



Trademark's “Duty to Police”

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Breakout Session 2 - Day One

Room 95	Room 180	Room 190	Room 280B	Room 290
Trademarks & Branding	Copyright and the First Amendment	Patent Reform and Trade Secrets	Patent Damages and Valuation	IP, Infringement Litigation and Efficiency
<i>Debunking the "Duty to Police" in Trademark Law</i> Deborah Gerhardt, Eric Goldman, & Leah Chan Grinvald	<i>Catch 22 in the Rye: Copyright Essentialism and the Performativity of Remedies</i> Andrew Gilden	<i>Protecting America's True Innovators</i> W. Keith Robinson	<i>Fixing FRAND: Rationalizing "Fair, Reasonable and Non-Discriminatory" Licensing of Standards-Essential Patents</i> Jorge Contreras	<i>Law and Economics of Litigation: New Insights from Patents</i> Axel Haus & Steffen Juranek



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Pattie Gonia Timeline

1970s-80s: Patagonia obtains TM registrations for its name and logo

2018: Wyn Wiley launches Pattie Gonia drag queen & environmental activist

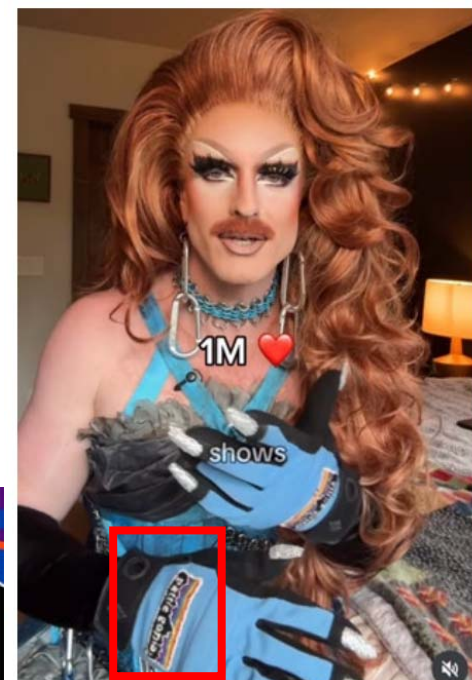
2022: parties discuss Pattie Gonia's commercialization

2024: pattiegoniamerch.com launches (now pattiemerch.com)

2025 email: "Trademark law requires Patagonia to affirmatively protect its trademark against all potential infringement"

2025: Pattie Gonia applies for trademark registration (99/404,728)

2026: Patagonia sues Pattie Gonia for TM infringement and dilution; seeks \$1 damages + equitable relief





Policing Duty Defined

“The law imposes on trademark owners the duty to be pro-active and to police the relevant market for infringers....the trademark owner must anticipate constant ‘maintenance’ of its trademark property by policing and enforcing the exclusivity of its trademark symbol in its marketplace. Thus, the corporate owners of trademarks have a duty to protect and preserve the corporation's trademark assets through vigilant policing and appropriate acts of enforcement.”

- McCarthy on Trademarks & Unfair Competition (5th Ed.) § 11:91



Descriptive Claim

The “duty to police” is a confusing mélange of trademark doctrines

- It’s not a “duty”
- “Policing” is the wrong descriptor



TM “Policing” Taxonomy

- **Forfeiture**

- Genericide
- Abandonment
- Naked licensing

- **Weakening**

- Concurrent use can block secondary meaning
- Concurrent use “hems in”
- Concurrent use may undermine LOCC factors & remedies
- Concurrent blurring & tarnishment undercuts dilution



Normative Claims

- Loss aversion bias leads to some wasteful enforcements
- Those enforcements can devolve into trademark abuse/bullying
- We need better protections against trademark enforcements abuses
- Judges may unintentionally exacerbate the loss aversion bias