

Debunking the “Duty to Police” in Trademark Law  
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Claims of trademark infringement seem to be appearing more frequently in the media. Cases such as Chick-fil-a’s claim that an artist’s “Eat More Kale” t-shirts infringes its “Eat Mor Chikin” trademark are often justified by brand owners as necessary to protect their mark. The president of Monster Cable (an extremely frequent enforcer of its “Monster” mark), Noel Lee has stated, “We have an obligation to protect our trademark; otherwise we’d lose it.” However, no express obligation to police trademarks (especially against expressive uses) exists in the Lanham Act. This Article will first examine the basis for the perception that brand owners have a duty to police their mark by showing how that duty is described in academic treatises and practitioner guides. Next, we will test whether the perception of the duty is empirically justified. To do so, we will determine how often mark owners actually lose brands by failing to police them. We will also analyze these results contextually to determine whether the risk is more real in some contexts, such as generic use, and rather mythical as in the “Eat More Kale” example. After defining the actual risk, it will become clear whether the duty to police is driven by factors other than a true risk of brand loss. The analysis up to this point will debunk the mystical “duty to police,” especially in the infringement contexts, much like turning on the bedroom light to reveal that there is no monster hiding in the closet. We next question whether the “duty to police” is routinely overstated by trademark counsel in business development. In view of our findings, we recommend that practitioners reexamine the advice they give regarding the “duty to police” in trademark law. Finally, we will conclude by identifying clear boundaries of the policing duty and provide recommendations on how trademark law can be fixed through safe harbors and legislative clarification.

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