sup> There are three distinct species of marijuana,<sup>183</sup> potentially hundreds of discrete strains,<sup>184</sup> and numerous black market and slang terms<sup>185</sup> for the drug. Given the expansive scope of marijuana terminology, carving out a distinctive and protectable trademark presents tricky questions. This Section proposes some guidelines to help courts, practitioners, and trademark examiners evaluate marijuana trademarks in a way that reduces the possibility of unfair competition.

#### A. *Marijuana Species and Strains Are Unprotectable Plant Varietals*

Terms for marijuana, cannabis species, and identifiable strains should be considered generic. Under accepted trademark doctrine, plant varietal names are generic and cannot be registered as a trademark, even if the varietal name was originally arbitrary.<sup>186</sup> A consumer "has to have some common descriptive name he can use to indicate that he wants one variety of apple tree, rose, or whatever, as opposed to another, and it is the varietal name of the strain which naturally and commonly serves this purpose."<sup>187</sup> While there is some disagreement about whether numerous forms of cannabis come from variations of a single species or distinct species, the general view is that there are three: (1) *Cannabis sativa*, (2) *Cannabis indica*, and (3) *Cannabis ruderalis*.<sup>188</sup> However, cultivation over

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<sup>180</sup> 2 MCCARTHY, *supra* note 169, § 11:2.

<sup>181</sup> CAULKINS ET AL., *supra* note 19, at 19, 139.

<sup>182</sup> *Id.* at 18; Chris Bennett, *Early/Ancient History*, in THE POT BOOK, *supra* note 18, at 18.

<sup>183</sup> MARTIN BOOTH, CANNABIS: A HISTORY 2 (2003); 4 CANNABIS: THE GENUS CANNABIS 30 (David T. Brown ed., 1998) [hereinafter GENUS CANNABIS].

<sup>184</sup> See, e.g., *Cannabis Strain Explorer*, LEAFLY (2014) <http://www.leafly.com/explore>; *Marijuana Strain Library*, KIND GREEN BUDS, <http://www.kindgreenbuds.com/strainlibrary.html>.

<sup>185</sup> *Drug Fact Sheet: Marijuana*, *supra* note 98.

<sup>186</sup> TMEP, *supra* note 111, § 1202.12; 2 MCCARTHY, *supra* note 169, § 12.36.

<sup>187</sup> *In re Pennington Seed, Inc.*, 466 F.3d 1053, 1057 (Fed. Cir. 2006) (quoting *In re Hilltop Orchards & Nurseries, Inc.*, 206 U.S.P.Q. (BNA) 1034, 1036 (T.T.A.B. 1979)) (internal quotation marks omitted); see also Office Action (Official Letter) About Applicant's Trademark Application (Nov. 30, 2010), U.S. Trademark Application Serial No. 85,083,994 (filed July 14, 2010) ("MAUI WAUI").

<sup>188</sup> BOOTH, *supra* note 183, at 2; GENUS CANNABIS, *supra* note 183, at 30.

many centuries has resulted in countless varieties and sub-strains of cannabis plants.<sup>189</sup>

Courts weigh a variety of evidence when determining whether a term identifies an unprotectable plant varietal, but an officially recognized catalog could offer decisive answers.<sup>190</sup> If a verified catalog of marijuana strains existed, then courts and examiners could easily refute shrewd attempts to trademark and monopolize those varietal names. Such a catalog can serve as a verifiable public domain<sup>191</sup> that could prevent trademark applicants from unfairly monopolizing recognizable strains. While such an officially recognized catalog does not exist for marijuana, the information is available. Various cannabis groups and experts are developing their own databases of marijuana-strain information.<sup>192</sup> However, officially recognizing a catalog of cannabis and marijuana strains would be a complex policy project for scientists, businesses, growers, and regulators, especially with the added consequences of blocking exclusive marijuana name rights. Nevertheless, if marijuana remains legal, such an authoritative catalog will be invaluable for fair competition.

#### B. Slang Terms for Marijuana Are Generic or Descriptive

Marijuana is identifiable by at least 24 different slang terms including: “Boom, Chronic, Dope, Gangster, Ganja, Grass, Hash, Herb, Kif, Mary Jane, Pot, Reefer, Sinsemilla, Skunk, Weed,”<sup>193</sup> “Aunt Mary, BC Bud, Blunts . . . Hydro, Indo, Joint, . . . Mota . . . Smoke . . . [and] Yerba.”<sup>194</sup> This does not include the many other cultural terms that have developed during society’s history of marijuana consumption.<sup>195</sup>

<sup>189</sup> GENUS *CANNABIS*, *supra* note 183, at 30–31. Phillip Hague, an expert breeder from Colorado, identifies four main types: “haze, skunk, kush, and northern lights.” Jonathan Ringen, *Weed City, USA*, ROLLING STONE, June 20, 2013, at 48.

<sup>190</sup> *In re Pennington Seed*, 466 F.3d at 1058 (considering “excerpts of articles from a variety of sources, including . . . the Germplasm Resources Information Network . . . the database maintained by [the International Union for the Protection of New Varieties of Plants and] . . . the Seed Regulatory and Testing Branch of the United States Department of Agriculture” when evaluating whether “Rebel” is a protectable trademark for grass seed).

<sup>191</sup> 1 MCCARTHY, *supra* note 47, § 1:30.

<sup>192</sup> See, e.g., 1 CANNABIS SATIVA, *supra* note 61; 2013 LA High Times Medical Cannabis Cup Winners Gallery, HIGH TIMES (Feb. 20, 2013), <http://hightimes.com/read/2013-la-high-times-medical-cannabis-cup-winners-gallery-0>; John Aguilar, *University of Colorado Professor to Explore Cannabis Genome*, DENVER POST (Feb. 9, 2014), [http://www.denverpost.com/news/ci\\_25095859/university-colorado-professor-explore-cannabis-genome](http://www.denverpost.com/news/ci_25095859/university-colorado-professor-explore-cannabis-genome); *Cannabis Strain and Infused Product Explorer*, *supra* note 184; *Marijuana Strain Library*, *supra* note 184.

<sup>193</sup> *Marijuana*, *supra* note 100.

<sup>194</sup> *Drug Fact Sheet: Marijuana*, *supra* note 98.

<sup>195</sup> See, e.g., KEROUAC, *supra* note 97; MILLS, *supra* note 97, at 1 (citing references to “Bangué,” “Bang,” and “Ganja,” in English language publications from 1745 and

A mark is generic if it merely signifies the type of product to the relevant consumers.<sup>196</sup> In the case of marijuana, the relevant consumers are marijuana consumers. Because marijuana has been a black-market product for so long, cultural and black-market slang terms are precisely the terms that consumers use to signify the type of product. Therefore, many slang terms should be classified as generic and unprotectable.

Alternatively, some slang terms could be descriptive. Descriptive terms identify a characteristic or quality of goods, and ordinarily are not protectable as trademarks. For example, “chronic” can mean marijuana itself.<sup>197</sup> But “chronic” can also be used descriptively to indicate high-quality marijuana.<sup>198</sup>

A descriptive term like “chronic” may be protectable if it acquires secondary meaning: if “the primary significance of the term in the minds of the consuming public is not the product but the producer.”<sup>199</sup> This could happen if one marijuana merchant exclusively used the mark “chronic” on its goods, no other seller used that mark, and the public came to primarily associate the term with that one merchant. Given the extensive use of “chronic” throughout marijuana culture,<sup>200</sup> establishing such primary significance would be challenging. Nevertheless, such a descriptive term could become protectable by acquiring distinctiveness or secondary meaning.

## CONCLUSION

The immediate prospects for national marijuana legalization remain uncertain. Meanwhile, wherever marijuana is legal, consumers will benefit from allowing marijuana merchants to trademark their products. Trademarks will encourage healthy competition and lower search costs for consumers. While marijuana trademarks entail benefits, potential costs include encouraging advertising and restricting the vocabulary of other marijuana merchants. These costs can be defrayed through sensible advertising regulations, education, and by evaluating marijuana trademarks in light of existing slang and plant varieties. Therefore, on

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1804); THOMPSON, *supra* note 97; A CHILD’S GARDEN OF GRASS, *supra* note 97; CHEECH AND CHONG, *supra* note 97; DR. DRE, *supra* note 97; PINEAPPLE EXPRESS, *supra* note 97.

<sup>196</sup> 2 MCCARTHY, *supra* note 169, § 12:4.

<sup>197</sup> *Drug Fact Sheet: Marijuana*, *supra* note 98.

<sup>198</sup> See, e.g., JONATHAN LETHEM, CHRONIC CITY (2010); DR. DRE, *The Roach (The Chronic Outro)*, on THE CHRONIC (Interscope 1992); SNOOP DOGGY DOGG, *Gin and Juice*, on DOGGYSTYLE (Death Row Records 1993); TWIZTID, *Hydro*, on THE GREEN BOOK (Psychopathic 2003); UGK, *Like a Pimp*, on DIRTY MONEY (Jive 2001).

<sup>199</sup> *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983) (quoting *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938)) (internal quotation marks omitted); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

<sup>200</sup> See, e.g., *supra* note 185 and accompanying text.

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balance, the trademark policy benefits of encouraging quality and consistency outweigh potential costs. Under existing laws, Washington marijuana merchants will have common law rights to their marijuana trademarks. Those merchants could register with the Secretary of State to cement those rights, achieve state-wide notice, and gain access to additional remedies for infringement. In registering their trademarks, marijuana merchants, like other merchants, will be well-advised to select a distinctive trademark that is fanciful, arbitrary, or suggestive. In sum, an understanding of the colorful language surrounding the existing marijuana industry is necessary to properly assess marijuana trademark rights and to avoid unfair competition.