

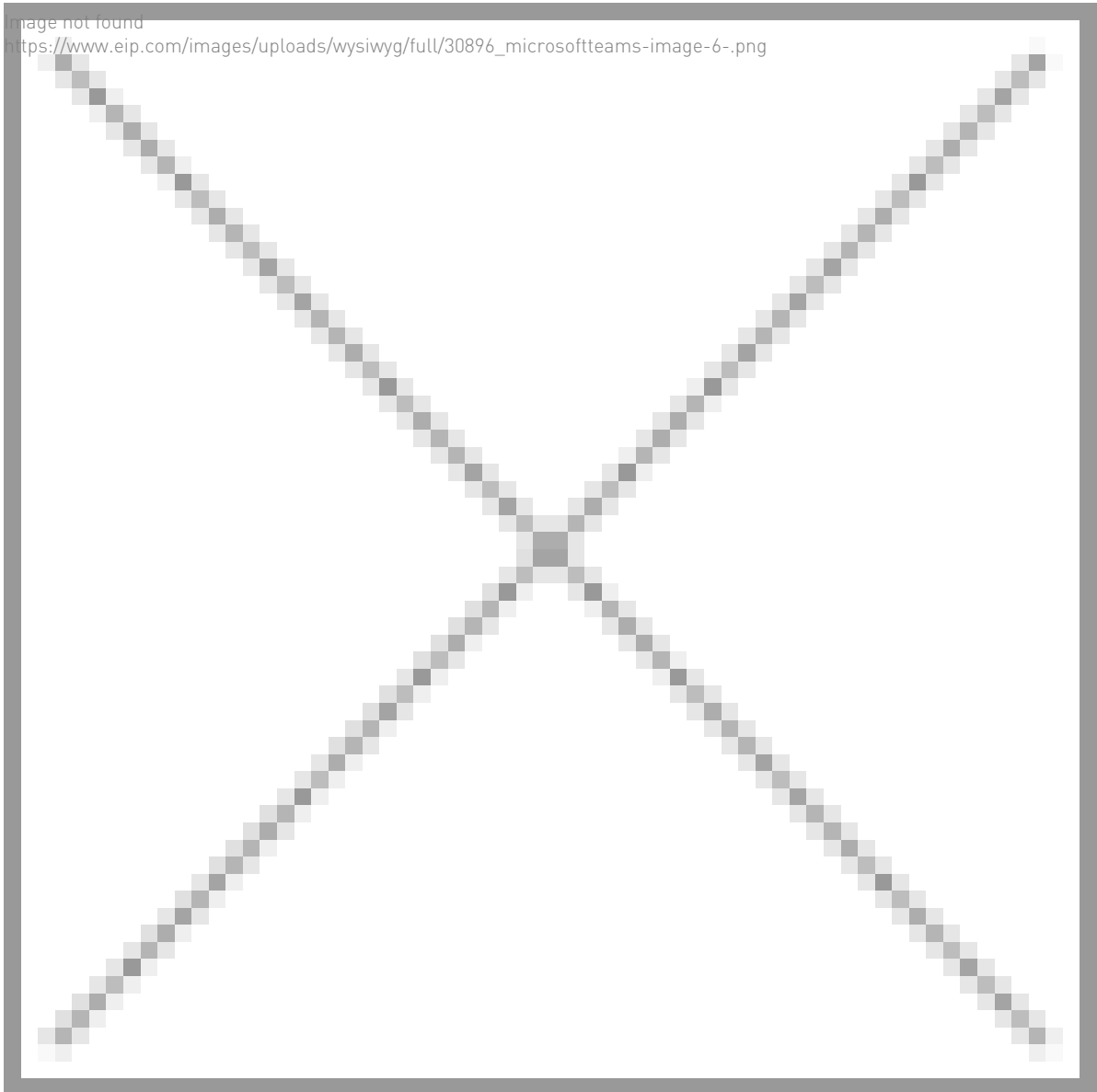
EIP



Banksy isn't monkeying around when it comes to EU trade marks

Background

Pest Control Office Limited (the “**EUTM proprietor**”), on behalf of Banksy, sought to register the figurative mark of a monkey wearing a sign (figure 1) in a number of categories, including games, clothing and education. The mark was registered on 8 June 2019, after which it was opposed by Full Colour Black Limited (the “**Cancellation applicant**”), who requested a declaration of invalidity on 28 November 2019.



The mark was declared to be invalid by the Cancellation Division on 18 May 2021, on the basis that Pest Control Office Limited had acted in bad faith by filing the application, as it believed that, at the time of filing, the company and Banksy had no intention to use the mark according to its function. In finding this decision, the Cancellation Division held that, as Pest Control Office Limited was acting as an agent of Banksy, Banksy's actions are "attributable to the EUTM proprietor in view of the assessment on the alleged bad faith".

The Board of Appeal had a significant number of issues to review. In support of its position, the Cancellation applicant relied on a witness statement produced by a lawyer who filed the request for invalidity against a different trade mark filed by the EUTM proprietor, which was found to be invalid on 14 September 2020. The Board of Appeal therefore considered that the witness statement "has to be considered as coming from the sphere of the Cancellation applicant" and would therefore have "less probative value, and must be corroborated by other objective and independent evidence".

Article 7(1)(c) EUTMR

The first area that the Board of Appeal considered in detail was whether the Cancellation Division was correct to find that the mark had breached article 7(1)(c) of the European Union Trade Mark Regulation (the “**EUTMR**”). This article is the equivalent to section 3(1)(c) of the Trade Marks Act 1994 (as amended) (the “**TMA 1994**”) prohibiting registration of marks which consist solely of signs that are descriptive. The Cancellation applicant submitted that the sign “gives already the impression of a mere decorative artwork”, due to its use before the filing date both by Banksy and by different customers. The Board felt that the Cancellation applicant’s evidence on this point was not convincing, and that, since the Board “must not carry out any further examination on its own motion”, the Cancellation Division was not correct to find that the mark was invalid based on this ground.

Bad Faith

Under Article 59(1)(b) of the EUTMR, a trade mark cannot be registered if the application was made in bad faith. This is equivalent to section 3(6) of the TMA 1994. The Cancellation division based its decision on bad faith on a number of reasons, including a lack of intention to use the mark, comparisons with copyright law, and the public dissemination of the mark by both Banksy himself and by Banksy’s encouragement of the general public to use the mark provided it was not for commercial purposes.

Lack of intention to use the mark

The Cancellation applicant claimed that Banksy’s creation of the mark as a public artwork, and subsequent provision of the artwork on his website and encouraging non-commercial copying of the work, were evidence that he had no intention to commercialize the mark. The Cancellation applicant also suggested that the EUTM proprietor only utilized the trademark registration procedure because it would not be possible to claim copyright in the mark, as to do so Banksy would need to provide personal details, thereby ruining his anonymous status.

The Board of Appeal rejected these arguments. They pointed out that Banksy specifically limited any permission to copy the artwork from his website to non-commercial uses, and that any commercial copying was therefore not permitted. They also pointed out that this website and its original creation in a public location did not prevent the use of the mark by the EUTM proprietor, nor suggest that they had no intention to do so. The Board of Appeal also pointed out that even if the Cancellation applicant was correct that Banksy would not be able to claim copyright in the work without jeopardizing his anonymous status, that does not prove that he had no intention of using the mark.

Finally, the Board of Appeal distinguished this case from a previous case regarding one of Banksy's works, *Holy et al.*, T-367/16, EU:T:2018:28, in which the 5 year grace period had already ended. In this case, the 5 year grace period will not finish until June 2024, and the invalidity proceedings were filed less than six months after the registration of the mark.

Purpose of filing to prohibit the use by third parties

Another argument the Cancellation applicant made was that the purpose of filing the mark was to prohibit "the use of the artwork contained in the contested mark which had previously been permitted". The Board of Appeal stated that the owner of a trade mark may withdraw its permission to use the mark at any time, and that this is therefore not an abuse of the system.

Purpose of circumventing copyright law

The Board of Appeal rejected this ground outright, stating that "the same artwork can be protected by copyright as well as by trade mark law", and that therefore there is no abuse in requesting registration of a trade mark for a work that could also be covered by copyright.

Purpose of circumventing US trade mark law provisions

The final ground argued by the Cancellation applicant was that the mark was registered in the EU in order to base a US trade mark application on this application, rather than showing actual use of the mark in the US or the intention to use the mark in the US.

The Board of Appeal found this argument to be circular – the EUTM proprietor would be acting in accordance with US law by basing an application on a foreign registration, such as the EU registration. They therefore cannot be acting in bad faith by doing so, unless the EU registration was made in bad faith.

Overall

The Board of Appeal felt that the Cancellation applicant had not in fact proved that the EUTM proprietor had acted in bad faith or had breached Article 7(1) EUTMR and that therefore the Cancellation Division was incorrect when cancelling the mark. The Board of Appeal therefore reinstated the mark, and ordered that the Cancellation applicant pay the costs of the EUTM proprietor.