The Ethics of Trademark Policing

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This project aims to contribute to the conversation about trademark bullying and other instances of aggressive assertion of intellectual property rights. There is a general consensus that trademark bullying is a significant problem, particularly among large corporations and other well-heeled entities that threaten litigation against small businesses, non-profit organizations, and individuals. But until now, there has been relatively little consideration about if or when lawyers who engage in such practices are acting unethically, i.e. in contravention of the ethical obligations contained in the ABA Model Rules of Professional Conduct (Model Rules), as opposed to merely undesirably. Most scholars who touch on the issue reflexively assume that such actions violate ethics rules without further discussion. Others have identified rules that arguably apply to some instances of trademark bullying, but they have not comprehensively examined the practice given the competing obligations that are owed to a lawyer's client, third persons, tribunals, and society at large.

This Article aims to fill that gap. Perhaps controversially, it will posit that in many instances the actions that are deemed trademark "bullying" do not contravene the Model Rules. In fact, there is an argument that a lawyer's aggressive policing—provided that they fully inform their client of the economic costs and potential for reputational backlash—fulfills their ethical obligations to their clients in light of the prevailing trademark doctrine and uncertainties in the application of the infringement and dilution causes of action. Yet there are limits. The Article aims to identify the types of situations when aggressive trademark policing crosses the ethical line. It also will argue for enforcement by the United States Patent and Trademark Office (USPTO) Office of Enrollment and Discipline (OED), the division that regulates the conduct of trademark and patent practitioners.