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Trademark Thrower: Using Banksy's Recent EU Trademark Misadventures to Assess Why Copyright Is Not "For Losers"

Shelly Kurland

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TRADEMARK THROWER: USING BANKSY’S RECENT EU TRADEMARK MISADVENTURES TO ASSESS WHY COPYRIGHT IS NOT “FOR LOSERS”

ABSTRACT

This Comment seeks to distinguish the protections and protection requirements of trademark and copyright in an international context, specifically using a recent case in which internationally known street artist Banksy lost his European Union trademark protections despite registration. This EU trademark proceeding will be utilized to analyze the requirements to maintain trademark protection in an international context and explain why those requirements are important to the integrity of intellectual property protections.

This Comment will first give an overview of trademark and copyright as intellectual property in general, then go into the specifics of the U.S. and EU trademark systems. This Comment will then evaluate why a trademark should not be used as a backup form of protection for copyright protection, and evaluate the distinctions in the U.S. and EU intellectual property systems, providing a potential solution specific to Banksy.

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INTRODUCTION

Trademarks possess the ability to be powerful, and this ability has been especially prevalent in 2020. Whether it is varying reactions to the mark conveying “Make America Great Again,”¹ the familiarity and comfort certain brands bring consumers when grocery shopping through a phone application, or even reactions to the marks for the COVID-19 vaccine makers, trademarks are a powerful type of protection in today’s world. Whether it is in the United States or the European Union (EU), registering a trademark is an effective way to protect a brand and uphold a certain number of rights—but trademark is undoubtedly a “use it or lose it” system and must be taken seriously as such.

In April 2020, street artist Banksy, who has become internationally known while remaining anonymous under his pseudonym, lost rights to his previously registered EU trademark.² The canceled mark was for his painting called Flower Thrower, arguably his most famous work.³ Although Banksy successfully registered the mark in 2014, it was canceled due to a trademark challenge when

¹ MAKE AMERICA GREAT AGAIN, Registration No. 5,020,556.

² Full Colour Black Ltd. v. Pest Control Off. Ltd., No. 33843C, at 2 (EUIPO Cancellation Div., Sept. 14, 2020).

³ *Id.* at 2.

Banksy sought to enforce his rights against a business that was using the registered trademark on its goods.⁴ While, in the words of scholar Rebecca Tushnet, Banksy most certainly sent “a trademark to do a copyright’s job,”⁵ the cancellation of his mark leads to questions. For example, the question of where the line is drawn with trademark registration, specifically in the United States versus the European Union, especially since trademark is a system of protection which can become depleted.⁶

Intellectual property litigation, enforcing intellectual property rights through other methods, and trademark registration itself are all costly. The fact that trademark protection is part of a depletable system is a cause for concern, especially when the European Union is letting trademark registrations such as Banksy’s Flower Thrower through as registrable, just to cancel the mark when he tries to enforce the rights he believed he lawfully obtained.⁷ This is a harsh but clear instance of a matter of copyright versus trademark. While Banksy made his opinion of copyright protection clear in his statement “copyright is for losers,”⁸ authors have theorized his avoidance of copyright in favor of trademark protection can be attributed to his desire to remain anonymous, working under his pseudonym with no threat to his identity.⁹

Trademark systems in the United States and the European Union have many distinctions. One way the systems differ is how the United States uses the first-to-use system to establish priority rights in a mark.¹⁰ In contrast, the European Union uses the first-to-file system to establish priority rights.¹¹ In a first-to-use system, the user who first used a mark in commerce has priority rights to the mark compared to a later user.¹² On the other hand, in a first-to-file system, priority rights to the mark are credited to the applicant who first files the mark

⁴ *Id.* at 3.

⁵ Rebecca Tushnet, *Don’t Send a Trademark to Do a Copyright’s Job, Forestry Edition*, TUSHNET.COM (Aug. 27, 2018), <https://tushnet.com/2018/08/27/dont-send-a-trademark-to-do-a-copyrights-job-forestry-edition>.

⁶ Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 947, 951 (2018) (“The supply of word marks that are at least reasonably competitively effective as trademarks is finite and exhaustible.”).

⁷ *Full Colour Black Ltd. v. Pest Control Off. Ltd.*, No. 33843C, at 2 (EUIPO Cancellation Div., Sept. 14, 2020).

⁸ BANKSY, WALL AND PIECE (2006).

⁹ *Full Colour Black Ltd.*, No. 33843C, at 12.

¹⁰ U.S. PATENT & TRADEMARK OFF., PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 20–21 (2020) [hereinafter PROTECTING YOUR TRADEMARK], https://www.uspto.gov/sites/default/files/BasicFacts_0.pdf.

¹¹ EUROPEAN IPR HELPDASK, YOUR GUIDE TO IP IN EUROPE 5–10 (2017), https://www.iprhelpdesk.eu/sites/default/files/documents/IPR-Chart_EU-trade-mark.pdf.

¹² PROTECTING YOUR TRADEMARK, *supra* note 10, at 20–21.

for registration.¹³ This first-to-use priority rights system in the United States demonstrates how the United States places more weight on the actual use of a mark in commerce compared to registration. In contrast, the EU model places more weight on its trademark filing system.

The foundations of protection eligibility for copyright and trademark are distinct.¹⁴ Copyright, in short, is protectable to help foster creativity and promote the progress of science and the useful arts, prioritizing the author's exclusive rights to their works.¹⁵ In contrast, the foundation of trademarks lies in commerce¹⁶ and creating a consumer-friendly environment that allows a sense of certainty or confidence in brands.¹⁷ In a system of protection where the subject matter being protected is finite and thus can become depleted, there should be a creativity incentive; or perhaps there already is an element of creativity inherent in the system since there can only be so many marks.

In a sense and to an extent, creativity is rewarded under trademark law, as it is with copyright, because marks which are "arbitrary and fanciful" are the most easily protectable under the U.S. registration system.¹⁸ The trademark system in the United States is seemingly becoming more liberal in what it allows to be registered, as demonstrated in the influential and game-changing U.S. Supreme Court case, *Matal v. Tam*.¹⁹ This 2017 case struck down the disparaging marks provision and the immoral and scandalous marks provision of the Lanham Act, which made registering those categories of marks impermissible.²⁰ The European Union also allows registration of marks which are not eligible in the United States, adding to the opportunity for creativity in the trademark system.²¹

While there is arguably an element of creativity in trademark systems, and a plethora of types of marks eligible for registration, especially in the European Union, these factors do not mean that copyright and trademark can be, or should be, used interchangeably. The trademark registration systems should be more stringent to avoid the use of copyright and trademark interchangeably. A more

¹³ EUROPEAN IPR HELPDESK, *supra* note 11, at 5–10.

¹⁴ *Inside WIPO: What is WIPO?*, WORLD INTELL. PROP. ORG. [hereinafter *What is WIPO?*], <https://www.wipo.int/about-wipo/en> (last visited Feb. 15, 2022).

¹⁵ U.S. CONST. art. I, § 8, cl. 8; 17 U.S.C. § 106.

¹⁶ U.S. CONST. art. I, § 8, cl. 3.

¹⁷ *What are Intellectual Property Rights?*, WORLD TRADE ORG., https://www.wto.org/english/tratop_e/trips_e/intell_e.htm (last visited Feb. 15, 2021).

¹⁸ PROTECTING YOUR TRADEMARK, *supra* note 10, at 6, 7.

¹⁹ *Matal v. Tam*, 137 U.S. 1744 (2017).

²⁰ *Id.* at 1771.

²¹ *Trade Mark Definition*, EU INTELL. PROP. OFF. (Sept. 22, 2017), <https://euipo.europa.eu/ohimportal/en/trade-mark-definition>.

rigorous trademark registration system would help to avoid the costs of needless registration, rights enforcement, and intellectual property litigation, especially if the mark at issue is canceled or invalidated. Since the European Union emphasizes trademark registration by using a first-to-file priority rights system, registration should be a stricter process than what is currently allowed by the EU trademark system.

This Comment will first give an overview of trademark and copyright as intellectual property in general, then go into the specifics of the U.S. trademark system and the EU trademark system. This Comment will then evaluate why a trademark should not be used as a backup form of protection for copyright protection. The primary case used for this analysis is Banksy's EU trademark cancellation of his previously-registered mark for Flower Thrower. Lastly, this Comment will propose that the European Union should be more stringent with what it allows to be registered to prevent issues such as "warehousing," costly and time-consuming cancellation proceedings, and trademark depletion.

I. INTELLECTUAL PROPERTY GENERALLY

The World Intellectual Property Organization (WIPO) is a specialized agency of the United Nations.²² WIPO explains that intellectual property "refers to creations of the mind – everything from works of art to inventions, computer programs to trademarks and other commercial signs."²³ WIPO makes the distinction between two categories of intellectual property.²⁴ The first category is "industrial property[.]" and the second is "copyright and related rights[.]"²⁵ The first category includes patents and trademarks, while the second category is more oriented towards the arts, such as literary works and various types of performances.²⁶ Both copyright and trademark can protect a work, but that does not mean the latter should be used to replace the former or wrongly serve as backup for a work.²⁷

The key to obtaining and utilizing rights to trademark and copyright is to file an application to register the eligible mark or work through the appropriate

²² *What is WIPO?*, *supra* note 14.

²³ WORLD INTELL. PROP. ORG., WHAT IS INTELLECTUAL PROPERTY? I (2020) [hereinafter WHAT IS IP?], https://www.wipo.int/edocs/pubdocs/en/wipo_pub_450_2020.pdf.

²⁴ *Id.* at 3.

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Full Colour Black Ltd. v. Pest Control Off. Ltd.*, No. 33843C, at 3 (EUIPO Cancellation Div., Sept. 14, 2020). The relevant intellectual property to this Comment is trademark and copyright, so patents will not be covered.

medium. The only exception is that for copyright in the European Union, rights that come with registration vest automatically.²⁸ Registration requirements vary depending on what an applicant is attempting to register and the country the applicant is attempting to register in.²⁹

While WIPO makes the distinction between the two intellectual property categories, it is worth noting that WIPO still encompasses both forms of intellectual property as “creations of the mind[,]” hinting at an underlying theme of creativity.³⁰ These factors pointing towards the element of creativity, however seemingly small, may be a cause of the confusion when both copyright and trademark protection *should* be used together as opposed to just when they *can* be used together. While there is arguably an element of creativity involved with creating trademarks, the main purpose behind trademarks is to protect commerce and consumers, whereas the main reason behind copyright is to protect creative works.

A. Copyright

1. In the United States

Copyright, in contrast to the commerce-based foundation of trademark registration and protection, revolves around the element of originality, and thus, creativity.³¹ Copyright applies to works of authorship including, among other categories, literary works, music, lyrics, paintings, and sculptures, so long as there is at least a minimal amount of creativity in the work.³² Copyright’s exclusive rights exist over an author’s work as soon as the creative work is created in a fixed, tangible medium, but the automatic rights are not as extensive as those when a copyright is registered.³³ Registration is not mandatory in the United States for copyright protection as the rights automatically vest once the work is in a fixed, tangible medium, but it is mandatory to enforce the rights for certain outcomes.³⁴

Upon creation of the work, an author automatically has the exclusive rights to reproduce, distribute, perform, and publicly display the work, and prepare

²⁸ WHAT IS IP?, *supra* note 23, at 14, 23; 17 U.S.C. § 106.

²⁹ WHAT IS IP?, *supra* note 23, at 14, 23.

³⁰ *Id.* at 1.

³¹ 17 U.S.C. § 106.

³² *Id.* § 102.

³³ *Id.* § 201.

³⁴ *Id.*

derivative works based on the original work.³⁵ If an author wants to enforce any of these rights against infringers through litigation, however, the author must register their work with the U.S. Copyright Office.³⁶ In addition to enforcing exclusive rights through litigation, registering a copyright with the U.S. Copyright Office allows additional remedies to infringement such as statutory damages, attorney's fees, and cost reimbursement.³⁷ In the United States, copyright protection for a work created on or after January 1, 1978, lasts for the life of the author plus seventy years after the author's death.³⁸

Copyright registration provides authors both “economic and moral rights” to their works, and various specific protections over their registered works.³⁹ In the United States specifically, copyright protection has its foundation in the U.S. Constitution's Intellectual Property Clause.⁴⁰ The Intellectual Property Clause establishes the power of Congress to “promote the [p]rogress of [s]cience and useful [a]rts, by securing for limited [t]imes to [a]uthors and [i]nventors the exclusive [r]ight to their respective [w]ritings and [d]iscoveries.”⁴¹ In summary, while the United States does not technically require copyright registration to maintain rights over a creative work, the fact that authors cannot utilize these rights to their maximum potential, or even pursue an infringement action, without registering with the U.S. Copyright Office demonstrates the weight the United States places on the actual registration of works eligible for copyright protection.

2. *In the European Union*

The European Union maintains a different set of copyright standards and procedures than the United States. The Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) provides automatic protection over copyrightable works, establishing that, “protection must not be conditional upon compliance with any formality[.]”⁴² While both the European Union and the United States are signatories to the Berne Convention,⁴³ the United States

³⁵ *Id.* § 106.

³⁶ *Id.* § 411.

³⁷ *Id.*

³⁸ *Id.* § 302.

³⁹ WHAT IS IP?, *supra* note 23, at 22.

⁴⁰ U.S. CONST. art. I, § 8, cl. 8.

⁴¹ *Id.*

⁴² *Summary of the Berne Convention for the Protection of Literary and Artistic Works (1886)*, WORLD INTEL. PROP. ORG. [hereinafter *Summary of the Berne Convention*], https://www.wipo.int/treaties/en/ip/berne/summary_berne.html (last visited Feb. 16, 2022).

⁴³ *Berne Convention*, COPYRIGHT HOUSE, <https://copyrighthouse.org/countries-berne-convention> (last

essentially requires registration for an author to actually enforce his or her exclusive rights.⁴⁴ Most Member States of the European Union, on the other hand, do not require any registration to bring an action against an infringer, although notice of copyright is recommended to assist in preventing infringement.⁴⁵

B. Trademark

As part of intellectual property, trademark law is internationally used in various markets to provide protection for brands and registrants or owners, but, most importantly, to protect consumers. Trademarks, which are generally words or symbols in the United States, are used as a method of identifying sources of goods and services for consumers and the general public.⁴⁶ WIPO explains trademarks as follows:

Trademark protection ensures that the owners of marks have the exclusive right to use them to identify goods or services, or to authorize others to use them in return for payment . . . [T]rademarks promote initiative and enterprise worldwide by rewarding their owners with recognition and financial profit. Trademark protection also hinders the efforts of unfair competitors, such as counterfeiters, to use similar distinctive signs to market inferior or different products or services.⁴⁷

While WIPO's explanation seems to reflect a prominent focus on protecting the rights of the entrepreneurs or businesses registering their marks for the purpose of owning them and obtaining rights and protections, the true focus of trademark protection is on the consumer.

The World Trade Organization explains that the purpose of trademark rights "aims to stimulate and ensure fair competition and to protect consumers, by enabling them to make informed choices between various goods and services."⁴⁸ This explanation straightforwardly addresses the theme of trademark protection and its primary focus on consumers.⁴⁹ However, to uphold this protection of consumers, it is important for trademark owners to have the ability to enforce their rights against unauthorized uses of their trademarks. Thus, the registration

visited Feb. 16, 2021).

⁴⁴ 17 U.S.C. § 411.

⁴⁵ WHAT IS IP?, *supra* note 23, at 20–23.

⁴⁶ *Id.* at 14.

⁴⁷ WHAT IS IP?, *supra* note 23, at 9.

⁴⁸ *What are Intellectual Property Rights?*, *supra* note 17.

⁴⁹ *Id.*

process is a crucial part of protecting the consumers referenced in the World Trade Organization's explanation.⁵⁰ Trademark rights' primary focus on the consumer, as opposed to the mark user, is prevalent in the ways the United States upholds its trademark system and protections.⁵¹

Trademarks are valuable and important to both mark owners and consumers for many reasons. One reason mark users and trademark owners benefit from registration of their marks is because registration provides the ability to prevent others from using marks in commerce, or stop unauthorized use.⁵² This right is an important source of protection against counterfeit items, for example, which have become especially prevalent during the COVID-19 pandemic.⁵³ When the pandemic began, mask sales were understandably on the rise.⁵⁴ When masks were mandated in numerous cities and states, people began purchasing even more,⁵⁵ and for those at high risk or with family at high risk, the reliability of the masks was even more crucial.⁵⁶ According to U.S. Homeland Security Investigations, its Operation Stolen Promise has made more than 3000 COVID-19 related seizures and has shut down thousands of fraudulent websites selling counterfeit masks.⁵⁷

In both the United States and the European Union, deciding whether a mark is eligible for trademark protection involves evaluating various levels of mark distinctiveness.⁵⁸ Deciding trademark protection eligibility also involves various categories of what can be considered a mark in the first place.⁵⁹ These categories

⁵⁰ *Id.*

⁵¹ *Lanham Trade-Mark Act*, FED. TRADE COMM'N, <https://www.ftc.gov/enforcement/statutes/lanham-trade-mark-act> (last visited Oct. 25, 2020); *About Trademark Infringement*, U.S. PATENT & TRADEMARK OFF., <https://www.uspto.gov/page/about-trademark-infringement> (last visited Feb. 18, 2022).

⁵² PROTECTING YOUR TRADEMARK, *supra* note 10, at 2, 3.

⁵³ *Viral Marketing, Counterfeits, Substandard Goods and Intellectual Property Crime in the COVID-19 Pandemic*, EUROPOL (Apr. 17, 2020), <https://www.europol.europa.eu/publications-documents/viral-marketing-counterfeits-substandard-goods-and-intellectual-property-crime-in-covid-19-pandemic>; *Trademark Counterfeiting and Consumer Fraud Related to the COVID-19 Outbreak*, U.S. PATENT & TRADEMARK OFF. (June 2, 2020), <https://www.uspto.gov/coronavirus/trademark-counterfeiting-and-consumer-fraud-related-covid-19-outbreak>.

⁵⁴ *Shortage of Personal Protective Equipment Endangering Health Workers Worldwide*, WORLD HEALTH ORG. (Mar. 3, 2020), <https://www.who.int/news/item/03-03-2020-shortage-of-personal-protective-equipment-endangering-health-workers-worldwide> ("To meet rising global demand, WHO estimates that industry must increase manufacturing by 40 per cent.").

⁵⁵ *Id.*

⁵⁶ *Considerations for Specific Groups of People*, U.S. CTRS. DISEASE CONTROL & PREVENTION, <https://www.cdc.gov/coronavirus/2019-ncov/prevent-getting-sick/cloth-face-cover-guidance.html> (last updated Feb. 25, 2022).

⁵⁷ *Operation Stolen Promise*, U.S. DEP'T HOMELAND SEC., <https://www.ice.gov/topics/operation-stolen-promise> (last updated Dec. 26, 2021).

⁵⁸ BARTON BEEBE, TRADEMARK LAW, AN OPEN-SOURCE CASEBOOK 34 (7th ed. 2020).

⁵⁹ *Id.* at 34–35.

of protectable marks are different in the trademark systems of the United States and the European Union. Neither trademark system allows for the protection of generic marks.⁶⁰ An example of a generic mark that is always generic is “cups” for a line of cups. An example of a mark that gradually becomes generic is “escalator.”⁶¹ The term “escalator” actually began as a registered trademark for the moving staircases now commonly found in malls and airports, but the mark became generic over time, thus losing its protectability.⁶² When consumers began to identify moving staircases as “escalators” as opposed to “Escalator-brand moving staircases,” the “escalator” mark started to become generic and ineligible for trademark protection.⁶³ Since trademark rights are used to distinguish the sources of goods and services for consumers, once a mark becomes generic, it can no longer be protected by trademark rights since the mark is no longer serving as a source identifier for the intended brand.⁶⁴

The Madrid System for the International Registration of Marks (Madrid System) allows trademarks from one country to be protected in numerous others as if they were primarily registered in those other countries.⁶⁵ For a mark to be protected in other countries under the Madrid System, a mark must first be registered and considered valid in its home country.⁶⁶ This home country registration and validity is called a Basic Mark.⁶⁷ Under the European Union Intellectual Property Office (EUIPO)’s current system, many marks which can now be registered in the United States⁶⁸ cannot pass muster in the European Union to achieve Basic Mark status.⁶⁹

⁶⁰ WHAT IS IP?, *supra* note 23, at 13.

⁶¹ See *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. 80 (1950).

⁶² *Id.*

⁶³ *Id.*

⁶⁴ U.S. PATENT & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01(c)(i) (July 2021).

⁶⁵ *Madrid Protocol*, U.S. PATENT & TRADEMARK OFF., <https://www.uspto.gov/ip-policy/trademark-policy/madrid-system-international-registration-marks-madrid-protocol> (last visited Feb. 25, 2022).

⁶⁶ *How the Madrid System Works*, WORLD INTELL. PROP. ORG., https://www.wipo.int/madrid/en/how_madrid_works.html (last visited Feb. 25, 2022).

⁶⁷ *Id.*

⁶⁸ See *Matal v. Tam*, 137 U.S. 1744 (2017).

⁶⁹ See *How the Madrid System Works*, *supra* note 66.

II. TRADEMARK SYSTEMS IN THE UNITED STATES AND EUROPEAN UNION

A. *Trademark in the United States*

On the one hand, copyright and patents, the intellectual property counterparts of trademark, have a constitutional basis in the Intellectual Property Clause.⁷⁰ Trademark rights in the United States, on the other hand, are Constitutionally grounded in the Commerce Clause.⁷¹ The Intellectual Property Clause serves to “promote the [p]rogress of [s]cience and useful [a]rts, by securing for limited [t]imes to [a]uthors and [i]nventors the exclusive [r]ight to their respective [w]ritings and [d]iscoveries.”⁷² While trademark is considered intellectual property,⁷³ the Commerce Clause has a different mission than the Intellectual Property Clause: promoting “fair and efficient competition.”⁷⁴ Therefore, trademark is foundationally seen as more of a protection relating to commerce than intellectual property.⁷⁵ Because copyright and patent are based in the Intellectual Property Clause,⁷⁶ trademark is distinct because its purpose is not to promote progress, but to assist in competition, trade, and commerce.⁷⁷ This distinction is important in deciding which works should be properly protected by copyright, which works should be properly protected by trademark, and which should be protected by both.

The foundation of trademark rights in the United States is codified in the federal statute, the Lanham Act.⁷⁸ An applicant for trademark registration and protection must submit either an application for registration to the U.S. Patent and Trademark Office (USPTO), which requires the mark has been used in commerce or, if the applicant chooses and has not yet used the mark in commerce, file an intent-to-use application.⁷⁹ An intent-to-use application allows an applicant time to begin to use the mark in commerce, but reserves their rights to the mark to an extent during the time between an intent to use application and actual use.⁸⁰ There *must* be satisfactory use of the mark in

⁷⁰ U.S. CONST. art. I, § 8, cl. 8.

⁷¹ *Id.* art. I, § 8, cl. 3.

⁷² *Id.* art. I, § 8, cl. 8.

⁷³ WHAT IS IP?, *supra* note 23, at 8–10.

⁷⁴ BEEBE, *supra* note 58, at 29.

⁷⁵ *Id.* (“Its goal is not to promote the progress of ‘Science and useful Arts’ but rather to promote fair and efficient competition.”).

⁷⁶ U.S. CONST. art. I, § 8, cl. 8.

⁷⁷ BEEBE, *supra* note 58, at 15.

⁷⁸ 15 U.S.C. § 1051.

⁷⁹ *Id.*

⁸⁰ PROTECTING YOUR TRADEMARK, *supra* note 10, at 21.

commerce by the trademark applicant for a mark to be protectable.⁸¹ According to the Lanham Act, use in commerce means, “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”⁸²

The first-to-use system requires use in commerce to establish priority rights. To satisfy use in commerce under this threshold requirement, the mark must be on the actual goods or their containers or displays. In the case of goods which would be impracticable to place the mark in the previously mentioned manners, the mark may be placed “on documents associated with the goods or their sale,” and the goods bearing the mark must be sold or transported in commerce.⁸³ As one example of use analysis for protection eligibility purposes, the U.S. Court of Appeals for the Ninth Circuit uses a “totality of the circumstances” test to analyze what qualifies as use, and deemed that sales are not dispositive in establishing use to satisfy the use requirement.⁸⁴

The United States has a two-tiered registration system consisting of the federal register and the state register.⁸⁵ The federal register consists of the Principal Register and the Supplemental Register, both of which provide different extents of trademark protection rights.⁸⁶ When a mark user files a registration application to obtain trademark rights from the Principal Register, the registrant has priority rights in the mark nationwide as of the date of application, provided the mark actually becomes registered on the Principal Register.⁸⁷ Keeping in mind the United States operates with a first-to-use priority rights system, this form of priority rights established when applying to the Principal Register may sound like a first-to-file system attribute; but these rights are framed as constructive use. In other words, the priority rights are conferred on the registrant not because of the act of filing, but because filing is considered a form of constructive use.⁸⁸ Constructive use is not to be confused with the requirement of *actual* use of a mark in commerce to uphold and maintain rights in a trademark.⁸⁹ The Supplemental Register affords protections to those marks which are not eligible for protection on the Principal Register because the marks

⁸¹ 15 U.S.C. § 1127.

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1205 (9th Cir. 2012).

⁸⁵ PROTECTING YOUR TRADEMARK, *supra* note 10, at 11–12.

⁸⁶ BEEBE, *supra* note 58, at 250–252.

⁸⁷ 15 U.S.C. § 1057(c).

⁸⁸ *Id.*

⁸⁹ 15 U.S.C. § 1127.

are deemed to lack secondary meaning—when a mark becomes so widely and closely associate with a brand that it is identifiable as the brand.⁹⁰

Common law trademark rights are also available on a limited scale to users who do not register their marks on either the Supplemental or Principal Register.⁹¹ An important part of the U.S. registration system is the *Abercrombie* classification spectrum.⁹² This spectrum of analysis, provided by the U.S. Court of Appeals for the Second Circuit in *Abercrombie & Fitch v. Hunting World, Inc.*, distinguishes between various classifications of marks.⁹³ The spectrum helps determine which types of marks are the most protectable, least protectable, or not protectable at all.⁹⁴

The marks, ranging from least protectable to most protectable, are: (1) generic marks, (2) descriptive marks, (3) suggestive marks, (4) arbitrary marks, and (5) fanciful marks.⁹⁵ The least protectable marks under the classification system are generic marks, which can never be protected under trademark registration.⁹⁶ The next classification includes descriptive marks, which are more protectable than generic, but require an acquisition of secondary meaning among consumers.⁹⁷ Descriptive marks are only eligible for protection if they are more than “merely descriptive” and are not mis-descriptive.⁹⁸ The third category classifies suggestive marks, which suggest what the product is, such as Coppertone for tanning oil. The fourth category includes arbitrary marks—one of the most protectable—such as Apple for computers, since consumers do not generally associate a fruit with technology. Lastly, fanciful marks, or made-up words, are considered to be the strongest base for registration, such as Exxon for gasoline.⁹⁹ This spectrum assists courts in determining whether a mark needs to acquire secondary meaning for the mark to achieve protectable rights and whether a mark is eligible for trademark protection to begin with.¹⁰⁰

While trademarks are usually associated with marks used on or for goods and products, there is also a category known as service marks.¹⁰¹ Service marks

⁹⁰ *Id.* § 1091(a).

⁹¹ EUROPEAN IPR HELPDESK, *supra* note 11, at 9.

⁹² *Abercrombie & Fitch v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976).

⁹³ *See id.*

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ BEEBE, *supra* note 58, at 45.

⁹⁸ *Id.*

⁹⁹ *Id.* at 63–64.

¹⁰⁰ *Id.* at 35.

¹⁰¹ EUROPEAN IPR HELPDESK, *supra* note 11, at 2.

are registered to protect activities and services performed for the benefit of others, outside of the company which would be registering the mark itself.¹⁰² Examples include restaurant services and shops for repairing goods or products. It is important to note that when registering a trademark, the class of goods or services listed on the application needs to be accurate.

For establishing priority trademark rights in challenges against marks, the United States uses a first-to-use system.¹⁰³ In a first-to-use priority rights system, the date in which a mark was first used in commerce is the date considered for whether a mark user may be given priority rights to the mark.¹⁰⁴ The priority rights extend over other users of the same mark in geographical territories (in addition to other users) even if the mark was not registered on or before the date the user began using the mark in commerce.¹⁰⁵ A first-to-use system prevents people or companies from acting as “trademark trolls,” registering and holding onto trademarks with no use, or intent to use, while attempting to utilize rights to the mark.¹⁰⁶ This is similar to what occurred in the Cancellation Division Proceeding regarding Banksy’s Flower Thrower mark.¹⁰⁷ The United States’ focus on use in commerce and rewarding priority rights to the first user of a mark are both consistent with the United States’ underlying trademark policy of protecting the consumer.¹⁰⁸

Allowing trademark rights for protectability of a mark provides an incentive for producers to generate a consistent quality of goods and services and maintain a high-quality of that good or service.¹⁰⁹ The incentive to create high-quality products can be connected to the fact that the mark user’s brand is associated with the products consumers purchase. To build up brand reliability and trust, mark holders produce a product of consistent quality which the consumer expects from that brand.¹¹⁰ Inconsistency, on the other hand, reduces the value of the trademark.¹¹¹ This can also be explained through the concept of

¹⁰² *Id.* at 2.

¹⁰³ *Id.* at 21.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ Vrinda Sehgal, *Trademark Trolls Causing Menace Around The World: How To Tackle The Problem?*, LEXOLOGY (Feb. 9, 2021), <https://www.lexology.com/library/detail.aspx?g=18eb14d5-a367-4119-8e23-2abb9166c2fc>.

¹⁰⁷ *See Full Colour Black Ltd. v. Pest Control Off. Ltd.*, No. 33843C (EUIPO Cancellation Div., Sept. 14, 2020).

¹⁰⁸ BEEBE, *supra* note 58, at 24.

¹⁰⁹ *Id.*

¹¹⁰ *Id.* (citing *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d. 1423 (7th Cir. 1985)).

¹¹¹ *Id.*

“credence” characteristics.¹¹² These characteristics, ideally positive ones associated with a brand through its consistency, are confirmed over time.¹¹³

In sum, trademark law and protection in the United States have a clear focus on the consumer as opposed to the mark user, even if a mark is registered. The use-in-commerce requirement is crucial to protection, as are consumer impressions, such as consumer confusion. Trademark owners may be able to enforce rights to a registered mark, but only to the extent that the mark is actually used in commerce. This focus on protecting the consumer is distinct from the underlying theme of copyright protection, which is to protect an author’s exclusive rights rather than protecting those consuming the creative work.¹¹⁴

B. Trademark in the European Union

The European Union Intellectual Property Office is the primary intellectual property source in the European Union. Its trademark system consists of expansive categories for what is eligible for trademark protection.¹¹⁵ Registrable marks under the European Union’s regime include (1) words; (2) figurative marks, such as the Adidas logo; (3) figurative marks containing word elements and shapes, such as a Coca-Cola bottle; (4) shape marks containing word elements; (5) position marks, meaning where the mark is placed; (6) pattern marks, such as the print for Louis Vuitton; (7) color marks; (8) color combination marks; (9) sound marks; and (10) motion marks.¹¹⁶ Two categories which are new as of October 1, 2017, are (11) multimedia marks and (12) hologram marks.¹¹⁷ Multimedia marks consist of combinations of sounds and images, which is a step forward in the world of technology and trademarks.¹¹⁸ Hologram marks “consist of elements with holographic characteristics.”¹¹⁹ The European Union also has a four-tier registration system: National, Regional, European Union-wide, and International.¹²⁰

¹¹² *Id.* (citing Phillip Nelson, *Advertising as Information*, 82 J. POL. ECON. 729 (1974)).

¹¹³ *Id.*

¹¹⁴ 17 U.S.C. § 106.

¹¹⁵ *Trade Mark Definition*, *supra* note 21.

¹¹⁶ *Trade Mark Examples*, EU INTEL. PROP. OFF., <https://euipo.europa.eu/ohimportal/en/trade-marks-examples> (last updated Feb. 3, 2020).

¹¹⁷ *Trade Mark Definition*, *supra* note 21.

¹¹⁸ *Trade Mark Examples*, *supra* note 116.

¹¹⁹ *Trade Mark Definition*, *supra* note 21.

¹²⁰ *Trade Marks in the European Union*, EU INTEL. PROP. OFF., <https://euipo.europa.eu/ohimportal/en/trade-marks-in-the-european-union> (last updated Feb. 2, 2016).

For establishing priority rights to a mark, the European Union uses a first-to-file trademark system.¹²¹ In a first-to-file priority rights system, priority ownership of a mark is given to the applicant who files first, based on the date of the actual filing as opposed to the use of the mark in commerce.¹²² Therefore, if there is a discrepancy between two of the same, or confusingly similar, marks, “[t]he right of priority has the effect that the date of priority will count as the date of filing of the EU trade mark application for the purposes of establishing which rights take precedence.”¹²³

Although filing is an instrumental step in the EU trademark prioritization process, the registered mark must be put to genuine use within five years following registration.¹²⁴ If the registrant does not make genuine use of its mark within five years, third parties can challenge the mark for non-use, potentially resulting in cancellation of the challenged mark.¹²⁵ Because use of the mark must occur within five years of its registration, it seems there is more leeway for qualifying use than the United States’ first-to-use system.¹²⁶ By giving the owner five years to use the mark, the EU system arguably better provides rights to those who are pursuing mark protection while potentially still establishing their business or goods. So, the European Union may place a focus on filing for priority rights, but like the United States, use in commerce still indicates priority for mark protection to be enforced.

While priority is given to those mark registrants and users who first filed, third parties may file oppositions against a mark.¹²⁷ If the third party who wants to oppose the filed mark misses the timeframe for bringing their opposition against the mark, they are even given a second chance to oppose.¹²⁸ On the EUIPO website, the rationale is explained: “[I]f the tables were turned, you might see it differently: imagine you had failed to observe the time limit for filing an opposition against one of your competitors’ trade marks.”¹²⁹ This explanation is interesting to note as it places more of a focus on the producer as

¹²¹ EUROPEAN IPR HELPDESK, *supra* note 11.

¹²² *Application and Registration Process*, Comment to *What Is the Difference Between Priority and Seniority?*, EU INTELL. PROP. OFF., <https://euipo.europa.eu/ohimportal/en/application-procedure> (last updated May 11, 2018).

¹²³ *Id.*

¹²⁴ *Strategy*, EU INTELL. PROP. OFF., <https://euipo.europa.eu/ohimportal/en/strategy> (last updated Feb 22, 2019).

¹²⁵ *Id.*

¹²⁶ *Id.*; BEEBE, *supra* note 58, at 24.

¹²⁷ *Strategy*, *supra* note 124.

¹²⁸ *Id.*

¹²⁹ *Id.*

opposed to the consumer, which is in contrast to the United States' clear focus on the consumer.¹³⁰

In addition to the second chance at challenging a mark, the European Union also utilizes a concept called a cooling off period.¹³¹ When an opponent completes an opposition which is deemed admissible, the EUIPO notifies the parties and a two-month period commences before the adversarial phase of the opposition.¹³² This allows both of the parties time to reach an agreement.¹³³ If both parties reach an agreement, neither party pays costs associated with opposition proceedings.¹³⁴

While prioritizing those who file first, the European Union gives ample opportunity to challenge a mark based on prior use,¹³⁵ which seems to slightly undermine the point of a first-to-file system. Additionally, filing multiple classes becomes costly and may hinder entrepreneurs from protecting their mark(s).¹³⁶ These fees add up quickly, and place a financial burden on those applicants who want their mark protected, but cannot necessarily afford to pay the fees and file. The resulting lack of priority rights in a first-to-file system is a disadvantage to the system as compared to a first-to-use. There is a chance that, on appeal, a business which had been using a mark without filing will not win the appeal. This allows those who had the resources and finances to file from the start to have a potentially unfair advantage.

In a first-to-file system, mark users acquire priority rights based on filing the mark first. In this kind of system, the ability to enforce registration rights solely by filing first could potentially result in brands and trademark users avoiding the process of attaining credibility among consumers over time.¹³⁷ The lack of time required to assert priority rights could be to the detriment of consumers as well if another brand were more credible, but did not file in time or win on appeal.¹³⁸ The fact that filing, as opposed to use, gives priority rights in a first-to-file system can also lead to businesses or other entities registering trademarks solely

¹³⁰ *Id.*; BEEBE, *supra* note 58, at 24.

¹³¹ *Opposition*, EU INTELL. PROP. OFF., <https://euipo.europa.eu/ohimportal/en/opposition> (last updated July 18, 2020).

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *See Forms and Filings*, EU INTELL. PROP. OFF., <https://euipo.europa.eu/ohimportal/en/forms-and-filings#invalidity> (last visited Feb. 25, 2022); EUROPEAN IPR HELPDESK, *supra* note 11.

¹³⁷ BEEBE, *supra* note 58, at 24 (citing Nelson, *supra* note 112.).

¹³⁸ *Id.* at 24–25.

to reserve them, and opens many doors for reserving trademarks through filing.¹³⁹

While there are many advantages to the trademark system and processes of the European Union, there are also numerous disadvantages. A primary disadvantage arises from the easy registration of marks given the variety of marks eligible for protection, especially combined with the ease of maintaining priority rights for the term allotted for use.¹⁴⁰

III. “DON’T SEND A TRADEMARK TO DO A COPYRIGHT’S JOB”¹⁴¹

In a recent decision by the EUIPO Cancellation Division on September 14, 2020, a registered trademark belonging to internationally “recognized” anonymous artist Banksy, through his company Pest Control Office Limited, was invalidated and the mark canceled due to bad faith filing.¹⁴² Banksy is a British street graffiti artist who is also a painter, activist, and filmmaker.¹⁴³ He has been active since the 1990s and his works are auctioned off for hundreds of thousands of dollars.¹⁴⁴ His breakthrough exhibition was “Turf War” in London in July, 2003.¹⁴⁵ More importantly, 2003 was the first appearance of his artwork “Flower Thrower” or “Love is in the Air[,]”¹⁴⁶ the mark at issue.¹⁴⁷

In 2005, Banksy “became an international star” after he painted children on the West Bank’s concrete wall in Palestine, including a girl holding balloons as she floats to the top of a wall.¹⁴⁸ Also in 2005, Banksy released his book, *Wall and Piece* which features Flower Thrower on the cover.¹⁴⁹ Banksy’s first major mistake with the court in this case was his inclusion of a quote on the page with

¹³⁹ EUROPEAN IPR HELPDESK, *supra* note 11.

¹⁴⁰ *See Trade Mark Definition*, *supra* note 21.

¹⁴¹ Tushnet, *supra* note 5.

¹⁴² Full Colour Black Ltd. V. Pest Control Off. Ltd., No. 33843C, at 15 (EUIPO Cancellation Div., Sept. 14, 2020).

¹⁴³ Will Ellsworth-Jones, *The Story Behind Banksy*, SMITHSONIAN MAG. (Feb. 2013), <https://www.smithsonianmag.com/arts-culture/the-story-behind-banksy-4310304>.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ *Banksy’s Rage, The Flower Thrower – Everything you Need to Know*, PUB. DELIVERY, <https://publicdelivery.org/banksy-flower-thrower> (last updated Aug. 22, 2021).

¹⁴⁷ Tim Lince, *Gross Domestic Failure—Banksy Trademark Portfolio “At Risk” After Registration Ruled Invalid*, WORLD TRADEMARK REV. (Sept. 14, 2020), <https://www.worldtrademarkreview.com/brand-management/gross-domestic-failure-banksy-trademark-portfolio-risk-after-eu-registration-declared-invalid>.

¹⁴⁸ Ellsworth-Jones, *supra* note 143.

¹⁴⁹ BANKSY, *supra* note 8, at 1.

information and credits: It states in bold, “Copyright is for losers©™” and an excerpt follows:¹⁵⁰

Against his better judgement Banksy has asserted his right under the Copyright, Designs and Patents Act, 1988 to be identified as the author of this work. . . . This book is sold subject to the condition that it shall not, by way of trade or otherwise, be lent, resold, hired out, or otherwise circulated without the publisher’s prior consent in any form of binding or cover other than that in which it is published and without a similar condition including this condition imposed on the subsequent purchaser[.]¹⁵¹

This excerpt is important for two primary reasons. First, this is a book Banksy authored and includes a provision about regulating the trade and commerce of the book, demonstrating his intention to be the sole user of it for distribution purposes unless consent is given, even if through the publisher.¹⁵² Second, Flower Thrower, the mark in the case at issue,¹⁵³ is on the cover of the book which it applies to.¹⁵⁴ The excerpt after the statement “Copyright is for losers” is also important in that it is seemingly contradictory to its preceding statement. In other words, despite stating, “Copyright is for losers[.]” Banksy immediately contradicts himself by demonstrating his desire to uphold his exclusive rights under protections afforded through copyright law. As previously addressed, the European Union is a signatory to the Berne Convention, which means there is no formal process to attain rights to a copyright-eligible work because the rights vest in the author as soon as the work is created.¹⁵⁵ Since the European Union allows this automatically vesting protection, Banksy was already afforded the rights he sought to utilize with this book excerpt, even though he claims that copyright is for losers.

After Banksy returned from painting Flower Thrower in Palestine, there was another London exhibition called “Crude Oils.”¹⁵⁶ This exhibit included 164 live rats running around the London gallery, which Smithsonian Magazine called “a signature Banksy touch[.]”¹⁵⁷ In 2011, the Museum of Contemporary Art in Los Angeles, California put on a show of street art and graffiti, which was a “high-

¹⁵⁰ *Id.* at 3.

¹⁵¹ *Id.*

¹⁵² *See id.*

¹⁵³ Full Colour Black Ltd. V. Pest Control Off. Ltd., No. 33843C (EUIPO Cancellation Div., Sept. 14, 2020).

¹⁵⁴ BANKSY, *supra* note 8, at 1.

¹⁵⁵ *Summary of the Berne Convention*, *supra* note 42.

¹⁵⁶ Ellsworth-Jones, *supra* note 143.

¹⁵⁷ *Id.*

profile demonstration of . . . the ‘Banksy effect’—the artist’s astounding success in bringing urban, outsider art into the cultural, and increasingly profitable, mainstream.”¹⁵⁸ The “Banksy effect” has been described as Banksy’s “visual commentary on contemporary social and political concerns” which “has taken many forms and his fame, public validation, and commercial success have helped pave the way for other street artists to emerge as key players in the global art market”¹⁵⁹

Considering the numerous popular exhibits utilizing his works,¹⁶⁰ the successful auctions, with his most recent raising almost ten million dollars,¹⁶¹ and the existence of his own “effect,”¹⁶² Banksy has definitely created a name and arguably a brand for himself, even without a face to go with the name. The issue arises, however, when trademark protection is used interchangeably with copyright, leaving the proper rights unenforced. Banksy may have arguably established a brand, but for the mark at issue, trademark was not the proper form of protection.

A. The EU Cancellation Division Case and Cancellation of Banksy’s Mark

Banksy’s persona as a public figure prominently includes his anonymity and use of a pseudonym.¹⁶³ He protects his identity with his pseudonym and by using the business Pest Control Office Limited to act on his behalf—registering his intellectual property, for example. Pest Control Office Limited was the filing party in the case at hand, in which a greeting card business sought cancellation of Banksy’s EU trademark for the work Flower Thrower in 2019.¹⁶⁴

Banksy, through Pest Control Office Limited, filed an EU trademark for the artwork Flower Thrower in 2014, and it was registered the same year.¹⁶⁵ In his application to file the mark, Banksy listed at least eleven classes of goods that

¹⁵⁸ *Id.*

¹⁵⁹ Sabrina DeTurk, *The “Banksy Effect” and Street Art in the Middle East*, 1 STREET ART & URB. CREATIVITY SCI. J. 22, 22 (2015).

¹⁶⁰ Ellsworth-Jones, *supra* note 143.

¹⁶¹ *Id.* Banksy’s work “Show Me the Monet” sold for \$9.8 million in October 2020, and “Forgive Us Our Trespassing” sold for \$8.3 million in 2005. Alastair Grant, *Banksy Artwork Sells for Almost \$10 Million at Auction*, SALEM NEWS (Oct. 23, 2020), https://www.salemnews.com/news/lifestyles/banksy-artwork-sells-for-almost-10-million-at-auction/article_99f1d189-1b1f-59f4-8028-cca6152a450d.html.

¹⁶² Ellsworth-Jones, *supra* note 143.

¹⁶³ *Id.*

¹⁶⁴ Full Colour Black Ltd. V. Pest Control Off. Ltd., No. 33843C, at 1 (EUIPO Cancellation Div., Sept. 14, 2020).

¹⁶⁵ *Id.* at 11.

he would supposedly use the mark on in commerce following registration.¹⁶⁶ The filing with the EUIPO meant that Banksy owned this mark,¹⁶⁷ and thus had priority rights to Flower Thrower regardless of whether he would actually use the mark on those goods in commerce over the five-year allotted term.¹⁶⁸ However, the fact that this was Banksy's work and registered as a trademark under his business was not enough to withstand the wrath of the cancellation proceeding. Moreover, while there were numerous issues with the registration which resulted in cancelation, a substantial part of the deficiencies was the amount of goods and services he listed in the application for the mark.¹⁶⁹

The EUIPO released its opinion on September 14, 2020, ruling that, six years after its successful registration, Banksy's Flower Thrower registered trademark was canceled because it was filed in bad faith.¹⁷⁰ The reasoning included that Banksy had no true intentions to use his trademark for the goods and services filed for.¹⁷¹ The EU filing by Pest Control Office Limited on behalf of Banksy listed at least eleven differing classes of goods to which the mark for Flower Thrower was supposedly going to apply.¹⁷² While the cancellation applied to all classes included in the filing, a main class to take note of is Class 16, which includes, "printed matter; stationery; photographs; posters; books; stencils; artists' materials; paint brushes; paper; apparatus for displaying pictures; pictures, prints of pictures, framed pictures; mounts for pictures; paintings."¹⁷³ This class sounds similar to the works covered by copyright such as photographs and books.¹⁷⁴ Classes such as this one add to the confusion of whether a mark or work should be protected by copyright, trademark, or both.

Banksy used his work in relation to these goods—he did use the work Flower Thrower for a few categories listed in the confusing Class 16, such as his use of the Flower Thrower mark on the cover of his book, *Wall and Piece*.¹⁷⁵ This book, which came out in 2006, is sold through retailers such as Barnes and Noble and Amazon.¹⁷⁶ Banksy has also used other registered marks on "certificates of

¹⁶⁶ *Id.* at 2.

¹⁶⁷ EUROPEAN IPR HELPDESK, *supra* note 11.

¹⁶⁸ *Id.*

¹⁶⁹ *Full Colour Black Ltd.*, No. 33843C, at 2, 11.

¹⁷⁰ *Id.* at 2.

¹⁷¹ *Id.* at 11; Lince, *supra* note 147.

¹⁷² *Full Colour Black Ltd.*, No. 33843C, at 2, 11.

¹⁷³ *Id.* at 2.

¹⁷⁴ 17 U.S.C. § 102.

¹⁷⁵ BANKSY, *supra* note 8.

¹⁷⁶ *Wall and Piece*, BARNES & NOBLE, <https://www.barnesandnoble.com/w/wall-and-piece-banksy/1101969414> (last visited Feb. 18, 2022).

authenticity released on Pest Control letterhead, and on some canvas frames.”¹⁷⁷ In terms of trademarks, these uses could help demonstrate that Banksy might be able to save his other registered marks which are not yet canceled. This could be accomplished by actually using the marks in commerce properly and consistently. For Flower Thrower, however, trademark protection was not the right choice.

Other interesting reasons for canceling Banksy’s trademark included his anonymity;¹⁷⁸ Banksy writing “[c]opyright is for losers” in his book, *Wall and Piece*;¹⁷⁹ and that “efforts to protect his trademark have been ‘inconsistent with honest practices.’”¹⁸⁰ The Cancellation Division, which handles trademark cancellation proceedings in the European Union,¹⁸¹ attributed Banksy’s anonymity to his desire to graffiti others’ property without their permission instead of using canvases or other property he owns.¹⁸² The Cancellation Division went on to explain that Banksy filed his trademark to achieve legal rights over his work because his anonymity prevents him from asserting any copyrights and questioned whether Banksy would even be a copyright holder since he remains anonymous and it cannot be determined definitively if he is the artist.¹⁸³

B. *The Milan Case and Copyright*

Another interesting case involving Banksy’s trademarks, including the formerly-registered Flower Thrower, occurred in Milan through the Milan Intellectual Property Court.¹⁸⁴ This case consisted of mainly the same factors, such as Banksy’s use of his registered trademarks, or lack thereof. In this case, however, the outcome was more in Banksy’s favor for a different reason than

¹⁷⁷ Enrico Bonadio, *Banksy Finally Goes to Court to Stop Unauthorised Merchandising, Despite Saying Copyright Is for Losers*, CONVERSATION (Feb. 25, 2019), <https://theconversation.com/banksy-finally-goes-to-court-to-stop-unauthorised-merchandising-despite-saying-copyright-is-for-losers-112390>.

¹⁷⁸ Georgia Coggan, *Banksy Chooses Anonymity over His Trademark Rights*, CREATIVE BLOQ (Sept. 18, 2020), <https://www.creativebloq.com/news/banksy-trademark-loss>.

¹⁷⁹ *Id.*; BANKSY, *supra* note 8.

¹⁸⁰ Coggan, *supra* note 178.

¹⁸¹ *Trade Mark Guidelines*, EU INTELL. PROP. OFF., <https://guidelines.euipo.europa.eu/1803468/1787334/trade-mark-guidelines/1-introduction-%E2%80%94-general-outline-of-cancellation-proceedings> (last visited Jan. 19, 2021).

¹⁸² Lince, *supra* note 147.

¹⁸³ *Full Colour Black Ltd. v. Pest Control Off. Ltd.*, No. 33843C, at 9 (EUIPO Cancellation Div., Sept. 14, 2020).

¹⁸⁴ Elena Martini, *The Milan IP Court on the Protection of Banksy Works Against Unauthorised Reproductions*, MARTINI MANNA (Mar. 15, 2019), <http://www.martinimanna.com/the-milan-ip-court-on-the-protection-of-banksy-works-against-unauthorised-reproductions>.

upholding trademark rights.¹⁸⁵ The Milan court found in the preliminary hearing that rights to the marks Banksy was asserting needed to be utilized through copyright protection instead of a trademark.¹⁸⁶

The case was brought against the Milan museum, Mudec Museum of Cultures, because the museum opened an exhibition using Banksy's name in the title and featured more than seventy of Banksy's works.¹⁸⁷ The museum also sold merchandise with Banksy's marks, among other things.¹⁸⁸ The museum did not attain Banksy's authorization to open the exhibition bearing Banksy's name and works, nor his authorization to use the marks on merchandise.¹⁸⁹ Through Pest Control Limited, Banksy claimed the museum's use of "Banksy" for the exhibition's title, the promotional materials and publications, the catalogue for the exhibition, and sales of merchandise bearing the Banksy word mark qualified as trademark infringement¹⁹⁰ and unfair competition.¹⁹¹ The marks included in the infringement claim were the BANKSY word mark itself and figurative marks, including Flower Thrower,¹⁹² the main mark at issue in the EUIPO case.¹⁹³

Once again, his anonymity was a hindrance to the outcome of the case, as Pest Control Office Limited "only achieved a partial, and indeed limited, grant of its claims."¹⁹⁴ The Milan IP Court looked at the bigger picture in analyzing the case than the EUIPO case, reasoning, "the presence on the market of products bearing the same trademark and not attributable to its legitimate holder would determine at least an undoubted dilution of its distinctiveness, which would not be fully recoverable through a mere economic compensation."¹⁹⁵ In determining whether the use of the mark on merchandise was lawful, the judge reasoned that the merchandise was not related to the Banksy Exhibition specifically, and was "purely commercial."¹⁹⁶

¹⁸⁵ *Id.*

¹⁸⁶ Mario Consani, *Banksy Is a Brand, War on the Milan Exhibition*, IL GIORNO MILAN (Feb. 22, 2019), <https://www.ilgiorno.it/milano/cronaca/banksy-1.4455040>.

¹⁸⁷ Chiara Marchisotti & Lydia Mendola, *Banksy: A Trademark Protest – Milan Court Partially Rules Out Trademark Infringement*, PORTOLANO CAVALLO (Mar. 2, 2019), <https://portolano.it/newsletter/portolano-cavallo-inform-digital-ip/banksy-a-trademark-protest-milan-court-partially-rules-out-trademark-infringement>.

¹⁸⁸ *Id.*

¹⁸⁹ *Id.*

¹⁹⁰ *Id.*

¹⁹¹ Martini, *supra* note 184.

¹⁹² Marchisotti & Mendola, *supra* note 187.

¹⁹³ Lince, *supra* note 147.

¹⁹⁴ Martini, *supra* note 184.

¹⁹⁵ *Id.*

¹⁹⁶ Marchisotti & Mendola, *supra* note 187.

One author of an Italian article regarding the case asserts:

Banksy is a brand like Coca-Cola and Nutella. Not only because the name of the English artist and writer without identity passed from street art to museums, but because it is now a successful brand recognized worldwide and not only in art. Additionally, the name “Banksy” was filed and registered in a special London office and is therefore legally protected in itself.¹⁹⁷

The author points out that Banksy is a brand that has attained international recognition. Banksy filed and registered the name “Banksy” as a trademark, providing legal protection for the mark.¹⁹⁸

Because Banksy had filed and successfully registered EU trademarks for both his word mark and the Flower Thrower mark before this case,¹⁹⁹ it would seem as though his priority rights would be more prevalent. However, that was not the case,²⁰⁰ because, inter alia, the EUIPO court did not approve of Banksy’s negative statement in his book regarding intellectual property rights.²⁰¹ Additionally, the court did not appreciate the note Banksy and Pest Control Office Limited used with the shop established to sell Banksy merchandise, which included the statement, “I still encourage anyone to copy, borrow, steal and amend my art for amusement, academic research or activism. I just don’t want them to get sole custody of my name.”²⁰² In the statement, Banksy acknowledged that his trademark was registered, that he wanted to maintain and utilize the trademark rights, and pointed out that the opposing company was selling merchandise with his mark on it.²⁰³

The Cancellation Division reasoned that Banksy only made use of the mark after the proceedings were initiated against him.²⁰⁴ This is arguably not entirely the case, because in the past Banksy had used the mark on his book, as was asserted in the Cancellation Division’s proceedings.²⁰⁵ The Cancellation Division also reasoned that Banksy’s use of the mark was merely trying to

¹⁹⁷ Consani, *supra* note 186.

¹⁹⁸ *Id.*

¹⁹⁹ Marchisotti & Mendola, *supra* note 187.

²⁰⁰ Simon Casinader & Ravena Guron, *Don’t Bank-sy on Trademarks: Banksy Loses EU Trademark Due to “Bad Faith”*, NAT’L L. REV. (Sept. 23, 2020), <https://www.natlawreview.com/article/don-t-bank-sy-trademarks-banksy-loses-eu-trademark-due-to-bad-faith>.

²⁰¹ BANKSY, *supra* note 8.

²⁰² Full Colour Black Ltd. v. Pest Control Off. Ltd. No. 33843C, at 11 (EUIPO Cancellation Div., Sept. 14, 2020); Lince, *supra* note 147.

²⁰³ Full Colour Black Ltd., No. 33843C, at 11; Lince, *supra* note 147.

²⁰⁴ Full Colour Black Ltd., No. 33843C, at 11; Lince, *supra* note 147.

²⁰⁵ BANKSY, *supra* note 8; Full Colour Black Ltd., No. 33843C, at 10.

circumvent the non-use requirement under EU law, and therefore Banksy had “no intention to genuinely use the sign as a trademark.”²⁰⁶ While Banksy did set up his shop with a note explaining its establishment was to prevent a company from “attempting to take custody” of the Banksy name and mark to “sell their fake Banksy merchandise legally[,]”²⁰⁷ he still did set up the shop. Indeed, the note with the shop seemed to be the result of a trademark owner attempting to secure his rights which were supposedly already secured.²⁰⁸ However, this was a failed effort because of the underlying issue of registering this work as a figurative mark. Once again, in the words of Rebecca Tushnet, Banksy “sent a trademark to do a copyright’s job.”²⁰⁹

From the facts evaluated by the Cancellation Division in its decision, Banksy could have done a much better job in using his mark in commerce to acquire rights past the initial filing of the mark.²¹⁰ Banksy is an internationally-known “brand[.]”²¹¹ Even though “[a]ll trademarks are brands, while not all brands are trademarks,”²¹² Banksy had established a brand *and* registered trademarks for protection.²¹³ His works are exhibited internationally,²¹⁴ and consumers know his name and his style of work and associate it with Banksy.²¹⁵ In addition to being internationally recognized,²¹⁶ Banksy did, in fact, sell items in commerce bearing the mark at issue—he used the mark on books that are for sale.²¹⁷ Thus, while he could have done much more, he did use the mark he believed he held the rights to. This leads to the question of whether the EU filing system should be stricter and set out more limitations at the outset to prevent costly proceedings and cancellation after years of believing a filed mark was protected. Additionally, all these considerations may be important for future registered marks, or even Banksy’s current registered marks which have not yet been canceled. However, for Flower Thrower, Banksy should have stuck to trademark requirements or utilized copyright protection instead.

²⁰⁶ Lince, *supra* note 147.

²⁰⁷ *Id.*

²⁰⁸ *Id.*

²⁰⁹ Tushnet, *supra* note 5.

²¹⁰ Full Colour Black Ltd. v. Pest Control Off. Ltd. No. 33843C, at 11 (EUIPO Cancellation Div., Sept. 14, 2020).

²¹¹ Consani, *supra* note 186.

²¹² *Trademark vs. Brand: Everything You Need to Know*, UPCOUNSEL, <https://www.upcounsel.com/trademark-vs-brand> (last visited Feb. 25, 2022).

²¹³ Lince, *supra* note 147 (emphasis added).

²¹⁴ Ellsworth-Jones, *supra* note 143.

²¹⁵ *See* Consani, *supra* note 186.

²¹⁶ *Id.*

²¹⁷ BANKSY, *supra* note 8.

C. *Banksy and the Case for Copyright*

Both the Cancellation Division proceeding of Flower Thrower²¹⁸ and the Milan IP Court case²¹⁹ found that Banksy went wrong by using trademark law instead of copyright to protect his works. This is a prime example of using trademark as a backup for copyright in a situation where copyright was, and still is, an obvious choice. In Banksy's situation, aside from his clear disdain for copyright protection as exemplified in his book,²²⁰ his anonymity seems to be consistently at the forefront of his actions. This anonymity is for good reason, since it has resulted in a large part of his appeal. In the Cancellation Division's proceeding the EUIPO asserted, "To protect the right under copyright law would require him to lose his anonymity which would undermine his persona."²²¹

Banksy had the potential for an outcome in his favor in the EU cancellation proceeding, had he used his registered mark in the ways he claimed he would when registering with the EUIPO. The shop was a good start for Banksy, and he seemed to have the right foundation for establishing actual use in commerce with Flower Thrower.²²² However, Banksy needed to actually *use* his registered mark in commerce, thus demonstrating he registered for the underlying policy reasons trademark protections exist (i.e., protecting consumers), and not just to make up for refusing to pursue copyright rights and protections.

CONCLUSION

As demonstrated through the analysis of Banksy's (mis)adventures in trademark rights, copyright and trademark differ in the protections they offer. As trademark becomes more expansive in the categories of marks it covers, copyright and trademark may need to develop a more precise barrier so the two protections do not step on each other's toes.

The need for a barrier between the two protections is especially prevalent because in a world of consistently growing technology and development, there is sure to be an ever-more expansive list of eligible marks in the future.²²³ The trademark registration system of the European Union provides prime examples of the impact of growing technology on what is eligible for trademark

²¹⁸ Full Colour Black Ltd. v. Pest Control Off. Ltd., No. 33843C, at 3 (EUIPO Cancellation Div., Sept. 14, 2020).

²¹⁹ Consani, *supra* note 186.

²²⁰ BANKSY, *supra* note 8.

²²¹ Full Colour Black Ltd., No. 33843C, at 3.

²²² Lince, *supra* note 147.

²²³ See *Trade Mark Definition*, *supra* note 21.

registration and protection. One example is from 2017, when the EUIPO introduced another category of marks which are eligible for trademark protection under their registration system: hologram marks.²²⁴ The list will continue to grow as technology does, as will the scope of what is eligible for copyright protection.²²⁵

While a work can be eligible for protection from both trademark and copyright systems, trademark is a category which must be used wisely when in combination with copyright. Trademark should not be used as a backup for copyright protection if the reason for registering is solely to expand rights or monopolize a work. Additionally, using trademark as a backup for copyright can lead to questionable behavior and false “use” of the work. In other words, individuals can register copyrightable works under trademark protection for the wrong reasons. An example of a “wrong reason” which takes advantage of the trademark system in bad faith is registering a work as a mark solely to attain a longer term of rights to a work through trademark protections, while only providing the bare minimum use requirement to maintain the protection.

Trademark can and should be used in conjunction with copyright protection and registration, so long as the registrant is utilizing trademark and its protections for its core function and purpose relating to use of marks in commerce.²²⁶ If individuals or companies begin using trademark as a backup for copyright, it could add to the issue of trademark being a depletable system.²²⁷ It could also create burdensome issues for the organizations which handle trademark proceedings, as there would be a rise in cancellation requests and oppositions, taking up valuable time and money from the organizations and courts.

Banksy’s anonymity is part of his brand and persona, as even the Cancellation Division acknowledged, and to reveal his identity would likely damage his brand and the mystery that makes Banksy so internationally appealing.²²⁸ This anonymity, and the belief that he is unable to assert rights as

²²⁴ *Id.*

²²⁵ The scope-changing in copyright is exemplified in changes such as the Digital Millennium Copyright Act. Pub. L. 105-304, 112 Stat. 2860 (codified in scattered sections of 17 U.S.C.). Another change is the brand-new copyright registration in the United States, Group Registration of Works on an Album of Music, which covers multiple songs on a music album with different producers, and songwriters. *See* 37 C.F.R. §§ 201–02 (2022); Group Registration of Works on an Album of Music, 86 Fed. Reg. 10820–26 (Feb. 23, 2021).

²²⁶ U.S. CONST. art. I, § 8, cl. 3.

²²⁷ Beebe & Fromer, *supra* note 6, at 951 (“The supply of word marks that are at least reasonably competitively effective as trademarks is finite and exhaustible.”).

²²⁸ Full Colour Black Ltd. v. Pest Control Off. Ltd. No. 33843C, at 12 (EUIPO Cancellation Div., Sept. 14, 2020).

an anonymous artist, is a major reason Banksy chose to pursue trademark protection as opposed to copyright.²²⁹ While he expresses that he is not the biggest fan or supporter of intellectual property rights,²³⁰ he will need to become more open-minded to either (1) use his registered marks in commerce in a way that genuinely meets the use requirement, or (2) expand his horizons by pursuing rights to his works under copyright protection.

In this scenario, primarily involving his work *Flower Thrower*, trademark was clearly not the appropriate choice for Banksy to protect his rights to the work of art. This was demonstrated because Banksy seemed to specifically choose trademark as a replacement for copyright protection, because he does not approve of or support copyright, as opposed to a genuine desire or plan to use the mark in commerce.²³¹ However, something to consider is that the rights attributed to copyright automatically vest in the author of a work once the work is created and in a fixed medium.²³² Thus Banksy as an author obtains rights to his paintings and designs as soon as they are on a canvas or some other form of fixed medium.²³³ This automatic vesting of rights is one of the elements provided under the Berne Convention, to which both the United States and the European Union are signatories.²³⁴ Going forward, Banksy should begin, even if slowly, utilizing the marks in commerce so he prevails in asserting his rights and preserving his anonymity.

Banksy's anonymity could also potentially coexist with copyright. One way this could work is if Banksy uses a work-made-for-hire copyright scheme to obtain rights to his work in a roundabout way. In a work-made-for-hire agreement, the employer for which the author works owns the rights to the copyrightable work.²³⁵ For the U.S. trademark regime, the relevant provision explains that "the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright."²³⁶ Using this scheme for copyright registration of his works could be done through Pest Control Office Limited. This would only apply to Banksy's future works, however, since there would

²²⁹ *Id.*

²³⁰ BANKSY, *supra* note 8.

²³¹ *Full Colour Black Ltd.*, No. 33843C, at 9.

²³² 17 U.S.C. § 102.

²³³ *Id.*

²³⁴ COPYRIGHT HOUSE, *supra* note 45.

²³⁵ 17 U.S.C. § 201(b).

²³⁶ *Id.*

need to be an actual agreement establishing that the work at issue will qualify as a work-made-for-hire.²³⁷ Using copyright registration through a work-made-for-hire agreement with Pest Control Office Limited, which already files intellectual property rights for Banksy, is a potential way for him to gain rights to his future works while upholding the anonymity that is so important to his persona. In the meantime, however, so long as Banksy maintains his well-known view that “copyright is for losers,”²³⁸ trademark is Banksy’s best chance at gaining and upholding rights to his works. That is on the condition, though, that he would use the mark in commerce and use trademark rights and protections as they were meant to be used, and not for trademark trolling.²³⁹

While a stricter process to register rights with the EUIPO could resolve a few of these issues, such as clarifying Class 16 registrations further, the real problem is falsely using copyright and trademark as interchangeable protections. As demonstrated throughout this Comment, while there may be confusing references and themes conveying creativity for both copyright and trademark, there are true and concrete distinctions between the protections regardless of the country in which protections exist. Copyright is to protect authors, affording exclusive rights to their creative works, regardless of the creative work’s popularity among consumers. Trademark is to protect consumers, focusing on the actual use in commerce and consumer confusion. If an author wants to use their creative work in a manner consistent with trademark practices, both copyright and trademark protection are appropriate. As demonstrated in the unfortunate cancellation of Banksy’s Flower Thrower, a creative work used in a manner consistent solely with copyright is not meant to be covered through trademark protection.

SHELLY KURLAND*

²³⁷ *Id.*

²³⁸ BANKSY, *supra* note 8.

²³⁹ A trademark troll, or opportunistic trademark registrant, is “a person or entity that registers a trademark without any intent to lawfully use that mark.” Sharon Urias, *Trademark Trolling*, LEXOLOGY (Oct. 11, 2018). Once a trademark troll obtains protections via registration, they “will seek out “infringers,” i.e. persons using a similar mark, and demand licensing fees, upon threat of a lawsuit. *Id.* Alternatively, the trademark troll will offer to sell the mark for a profit.” *Id.*

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