Patent Law in the Marijuana Industry

Innovations can be protected, despite federal 'morals'

By Neil Juneja

Intellectual property is an important and often overlooked aspect of the marijuana industry. Intellectual properties are creations of the mind and consist of trademarks, copyrights, patents, and trade secrets. Trademark protection has been discussed in previous issues of Marijuana Venture. Copyrights in our industry are limited in scope. Patents, on the other hand, are greatly beneficial to the innovators in the industry, yet are often overlooked.

WHAT IS A PATENT?

A patent is a constitutionally guaranteed right that conveys upon the patent holder a limited monopoly in their invention. A patent is a social contract between the inventor and the public. This social contract gives the inventor a monopoly in exchange for sharing the invention. When the patent expires, the public may have free reign on the invention.

This tradeoff incentivizes an inventor to devote resources to research and development, and to share the details of the invention with the public. A patent conveys the right to exclude others from making, selling, offering for sale, importing, or using the invention. While this exclusionary right is well worth the cost of admission, notice that a patent does not convey any right for the inventor to actually practice the invention. There are three kinds of patents: utility patents, design patents and plant patents. Yes, there are patents for plants.

For our purposes in this article, we will look at the two most common types of patents: utility patents and design patents. We will have a longer discussion on plant patents in a later issue.

Utility patents are the most common type of patent and protect the invention of a new and useful process, machine, manufacture, or composition of matter, or a new and useful improvement thereof. This protection lasts 20 years from the filing date, provided that the maintenance fees are paid.

A design patent protects the ornamental design of a functional item and lasts 15 years from the issue date. A design patent's protection is narrower than a utility patent. However, design patents have their value. For instance, a particular industrial design of a consumer product, such as a bong or a vaporizer, is protectable by a design patent. There can also be overlap between design patents and trade dress (a type of trademark). This is because trade dress protection acts on a source identifier to the same regard as a logo or product name, but protects nonfunctional design and product packaging. An iPhone is an example of a product that is protectable by both design patents and trade dress protection.

Inventions must meet three main requirements to receive a patent. The patent must have utility, novelty and nonobviousness.

UTILITY

First and foremost, the invention must be useful. This is generally a low standard and essentially requires the invention to be sufficiently described as having some sort of function. Until recently, however, patent attorneys did not file applications for inventions that lacked a legal use. This position was based upon a case in 1897 where a court refused to uphold a patent on a gambling machine because it was "frivolous or injurious to the well-being, good policy, or sound morals of society."

This is perfectly fine if the invention is a vaporizer that can use oils without any federally illegal additives, but would not work so well on processes and compositions containing cannabinoids.

Fortunately, as of 1999, the government's opinion of morality is no longer a determining factor in patentability.

This opens up the entire area of marijuana innovations to federal patent protection. This may include methods of making edibles, solutions with ratios of cannabinoids in a solution, or extraction devices, among thousands of other innovations that immediately come to mind.

NOVELTY

An invention must also be novel to be patentable. In order to provide the social contract and allow a monopoly, the invention cannot already be known to the public. This means that the invention cannot be previously described in any issued or filed patent, used by others, or published in any papers. Before filing a patent, it is usually prudent to search for previous inventions. This is an interesting area for marijuana patents because many innovators in this industry are underground and do not want to publicize their creative efforts.

NONOBVIOUS

Finally, an invention must not be obvious to one of ordinary skill in art. Every invention should solve a problem. If the solution to the problem is obvious to those working in the technical area, then the invention really isn't innovative and is, therefore, not entitled to patent protection. This requirement is not always easy to determine in advance of filing the patent.

For instance, there are many light sources used for supplemental light in greenhouses, such as high-pressure sodiums, metal halides and LEDs. If a new light source is discovered, perhaps a new type of glowing rice kernels, it would be obvious to try it in the greenhouse. Therefore, the use of this new light source as supplemental lighting would not be patentable. If, however, one discovers that arranging glowing rice kernels in the shape of a buckyball and shining the light through a diffraction grating, and the resulting light increased yield by 30 percent, this type of innovation would probably not be obvious to one of ordinary skill in the art.

The pace of innovation in the marijuana industry is not just staggering, but rapidly accelerating. Patents provide a way to protect those innovations. Patent protection also prevents others from patenting the very same invention. As the industry grows more crowded, only one's brand and protectable innovations will separate them from the herd. MV

Neil Juneja practices intellectual property and marijuana law with Gleam Law. He can be reached by email at Neil@GleamLaw.com.