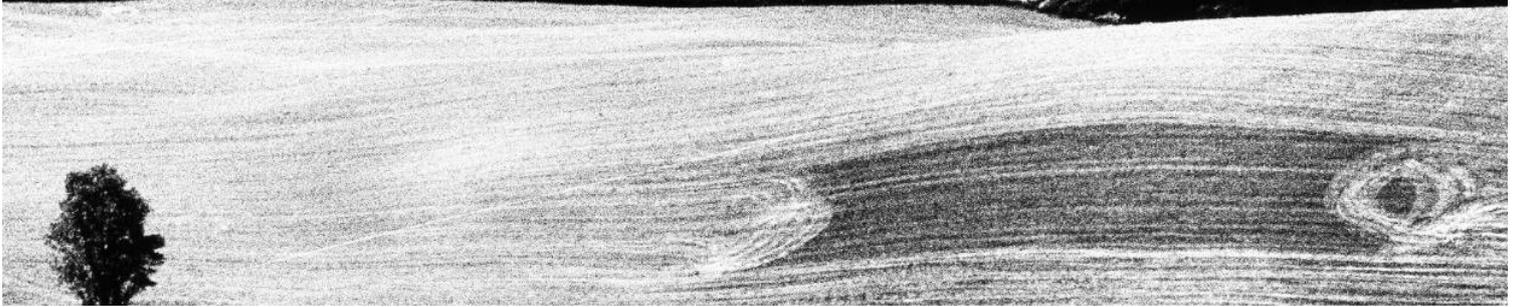


Newsalert

IP, TMT and Data Protection Department

The Banksy case: the EUIPO Cancellation Division declares invalid due to bad faith the trademark filed on behalf of the artist reproducing one of his most famous works



On 14 September 2020, the EUIPO Cancellation Division ('EUIPO') declared invalid the following figurative trademark, reproducing one of the most iconic works of Banksy (so called '*Flower Thrower*'), appeared as a street graffiti on a wall on the side of a garage in Jerusalem in 2005:



The decision was issued in the framework of the cancellation proceedings (No. 33 843 C) commenced by Full Colour Black Limited ('**Applicant**') against the above figurative EUTM No. 12 575 155 ('**Trademark**') filed in 2014 by Pest Control Office Limited ('**EUTM Proprietor**').

The Applicant sought a declaration of invalidity of the Trademark, mainly on the ground of bad faith under Article 59(1)(b) EUTMR as it appeared that the EUTM Proprietor had no intention to use it. According to the Applicant, the Trademark represented an attempt (i) to prevent the ongoing use of the relevant work and (ii) to monopolize the image in suit on an indefinite basis, overcoming the application of the relevant copyright law provisions.

The EUTM Proprietor – the likely legal representative of Banksy – objected to the opposing party's arguments, noting that the latter failed to prove the Trademark was filed in bad faith. In particular, the Applicant did not prove that Banksy gave free reign to the public to use his works nor that did he allow any commercial and/or non-commercial use of it.

In assessing the case, the EUIPO reminded that there is no legal definition of '*bad faith*'. This is a subjective state regarding the trademark applicant's intentions at the time of the trademark filing. This being the relevant moment in time, the decision emphasizes that elements of evidence on the intention at the time of filing the application can also be drawn from facts that occurred before or after the filing, if suitable for indicating the intentions to use the trademark in question. The burden of allegation and proof regarding the alleged bad faith lies upon the party seeking a declaration of invalidity of the trademark. Should bad faith be duly proven, it will be up to the trademark owner to demonstrate the existence of a legitimate reason for the filing of application.

That being said, the EUIPO noted that:

- it would be difficult for Banksy (or the EUTM Proprietor) to enforce copyright to prevent the reproduction of the works, due to e.g. the anonymity of the author and the consequent difficult identification, as well as the ways in which the works were expressed/created (affixing to the property of third parties without their permission, and in public places such as to allow indiscriminate viewing and photographs), although the decision expressly notes that the issue of copyright's existence goes beyond the scope of the trademark (cancellation) proceedings;
- the EUTM Proprietor expressly allowed the public to download and use the works, upon the sole condition that no commercial use was made thereof. On the other hand, Banksy has long been aware of the use by third parties of his works on a number of goods and products and, although he did not give his consent to such uses, he did not even take any legal action against them;
- at the time of instigation of the cancellation proceedings, the EUTM Proprietor and/or Banksy had never marketed or sold products bearing the Trademark. Banksy commenced offering for sale goods bearing the Trademark only after the cancellation proceedings hereof were instigated, expressly (and "unfortunately") declaring – together with his representative – that this initiative was determined by the need to demonstrate the use of the works as a trademark for the purposes of the relevant provisions of law.

In light of the above, the EUIPO concluded that – at the time of the Trademark filing – Banksy and/or the EUTM Proprietor did not have any intention to genuinely use the Trademark in accordance with its functions as a distinctive sign, but substantially to evade the issues that make it difficult to protect the works under copyright.

The EUIPO therefore considered '*objective, relevant and consistent*' evidence to exist in the sense of placing at the basis of the trademark registration application the intention '*of undermining the interests of third parties, in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark*' and, therefore, a conduct amounting to '*bad faith*' according to the criteria set out by the European Court of Justice in the Sky vs. Skykick judgment of 29 January 2020, case C-371/18.

As a result, the EUIPO declared the Trademark invalid for all the contested goods and services. The decision can be appealed.

Eventually, it should be noted that the decision takes into account and reports certain alleged Banksy's statements in principle highly critical about intellectual property, including the line '*copyright is for losers*', albeit it affirms that the aversion showed for such institution is not generally able to undermine valid exclusive rights possibly held by the artist (which anyhow was not the case).

Contatti

Paolo Bertoni

Of Counsel - Chiomenti
Dipartimento IP, TMT e Data Protection
T+39.02.72157.679
paolo.bertoni@chiomenti.net

Sara Molina

Senior Associate - Chiomenti
Dipartimento IP, TMT e Data Protection
T+39.02.72157.476
sara.molina@chiomenti.net

Anna Gardini

Counsel - Chiomenti
Dipartimento IP, TMT e Data Protection
T+39.02.721.571
anna.gardini@chiomenti.net