

# GET YOUR OWN STREET CRED: AN ARGUMENT FOR TRADEMARK PROTECTION FOR STREET ART

**Abstract:** Street art is visual art created in public spaces, many times at the behest of the communities in which the work is created. It is a derivative of graffiti, which is the illicit marking of public locations, usually on buildings or train cars. Retailers' appropriation of street art and graffiti is becoming commonplace, causing confusion in the market. As a result, street artists have filed an increasing number of copyright and trademark infringement lawsuits to protect their intellectual property rights. There is a debate regarding whether these artists are entitled to trademark protection given the expressive nature of their marks. Courts are reluctant to grant trademark protection since expressive works are traditionally protected under copyright law. Most street artists, as opposed to creators of "fine art," however, use marks in a trademark manner to build reputations and identify the source of their works. This Note argues that courts should broadly interpret the Lanham Act's "use in commerce" requirement to validate marks used by street artists. Street art substantially affects commerce and therefore should be covered by the Commerce Clause. A broad interpretation furthers Congress's intent under trademark law to prevent consumer confusion. In the alternative, this Note contemplates treatment of street artists under the eleemosynary standard reiterated by the Eleventh Circuit Court of Appeals in 2001 in *Planetary Motion Inc. v. Techsplosion, Inc.*, and considers the possibility of adding a famous mark exception to the use in commerce requirement.

## INTRODUCTION

Graffiti has undergone a revolution in the past decade.<sup>1</sup> It is no longer representative of drugs, gangs, and other illegal activities.<sup>2</sup> A distinction has been

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<sup>1</sup> See Brittany M. Elias & Bobby Ghajar, *Street Art: The Everlasting Divide Between Graffiti Art and Intellectual Property Protection*, 7 LANDSLIDE 48, 48 (2015) (discussing the evolution of graffiti from vandalism to a sought-after commodity); Lindsey Bartlett, *Ten Ways to Tell the Difference Between Street Art and Graffiti*, WESTWORD (AUG. 13, 2015, 6:44 AM), <http://www.westword.com/arts/ten-ways-to-tell-the-difference-between-street-art-and-graffiti-6961170> [<https://perma.cc/K563-APG9>] ("Street art is the evolution of graffiti . . . ." (quoting artist Anthony Garcia Sr.)); Deborah Vankin & David Ng, *How Shepard Fairey's Arrest Provides a New Look at an Old Question: Is It Art or Is It Vandalism?*, L.A. TIMES (July 14, 2015, 3:30 AM), <http://www.latimes.com/entertainment/arts/la-et-cm-shepard-fairey-street-art-20150714-story.html> [<https://perma.cc/DUV7-G6TW>] (discussing the changes in perception and commercialization of graffiti).

<sup>2</sup> See Elias, *supra* note 1 (discussing how graffiti has moved away from its association with vandalism). Graffiti has progressed to a point at which many believe it represents an entirely new movement. Danwill Schwender, *Promotion of the Arts: An Argument for Limited Copyright Protection of*

drawn between graffiti writers, who participate in illegal activity, and street artists, who produce legal works.<sup>3</sup> Street art has not only become accepted by mainstream culture, but has also proven itself to be commercially valuable.<sup>4</sup> A retailer's collaboration with street artists can boost the retailer's "street cred" and expand their market base.<sup>5</sup> Additionally, street art has become an asset to many communities.<sup>6</sup> Many street artists are participating in projects aimed at developing economically depressed communities by bringing messages of hope.<sup>7</sup>

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*Illegal Graffiti*, 55 J. COPYRIGHT SOC'Y U.S.A. 257, 262 (2008). So-called vandals still exist, but the majority of street artists have transcended this reputation. See Eric Felisbret, *Legal Venues Celebrate Graffiti as an Art Form*, N.Y. TIMES (July 16, 2014, 5:50 PM), <http://www.nytimes.com/roomfordebate/2014/07/11/when-does-graffiti-become-art/legal-venues-celebrate-graffiti-as-an-art-form> [https://perma.cc/J7VE-CSEB] (discussing the emergence of legal outlets for graffiti and the negative and positive aspects of such legal walls); *Here Comes the Neighborhood Episode 6: Irak*, VIMEO (Dec. 4, 2011, 11:53 PM), <https://vimeo.com/33137486> [https://perma.cc/BB6V-4ABB] (featuring Earsnot and Nemel, two graffiti writers who participated in the Wynwood Walls project but who also tag illegally); Lady Pink, *Graffiti Is Young, Cool, Creative—Let It Happen*, N.Y. TIMES (July 11, 2014, 6:15 PM), <http://www.nytimes.com/roomfordebate/2014/07/11/when-does-graffiti-become-art/graffiti-is-young-cool-creative-let-it-happen> [https://perma.cc/YD3-4BBW] (discussing how Lady Pink, a prolific graffiti artist in the 1980s, moved towards commission-based and other legal work). There are artists still associated with vandalism, crime, and drugs, such as members of the Irak crew, who *Vice Magazine* called "the most reckless drug users in America." See Bruce LaBruce, *The VICE Guide to New York Graffiti*, VICE (Nov. 30, 2001), <https://www.vice.com/read/graf-v8n3> [https://perma.cc/DZ38-GFN7] (chronicling a reporter's time interacting with the Irak crew). "Irak" refers to "Irak," or "I shoplift." LaBruce, *supra*.

<sup>3</sup> See Bartlett, *supra* note 1 (explaining the differences between street art and graffiti). The biggest difference between street art and graffiti is that street art is sanctioned. *Id.* Whereas "street art" colloquially can include graffiti, the term is usually used to denote public artwork that is devoid of vandalism and gang affiliation. Indigo Ion, *Street Art*, URBAN DICTIONARY (Sept. 1, 2006), <http://www.urbandictionary.com/define.php?term=street%20art> [https://perma.cc/67X7-HLWG].

<sup>4</sup> See Elias, *supra* note 1 (discussing the value of graffiti and how retailers are copying and re-printing graffiti onto merchandise).

<sup>5</sup> See In Chambers Order Denying Motions to Dismiss and Denying Motions to Strike at 2, 7–8, *Tierney v. Moschino et al.*, No. 2:15-cv-05900 (C.D. Cal. Jan. 13, 2016), ECF No. 49 (holding that a street artist used his tag, "Rime," in commerce and therefore was free to bring a § 43(a) claim against the fashion brand who was using "Rime" without permission and damaging his street cred); Al Roundtree, *Graffiti Artists "Get Up" in Intellectual Property's Negative Space*, 31 CARDOZO ARTS & ENT. L.J. 959, 965 (2013) (discussing how the value of illegal street art is increasing as a result of its mainstream success); Schwender, *supra* note 2, at 263 (discussing the increasing value of graffiti, both economically and culturally). "Street cred" means "the acceptance and respect of people who live in poor city neighborhoods." MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/street%20cred> [https://perma.cc/LN35-FBDT].

<sup>6</sup> See *Here Comes the Neighborhood Episode 1: Introducing the Walls*, VIMEO (Nov. 20, 2011, 8:43 PM), <https://vimeo.com/32424117> [https://perma.cc/9XHM-ANWE] (documenting the creation and evolution of the Wynwood Walls, one of many legal graffiti outlets developed in the United States in depressed neighborhoods in an effort to revitalize and beautify a neighborhood); *Here Comes the Neighborhood Episode 8: Gentlification*, VIMEO (Feb. 4, 2012, 8:55 PM), <https://vimeo.com/36213345> [https://perma.cc/YHV8-73YE] (stating that the art is done for the streets and for the neighborhood).

<sup>7</sup> See *Here Comes the Neighborhood Episode 8*, *supra* note 6 (discussing the Wynwood Walls project).

In spite of this revolution, street art has not lost its fundamental ties to graffiti.<sup>8</sup> Street art is rooted in the culture of tagging, in which a writer's status within the tagging community depends on the repetition of their tag on public walls.<sup>9</sup> This historical connection to artist branding makes street art uniquely situated for trademark protection, but its connection to non-commercialization creates challenges for street artists claiming trademark rights.<sup>10</sup> Street artists have embraced the graffiti writers' core value of free public art, but in order to bring a trademark claim under § 43(a) of the Lanham Act, a mark must be used in or substantially affect interstate commerce.<sup>11</sup> Many street artists veer away from commercialization and avoid the confines of galleries and museums.<sup>12</sup> In addition, street art's new ties to the art world bring its own problems when claiming trademark protection.<sup>13</sup>

This Note discusses the importance of granting trademark protection to street artists and addresses the many challenges a street artist faces when seeking trademark protection through a § 43(a) infringement claim.<sup>14</sup> It argues for an interpretation of trademark law that protects consumers from market confusion and protects artists from the misuse of their marks.<sup>15</sup> Part I provides a brief history of graffiti and expands on its progression into the art form it is today.<sup>16</sup> It

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<sup>8</sup> See PATRICK VEREL, *GRAFFITI MURALS: EXPLORING THE IMPACTS OF STREET ART* 28–29 (2015) (explaining that legal murals found in New York today are rooted in subway graffiti); Bartlett, *supra* note 1 (discussing the connection between graffiti and street art); *Graffiti Q & A, ART CRIMES* (1994), [http://www.graffiti.org/faq/graffiti\\_questions.html](http://www.graffiti.org/faq/graffiti_questions.html) [<https://perma.cc/HB5R-TPMB>] [hereinafter *Graffiti Q & A*] (stating that modern street art is still rooted in graffiti writing).

<sup>9</sup> See VEREL, *supra* note 8, at 25–26 (comparing tags and murals to musical notes and songs); Roundtree, *supra* note 5, at 963–64 (discussing how unique artistic style replaced pseudonyms and tags as the method graffiti artists use to distinguish their work on the streets).

<sup>10</sup> See *Craigslist Inc. v. 3Taps Inc.*, 942 F. Supp. 2d 962, 979–80 (N.D. Cal. 2013) (finding that copyright and trademark violations can exist simultaneously when use of a mark causes customer confusion and diminishes the mark's value); *supra* notes 8–9 and accompanying text (explaining the historical connection between street art and graffiti); *infra* notes 111–125, 140–148 and accompanying text (discussing the treatment of trademark claims in other visual art forms and the uniqueness of street art as compared to other fine art forms).

<sup>11</sup> See Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1) (2012) (stating that mark must be used in commerce); MARY LAFRANCE, *UNDERSTANDING TRADEMARK LAW* 36 (2d ed. 2009) (expanding on the meaning of “used in commerce”); VEREL, *supra* note 8, at 28 (discussing the importance of street art remaining public on the street).

<sup>12</sup> See Felisbret, *supra* note 2 (explaining the limitations and downfalls of working in connection with legal venues). Artist Eric Felisbret, writing for the *New York Times*, points out the fact that it is hard for a graffiti writer to achieve fame and respect based on artistic ability alone. *Id.* Respect is grounded in the concept of risk and illegality and working under pressure. *Id.* He also discusses how many legal venues do not provide artists with complete creative freedom. *Id.* Many writers continue to produce illegal works for these reasons. See *id.* (discussing how legal venues do not provide perfect substitutes for illegal graffiti).

<sup>13</sup> See *infra* notes 111–125 and accompanying text.

<sup>14</sup> See *infra* notes 21–205 and accompanying text.

<sup>15</sup> See *infra* notes 21–205 and accompanying text.

<sup>16</sup> See *infra* notes 21–59 and accompanying text. For the purposes of this Note, the term graffiti will be used in reference to illegal activity and street art in reference to legal activity. See Bartlett,

also provides background on § 43(a) of the Lanham Act.<sup>17</sup> Part II discusses the challenges facing street artists in § 43(a) unfair competition claims and expands on the relationship between trademark law and street art.<sup>18</sup> Part III proposes three alternatives that could be adopted to provide street artists with protection against potential trademark infringement: (1) the “use in commerce” requirement under § 43(a) of the Lanham Act could be interpreted broadly in order to allow street artists the opportunity to bring trademark infringement claims against infringing retailers, (2) courts could classify street art as a charitable activity that would make it eligible for protection, or (3) Congress could supplement the use in commerce requirement with a fame requirement.<sup>19</sup> It also argues that the courts should distinguish street art from other fine arts.<sup>20</sup>

## I. BACKGROUND

The graffiti culture has evolved since its inception.<sup>21</sup> Over the years, it has been associated with a wide spectrum of positive and negative imagery: drugs, crime, youth, beauty, innovation, politics, gangs, gentrification, music, and violence.<sup>22</sup> Street art is increasingly departing from negative associations and it is becoming an accepted form of art.<sup>23</sup> This Part explores the evolution of street art and provides background on § 43(a) of the Lanham Act.<sup>24</sup> Section A will provide a brief history of street art, beginning with its graffiti roots.<sup>25</sup> Section B will explore what the street art genre looks like today.<sup>26</sup> Section C explains the requirements for a trademark infringement claim under § 43(a) of

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*supra* note 1 (stating the biggest difference between graffiti and street art is that one is legal but the other is not). This is consistent with common usage within the art community. *See id.* (discussing the differences between street art and graffiti).

<sup>17</sup> *See infra* notes 60–81 and accompanying text.

<sup>18</sup> *See infra* notes 82–125 and accompanying text. “Fine arts” for the purpose of this Note means visual artwork other than street art and graffiti.

<sup>19</sup> *See infra* notes 126–134, 152–205 and accompanying text.

<sup>20</sup> *See infra* notes 135–148 and accompanying text.

<sup>21</sup> *See* Elias, *supra* note 1 (discussing the rapid growth of graffiti art); Bartlett, *supra* note 1 (“Street art is the evolution of graffiti . . .” (quoting artist Anthony Garcia Sr.)); Vankin, *supra* note 1 (discussing the changes in perception, public policy, and commercialization).

<sup>22</sup> *See* VEREL, *supra* note 8, at 25 (discussing how the public’s perception is that graffiti is to blame for an urban area’s decay); Schwender, *supra* note 2, at 263 (discussing the association graffiti has with vandalism, crime, and gangs); Lady Pink, *supra* note 2 (discussing the negative reputation of graffiti in New York City).

<sup>23</sup> *See* Lady Pink, *supra* note 2 (discussing how museums have begun to recognize graffiti for its artistic value and commenting on the possibility of graffiti artists being able to make a living off their work in the future).

<sup>24</sup> *See infra* notes 29–81 and accompanying text.

<sup>25</sup> *See infra* notes 29–46 and accompanying text.

<sup>26</sup> *See infra* notes 47–59 and accompanying text.

the Lanham Act.<sup>27</sup> Section D breaks down the “use in commerce” requirement of § 43(a).<sup>28</sup>

### A. Graffiti to Street Art: A Brief Historical Overview

Graffiti is a unique art form with its own rules.<sup>29</sup> Philadelphia teenagers in the late 1960s may have been responsible for the birth of graffiti.<sup>30</sup> In its early years, graffiti was synonymous with “bombing,” or writing a tag throughout an area.<sup>31</sup> Writers were looking for an outlet to express themselves and be heard.<sup>32</sup> They were motivated by their love of painting and achieving the respect of their peers—not monetary rewards.<sup>33</sup> The public viewed these early graffiti writers as vandals and few people dared to show any affiliation with or endorsement of these artists.<sup>34</sup>

<sup>27</sup> See *infra* notes 60–66 and accompanying text.

<sup>28</sup> See *infra* notes 67–81 and accompanying text.

<sup>29</sup> See Jim Dwyer, *From Vandals to Artists: Time Rouses More Appreciation for Graffiti*, N.Y. TIMES (May 13, 2014), <http://www.nytimes.com/2014/05/14/nyregion/from-vandals-to-artists-time-rouses-more-appreciation-for-graffiti.html> [https://perma.cc/4MX2-94YF] (explaining how early graffiti artists invented the art form without any reliance on artistic history).

<sup>30</sup> *History Part One*, @149ST, <http://www.at149st.com/hpart1.html> [https://perma.cc/NQ6Q-B7RY]. It is worth noting that any account of the history of graffiti is colored by the person telling it, depending on his or her location and place in the movement. *History*, @149ST, <http://www.at149st.com/history.html> [https://perma.cc/VH7Y-PF24]. Given that graffiti is an underground movement, there is a reliance on imperfect oral history. *Id.*

<sup>31</sup> *History Part One*, *supra* note 30; *The Words: A Graffiti Glossary*, ART CRIMES, <http://www.graffiti.org/faq/graffiti.glossary.html> [https://perma.cc/YH9T-PDTR].

<sup>32</sup> See Dwyer, *supra* note 29 (quoting the successful graffiti writer, Lee Quiñones, who began painting in 1974 on trains); Lady Pink, *supra* note 2 (stating that young graffiti artists started writing because of a need to be heard). Mr. Quiñones said:

[I]t was wrong for society to forget about a lot of young people. The Bronx was burning, the president had said the city should drop dead. Out of necessity we invented an art form. It came from very young people that didn't necessarily have any art history to stand on. They were creating art history without a script in their hand.

Dwyer, *supra* note 29. Young people were looking for a voice and found that voice through the expression of graffiti. *Id.* Graffiti was grounded in that need to be heard, not in a desire to build on the tradition of artists before them. *Id.*

<sup>33</sup> See Roundtree, *supra* note 5, at 963 (stating the core values of graffiti writers are “[reputation with other writers], artistic expression, power, and rebellion”); Dwyer, *supra* note 29 (“I had maybe 14 cents to my 14 years of age.” (quoting Lee Quiñones)).

<sup>34</sup> See Dwyer, *supra* note 29 (discussing the risk surrounding an association with graffiti writers and artists in the early years). This is in sharp contrast to the fame and acclaim street artists receive today. See *infra* note 47 and accompanying text (discussing the popularity of street art today); *infra* notes 132–133 and accompanying text (discussing examples of street art's presence in mainstream culture). The goal for most graffiti writers was to “get up,” or place as many tags anywhere and everywhere to gain the respect of their community. *History Part One*, *supra* note 30; see Schwender, *supra* note 2, at 261 (explaining how “getting up” is the point of writing and how tags act as brands for artists). Tags are the stylized, personal signatures of a graffiti writer. Schwender, *supra* note 2, at 260–61; see also *The Words: A Graffiti Glossary*, *supra* note 31 (defining tag). Tagging dates back to World War II; however, TAKI 183 was considered the first graffiti writer to gain notoriety through his

As the graffiti movement in Philadelphia grew, graffiti artists in New York were starting to use the subway system as a means to grow their reputation outside their immediate communities.<sup>35</sup> Subways connected the city and thus allowed writers to achieve citywide recognition.<sup>36</sup> Through motion tagging, tags began reaching a level of fame that extended beyond the writer's community as the public began to take notice of unique pseudonyms.<sup>37</sup> These writers were building a brand.<sup>38</sup>

As competition between writers increased, graffiti writers searched for ways to distinguish themselves.<sup>39</sup> This led to the development of calligraphic styles and tag enhancements.<sup>40</sup> Writers began experimenting with size and thickness of letters by using different spray can nozzles.<sup>41</sup> They departed from pure tagging to "throw ups" and eventually more artistic "pieces" and "murals."<sup>42</sup>

tagging. Schwender, *supra* note 2, at 261; 'Taki 183' Spawns Pen Pals, N.Y. TIMES (July 21, 1971), <http://www.nytimes.com/1971/07/21/archives/taki-183-spawns-pen-pals.html> [<https://perma.cc/J3Z9-LDJ4>]. In the 1970s, the artist placed his tag all across New York City, inspiring others to do the same. 'Taki 183' Spawns Pen Pals, *supra*. "Getting up" became the central purpose of graffiti and the main way to achieve fame. Schwender, *supra* note 2, at 261. The more prolific and risky, the more respect a writer garnered in the community. VEREL, *supra* note 8, at 25.

<sup>35</sup> *History Part One*, *supra* note 30. The practice of tagging active subway cars is called "motion tagging." *Writer's Vocabulary*, @149ST, <http://www.at149st.com/glossary.html> [<https://perma.cc/XR5G-UEC6>].

<sup>36</sup> See *History Part One*, *supra* note 30 (discussing the role of the NYC subway system in graffiti's history).

<sup>37</sup> *Id.* At age seventeen, TAKI 183 from New York became one of the first writers to gain recognition outside the graffiti community and attract public curiosity through his motion tagging. *Id.* *The New York Times* even took notice and wrote an article featuring TAKI 183. See 'Taki 183' Spawns Pen Pals, *supra* note 34; *History Part One*, *supra* note 30.

<sup>38</sup> Schwender, *supra* note 2, at 260–61 (stating that tags acted like brands for graffiti writers); *Graffiti Q & A*, *supra* note 8 (comparing graffiti and advertising); *History Part One*, *supra* note 30 (explaining that graffiti writers attempted to distinguish themselves by creating unique tags).

<sup>39</sup> Roundtree, *supra* note 5, at 963–64 (discussing how graffiti writers and street artists developed unique pseudonyms and artistic styles to distinguish themselves); *History Part One*, *supra* note 30.

<sup>40</sup> *History Part One*, *supra* note 30. These enhancements were sometimes purely ornamental, whereas others held meaning in the community. *Id.* For example, a crown meant you considered yourself a graffiti king. *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> Schwender, *supra* note 2, at 261–62. "Throw up" is defined differently depending on who is asked. *The Words: A Graffiti Glossary*, *supra* note 31. They are either quickly done bubble-lettered versions of the writer's name or simple works not using more than two colors. Schwender, *supra* note 2, at 261; *The Words: A Graffiti Glossary*, *supra* note 31. "Pieces" are larger, more artistic paintings usually incorporating at least three colors. Schwender, *supra* note 2, at 261; *The Words: A Graffiti Glossary*, *supra* note 31. "Murals" are larger scaled pieces that tend to cover the entirety of a wall. *The Words: A Graffiti Glossary*, *supra* note 31. They involve a large production with usually more than one piece and involvement of characters or cartoon figures. *Id.* Creating an illegal mural is a complex, risky process as it usually requires returning to a site multiple nights to complete. See VEREL, *supra* note 8, at 25 (explaining how more time is needed to complete murals which exposes writers to the increased risk of getting caught).

These pieces and murals frequently incorporated elements of the writer's signature style or a stylized signature.<sup>43</sup>

In the 1980s, graffiti writers were gaining domestic and international fame with the release of books such as Henry Chalfant and Martha Cooper's *Subway Art*, magazines like *International Graffiti Times*, and films such as *Style Wars*.<sup>44</sup> In more recent years, the Internet has embraced graffiti and provided an even greater opportunity for fame.<sup>45</sup> There are currently hundreds of websites and countless social media accounts devoted to the documentation and communication of graffiti and street art.<sup>46</sup>

### B. Street Art Today: Legitimate Graffiti

Street art has recently piqued the public's interest.<sup>47</sup> This has made it easier for artists to find legal outlets to create and sell street art.<sup>48</sup> Many companies are calling on street artists to assist in creating capsule collections.<sup>49</sup> Mu-

<sup>43</sup> See Celia Lerman, *Protecting Artistic Vandalism: Graffiti and Copyright Law*, 2 NYU J. INTEL. PROP. & ENT. L. 295, 305 (2013) (recognizing that artists can be identified by their characteristic style); *Collecting Guide: 5 Things to Know About Street Art*, CHRISTIE'S (Feb. 15, 2016), [http://www.christies.com/features/Street-Art-Collecting-Guide-7074-1.aspx?sc\\_lang=en&cid=EM\\_EML\\_content0414434B\\_0](http://www.christies.com/features/Street-Art-Collecting-Guide-7074-1.aspx?sc_lang=en&cid=EM_EML_content0414434B_0) [<https://perma.cc/46VT-DXYM>] [hereinafter *Christie's Collecting Guide*] (explaining that graffiti artists revisit themes or repeat imagery to create recognizable trademarks). Some examples include Keith Haring's iconic man figures and KAWS's use of "x"s in the eyes of characters. *Christie's Collecting Guide*, *supra*.

<sup>44</sup> *History Part Two*, @149ST, <http://www.at149st.com/hpart2.html> [<https://perma.cc/V5SM-WUJJ>]. Many writers contributed to these magazines and produced or contributed to documentary films on the movement. *Id.*

<sup>45</sup> *Id.* In 1994, *Art Crimes*, the first credited website devoted to documenting and communicating graffiti to a large network, was created. *Id.*

<sup>46</sup> *Id.* (comparing the Internet to the subway system in the early years of graffiti); see, e.g., invaderwashere, INSTAGRAM, <https://www.instagram.com/invaderwashere/> [<https://perma.cc/83BV-V2M6>] (the Instagram account for Invader); SPACE INVADER, <http://www.space-invaders.com/> [<https://perma.cc/WBG8-LQ49>] (the official website of Invader).

<sup>47</sup> See *Christie's Collecting Guide*, *supra* note 43 (discussing the increasing popularity of street art). Popularity in the genre has boomed since the 2008 presidential campaign, which featured Shepard Fairey's "Hope" poster in 2008, and the trailblazing show at the Museum of Contemporary Art in Los Angeles in 2011 that documented the history of graffiti and street art. *Id.* Works by Haring, KAWS, and Invader are being priced at auction anywhere between \$6,000 and \$300,000. *Id.*

<sup>48</sup> See Roundtree, *supra* note 5, at 964 (discussing how municipalities have adopted a more permissive approach to graffiti, establishing free walls for artists to paint).

<sup>49</sup> See Schwender, *supra* note 2, at 263 (pointing out some graffiti artists attain commercial success). For example, the clothing retailer Uniqlo announced a spring 2016 collaboration with the street artist Kaws; Happy Socks has a 2016 collaboration with street artist André, for socks and underwear, which will feature his signature artwork; Hennessy has worked with numerous graffiti artists, including Kaws and Futura, on special edition bottles; street artist Tristan Eaton has collaborated with Beats by Dre and Reebok, among others; and Louis Vuitton has a history of collaboration with street artists for its artist scarves. See Tristan Eaton, *Introducing the Artist Series: Tristan Eaton*, BEATS BY DRE (Oct. 9, 2012), [http://au.beatsbydre.com/on/demandware.store/Sites-beats-AU-Site/en\\_AU/NewsAndPressRelease>ShowArticleContent?articleID=NewsAndEvents\\_art\\_Tristan&fdid=news-press-release](http://au.beatsbydre.com/on/demandware.store/Sites-beats-AU-Site/en_AU/NewsAndPressRelease>ShowArticleContent?articleID=NewsAndEvents_art_Tristan&fdid=news-press-release) [<https://perma.cc/RG8F-6E2U>] (discussing Tristan Eaton's collaboration with Beats by Dre); Jonathan Luk, *Happy*

seums and galleries are opening up their doors to street artists.<sup>50</sup> In this regard, graffiti has grown from the quick, illegal practice of tagging to the production of large, time-consuming, legal murals.<sup>51</sup> The form has progressed so far that many regard street art as an entirely new movement.<sup>52</sup>

Even today, however, many street artists shy away from commercialization.<sup>53</sup> Some street artists embrace it and produce nothing but legal, commercialized works.<sup>54</sup> They license their works, collaborate with companies on merchandise and advertising campaigns, sell merchandise through their web-

*Socks Links with Graffiti Artist André for Sock & Underwear Collaboration*, HIGHSNOBIETY (Jan. 29, 2016), <http://www.highsnobiety.com/2016/01/29/happy-socks-andre-collaboration/> [https://perma.cc/4S3E-6Q8P] (discussing Happy Socks and André collaboration); Asja Nastasijevic, *10 Street Art Fashion Collaborations*, WIDEWALLS, <http://www.widewalls.ch/10-fashion-collaborations/louis-vuitton-artist-scarves/> [https://perma.cc/QQ4A-X82W] (discussing Louis Vuitton collaboration); *Reebok Collaborates with Renowned Street Artist, Tristan Eaton to Create Street Inspired Yoga Apparel*, REEBOK (July 26, 2016), <http://news.reebok.com/global/latest-news/reebok-collaborates-with-renowned-street-artist-tristan-eaton-to-create-street-inspired-yoga-appare/s/7ebfa81f-7038-4726-9594-3e34a4483faa> [https://perma.cc/PDA2-M2YS] (discussing Tristan Eaton's collaboration with Reebok); Anna Sanina, *Hennessy Unveils Results of Its Collaboration with Graffiti Artist Futura*, POPSOP (Aug. 9, 2012), <http://popsop.com/2012/08/hennessy-unveils-results-of-its-collaboration-with-artist-futura/> [https://perma.cc/S4M9-MMPA] (discussing Hennessy collaboration); Jonathan Sawyer, *Uniqlo Is Relaunching Its KAWS Collection This Weekend*, HIGHSNOBIETY (May 17, 2016), <http://www.highsnobiety.com/2016/03/30/uniqlo-kaw-collection-ss16/> [https://perma.cc/383A-UJELN] (discussing the collaborative collection created by Uniqlo and KAWS).

<sup>50</sup> Schwender, *supra* note 2, at 263. For example, Kaws completed a show at The Brooklyn Museum in 2016 and the Museum of the City of New York had an exhibit devoted to graffiti in 2014. See Gabriella Karefa-Johnson, *Street Art Hits the Museum in New Graffiti Exhibit at the Museum of the City of New York*, VOGUE.COM (Feb. 4, 2014), <http://www.vogue.com/872672/street-art-hits-the-museum-in-new-graffiti-exhibit-at-the-museum-of-the-city-of-new-york/> [https://perma.cc/6NX4-DPCJ] (discussing the exhibit at Museum of the City of New York); *Kaws: 'Along the Way'*, BROOKLYN MUSEUM, [https://www.brooklynmuseum.org/exhibitions/kaws\\_along\\_the\\_way](https://www.brooklynmuseum.org/exhibitions/kaws_along_the_way) [https://perma.cc/2BR9-ZN3K] (discussing the exhibit featuring Kaws).

<sup>51</sup> See Schwender, *supra* note 2, at 262 (explaining that muralists have distinguished themselves from gang-related tagging); *Graffiti Q & A*, *supra* note 8 (featuring graffiti writers talking about writers' use of legal yards). Most writers in this movement are respected based on their artistic merits, not the level of risk associated with getting a piece or mural up. See Lerman, *supra* note 43, at 298 (explaining how street art is an artistic work with which the public can connect); Roundtree, *supra* note 5, at 963–64 (discussing how graffiti has evolved and is judged based on artistic merit).

<sup>52</sup> Schwender, *supra* note 2, at 262; see *Graffiti Q & A*, *supra* note 8 (publishing a Q&A with graffiti writers answering questions about graffiti). Schmoor, one graffiti writer, stated he does not believe legal murals are graffiti, whereas another said that if the writer thinks it is graffiti, then it is. *Graffiti Q & A*, *supra* note 8.

<sup>53</sup> See Roundtree, *supra* note 5, at 965–66 (discussing how commercialization runs counter to graffiti's core value of rebellion). Some artists view commercialization as “selling out” and many wonder if commercialization is damaging graffiti's street cred. Vankin, *supra* note 1; see In Chambers Order, *supra* note 5, at 2 (claiming the unauthorized commercial use of his trademark was damaging his street cred); Roundtree, *supra* note 5, at 965–66 (discussing how graffiti writers separate themselves from pop culture).

<sup>54</sup> See Schwender, *supra* note 2, at 262 (discussing the trend towards legal works); Vankin, *supra* note 1 (discussing graffiti's commercialization).

sites, and sell small prints or works on canvas.<sup>55</sup> Still other graffiti writers produce only illegal, non-commercialized works.<sup>56</sup> There are also artists who fall into a middle ground by not confining themselves to illegal or legal works or by working only on non-commercialized projects, whether legal or illegal.<sup>57</sup> Street artists can create legal works without commercialization by painting on “free walls,” or “legal walls.”<sup>58</sup> Building owners and communities have donated legal walls for writers to create murals.<sup>59</sup>

### C. Trademark Infringement Actions Under § 43(a) of the Lanham Act

Unregistered trademarks and service marks are eligible for protection against infringement under § 43(a) of the Lanham Act.<sup>60</sup> In order to qualify for

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<sup>55</sup> See Schwender, *supra* note 2, at 262 (discussing the fact that many artists produce legal works); Vankin, *supra* note 1 (discussing graffiti’s commercialization).

<sup>56</sup> See *Graffiti Q & A*, *supra* note 8 (discussing how “hard core” graffiti artists are against any legalization of their work, especially when it leads to commercialization).

<sup>57</sup> See Roundtree, *supra* note 5, at 965 (providing examples of such artists as Banksy and Shepard Fairey); Vankin, *supra* note 1 (discussing how many artists, including Shepard Fairey, oscillate between legal and illegal).

<sup>58</sup> See Roundtree, *supra* note 5, at 964 (describing the creation of “free walls,” which are either officially created through permission or unofficially accepted through non-enforcement); Schwender, *supra* note 2, at 262 (discussing how murals were mostly created on abandoned property or on walls donated by property owners with the community’s support and how artists attempted to capture the experience of the community in their works); *Graffiti Q & A*, *supra* note 8 (featuring graffiti writers discussing “legal walls”). These walls provide opportunities for writers to take the time to develop larger and more detailed works during daylight hours without the pressure of being discovered and arrested. *Graffiti Q & A*, *supra* note 8.

<sup>59</sup> See VEREL, *supra* note 8, at 32–35 (providing a case example of how street artists approach building owners for permission to paint murals on the building’s walls); Roundtree, *supra* note 5, at 964 (noting that not all graffiti is illegal and describing the creation of “free walls”); Schwender, *supra* note 2, at 262 (describing how the community supported many muralists and building owners allowed artists to use their walls). Many organizations and projects have developed in an effort to beautify and revitalize neighborhoods. See, e.g., *Houston Bowery Wall*, GOLDMAN PROPERTIES, <http://www.goldmanproperties.com/Art-and-Culture/Houston-Street-Wall.asp> [https://perma.cc/4DDJ-ZGSE]; *Mission*, THE L.I.S.A. PROJECT, <http://www.lisaprojectnyc.org/#!/mission/c21p> [https://perma.cc/BJ49-F4NY]; *About Wynwood Walls*, WYNWOOD WALLS, <http://www.thewynwoodwalls.com/overview> [https://perma.cc/7N5C-DV9E]. There are also festivals that focus on bringing artists to communities to create murals. *About Pow! Wow!*, POW! WOW! (Mar. 9, 2016), <http://powwowhawaii.com/about-pow-wow-hawaii/> [https://perma.cc/84G6-H2NF].

<sup>60</sup> Lanham Act § 43(a); LAFRANCE, *supra* note 11, at 6–7. Irrespective of a street artist or graffiti writer’s means of expression, they are not likely to register a trademark. See *Complaint for Damages and Injunctive Relief for Copyright Infringement, Violation of the Lanham Act, Violation of the Right of Publicity, Unfair Competition, and Negligence* at 11–14, *Tierney v. Moschino et al.*, No. 2:15-cv-05900 (C.D. Cal. Aug. 5, 2015), ECF No. 1 (stating the cause of action is an unfair competition claim under Section 43(a) of the Lanham Act); *First Amended Complaint for Damages and Injunctive Relief for Copyright Infringement, Violation of the Lanham Act, Unfair Competition, and Negligence* at 13–15, *Williams v. Cavalli*, No. 2:14-cv-06659 (C.D. Cal. Nov. 10, 2014), ECF No. 43 (same). A trademark is a word, name, symbol, or device, or any combination thereof, which is used to identify and distinguish one person’s goods from another. Lanham Act § 45, 15 U.S.C. § 1127 (2012). A service mark is a word, name, symbol, or device, or any combination thereof, which is used to identify and

protection, an unregistered mark must be valid under common law.<sup>61</sup> Common law requires that the mark either be “inherently distinctive” or have “acquired secondary meaning.”<sup>62</sup> In addition, the mark must have been used in commerce in connection with the offering of goods or services.<sup>63</sup>

In order to prove infringement under § 43(a) of the Lanham Act, a plaintiff must successfully argue that the defendant used the mark in commerce; in connection with a good or service; and in a manner that was likely to confuse, mistake, or deceive the public “as to the affiliation, connection, or association” of the defendant with the plaintiff or “as to the origin, sponsorship, or approval of [the defendant’s] goods, services, or commercial activities . . . .”<sup>64</sup> In other words, the defendant must have used the infringing mark in connection with interstate commerce in a manner that was likely to cause confusion.<sup>65</sup> These claims are typically called “false designation of origin” claims and include reverse passing off, passing off, and false sponsorship or endorsement.<sup>66</sup>

#### *D. Breaking Down the Use in Commerce Requirement for a Valid Common Law Trademark Under § 43(a) of the Lanham Act*

A plaintiff must have a valid trademark to pursue an infringement claim under § 43(a) of the Lanham Act, which means, in part, that they must have used

distinguish the services of an individual or company. *Id.* Both marks serve as source identifiers. *Id.* Registered marks are marks registered with the United States Patent and Trademark Office. Lanham Act § 1, 15 U.S.C. § 1051(a)(1). Registered marks have the advantage of being presumed to be both valid and constructively used in commerce. LAFRANCE, *supra* note 11, at 76–77. Unregistered marks are constrained to those remedies available under § 43(a) of the Lanham Act. *Id.* at 7. Section 2 of the Lanham Act provides the rules for registering a trademark, § 32 protects against infringement of registered marks, and § 43(a) protects trademarks against unfair competition. *Id.*

<sup>61</sup> LAFRANCE, *supra* note 11, at 134.

<sup>62</sup> *Id.* at 136. Generic words or marks are not protected under trademark law. JANE C. GINSBURG, JESSICA LITMAN & MARY KEVLIN, TRADEMARK AND UNFAIR COMPETITION LAW: CASES AND MATERIALS 279 (5th ed. 2013). Distinctive, fanciful, and arbitrary marks acquire protection immediately upon use in commerce. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 18 (AM. LAW INST. 2015). Marks that are not inherently distinctive must establish secondary meaning before qualifying for protection. *Id.*

<sup>63</sup> LAFRANCE, *supra* note 11, at 36, 136. The Commerce Clause of the U.S. Constitution limits the Lanham Act’s power. 3 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 11.03(e)(i) (2015) [hereinafter GILSON ON TRADEMARKS]; see U.S. CONST. art. I, § 8, cl. 3 (limiting the definition of commerce to trade or business “with foreign nations, and among the several States, and with the Indian Tribes”).

<sup>64</sup> Lanham Act § 43(a).

<sup>65</sup> *Id.*

<sup>66</sup> GILSON ON TRADEMARKS, *supra* note 63, § 7. Passing off is when a defendant tries to pass off its own product as originating from another source. *Id.* Reverse passing off is when a defendant holds out another’s goods or services as his own. LAFRANCE, *supra* note 11, at 192. False sponsorship or endorsement is when a defendant falsely leads a consumer to believe another party has approved a product or service, or that another party has worked in affiliation with the defendant on the product or service. GILSON ON TRADEMARKS, *supra* note 63, § 7.

the mark in commerce.<sup>67</sup> “Use in commerce” is a term of art defined by § 45 of the Lanham Act as “the *bona fide use* of a mark in the *ordinary course of trade*.”<sup>68</sup> This Section will explore the subtleties of this requirement in more detail by breaking down the definitions of “commerce,” “use,” and “ordinary course of trade.”<sup>69</sup>

“Commerce” under the Lanham Act refers to the activities that can be regulated under the Commerce Clause.<sup>70</sup> Congress intended the Lanham Act to extend to the outer limits of congressional authority under the Commerce Clause.<sup>71</sup> “Use” is not strictly reserved to sales, but instead, use is established through the sale or transportation of goods or services.<sup>72</sup> Not all transportation,

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<sup>67</sup> See Lanham Act § 43(a) (stating the requirements for an unfair competition claim); LAFRANCE, *supra* note 11, at 134 (indicating that a mark must qualify as a valid mark under common law before bringing an infringement claim).

<sup>68</sup> Lanham Act § 45 (emphasis added). The court’s standard of review regarding use varies depending on the kind of use being addressed at the time. Krystil McDowall, *A Critical Look at “Use” Under the Lanham Act*, 4 NYU J. INTELL. PROP. & ENT. L. 226, 232 (2015). For example, the review of a defendant’s use in commerce is different than the review of a plaintiff’s use in commerce. *Id.* at 232 n.22.

<sup>69</sup> See *infra* notes 70–109 and accompanying text.

<sup>70</sup> Lanham Act § 45 (defining commerce and stating “the intent of this chapter is to regulate commerce within the control of Congress . . .”); *Int’l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 363–64 (4th Cir. 2003). The Commerce Clause states “[t]he Congress shall have Power . . . to regulate Commerce with foreign nations, and among the several States, and with the Indian Tribes.” U.S. CONST. art. I, § 8, cl. 3.

<sup>71</sup> *United We Stand Am., Inc. v. United We Stand Am. New York, Inc.*, 128 F.3d 86, 92 (2d Cir. 1997). In 1995, the U.S. Supreme Court in *United States v. Lopez* identified three categories of activity that Congress can regulate under the Commerce Clause. 514 U.S. 549, 558 (1995). They include use of channels of interstate commerce, instrumentalities for interstate commerce and finally, “activities that substantially affect interstate commerce.” *Id.* at 558–59. Congress can regulate intrastate activities that substantially affect other states or interstate commerce. *Id.* The Court has a history of broadly interpreting Congress’s power under the Commerce Clause. See generally *Katzenbach v. McClung*, 379 U.S. 294 (1964) (holding that a restaurant’s purchase from interstate vendors was enough to support a rational basis for regulation under the Commerce Clause); *Wickard v. Filburn*, 317 U.S. 111 (1942) (holding that the aggregate effect of a local activity can be regulated under the Commerce Clause if it has a substantial effect on interstate commerce); *United States v. Darby*, 312 U.S. 100 (1941) (holding, under a broad interpretation of interstate commerce, that Congress can regulate intrastate activities under the Commerce Clause if they substantially affect interstate commerce). In the 1990s, however, the Supreme Court began walking back prior jurisprudence and limiting Congress’s power to regulate under the Commerce Clause. See, e.g., *United States v. Morrison*, 529 U.S. 598, 617 (2000) (holding that non-economic activity and activity that is traditionally a state concern must have a direct effect on the economy in order to qualify for regulation under the Commerce Clause); *Lopez*, 514 U.S. at 567 (holding that one cannot aggregate non-commercial activities to create a nexus).

<sup>72</sup> Lanham Act § 45; *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1196 (11th Cir. 2001); *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951) (“[T]o hold that a sale or sales are the sine qua non of a use sufficient to amount to an appropriation would be to read an unwarranted limitation into the statute . . .”); 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:118 (4th ed. 2016).

however, qualifies as use.<sup>73</sup> De minimis transportation will not qualify, nor will private, internal shipments.<sup>74</sup> A good that is transported merely to acquaintances or displayed at a venue with limited attendance confined to a specialized group is not sufficient to qualify as use.<sup>75</sup>

In § 45 of the Lanham Act, Congress specified that use must be made in the “ordinary course of trade, and not made merely to reserve a right in a mark” for future use.<sup>76</sup> What constitutes the ordinary course of trade varies from industry to industry.<sup>77</sup> For example, use could be established through a single sale or transportation of one item if the holder had an intention of further use.<sup>78</sup> Conversely, protection may be denied for ten such occurrences if such occurrences were done solely with the intention to establish use.<sup>79</sup> As an additional require-

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<sup>73</sup> See *Planetary Motion*, 261 F.3d at 1196 (stressing that more than de minimis use is necessary to establish trademark ownership); *New England. Duplicating Co.*, 190 F.2d at 418 (stating the adequacy of use is to be determined on a case-by-case basis).

<sup>74</sup> *Planetary Motion*, 261 F.3d at 1196; *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265 (5th Cir. 1975); LAFRANCE, *supra* note 11, at 36.

<sup>75</sup> *Planetary Motion*, 261 F.3d at 1196 (stating that software creator established use despite not having sold his product, since he distributed software to a wide market of potential users outside a select group); see McDowall, *supra* note 68, at 233 (stating that use must be “open and public”). The sale or transportation of goods must be public to put the public on notice. McDowall, *supra* note 68, at 233.

<sup>76</sup> Lanham Act § 45 (defining “use in commerce” as “the bona fide use of a mark in the ordinary course of trade”). Congress amended the definition of “use in commerce” in 1988 to address the issue of “token use.” GINSBURG, *supra* note 62, at 137; see McDowall, *supra* note 68, at 231–32 (discussing the implications of the 1988 amendment). Token use is when a company makes bogus use of a mark in order to establish first use and ensure trademark protection. GINSBURG, *supra* note 62, at 137 (explaining token use). It is also referred to as warehousing a mark. See *Planetary Motion*, 261 F.3d at 1198 (using the term “warehouse”). Token use established use under the Lanham Act until 1988 when Congress adopted a stricter “bona fide use” standard. McDowall, *supra* note 68, at 231–32. This hurt businesses that underwent periods of lengthy and costly product development prior to the introduction of products to the market. GINSBURG, *supra* note 62, at 137. To address this issue, Congress allowed for the pre-registration of trademarks in anticipation of use. *Id.* A registrant must intend to use the mark within a specified timeframe in order to qualify for federal registration. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 18 (AM. LAW INST. 2015). Common law protection is more rigorous and does not include a provision to protect intent to use. *Id.* The courts have, however, recognized “analogous use.” GINSBURG, *supra* note 62, at 149. Analogous use protects marks that have yet to enter commerce, but still have established source association, such as through advertising. *Id.* A holder must prove that the public identifies the mark as belonging to the owner’s product or services and that actual sales and services were rendered within a reasonable amount of time to establish that the holder did not act merely to reserve use at a future time. See *Aktieselskabet AF 21. Nov. 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 21 (D.C. Cir. 2008) (discussing the need to prove bona fide intent to establish use); GINSBURG, *supra* note 62, at 149 (explaining “analogous use”). An analogous use may include regular business contacts, after-sales services, advertising, or marketing. GINSBURG, *supra* note 62, at 149 (showing hypothetical situations where analogous use may apply). Only pre-sale use directed at future consumers will be considered. *T.A.B. Sys. v. Pactel Teletrace*, 77 F.3d 1372, 1376 (Fed. Cir. 1996); 2 MCCARTHY, *supra* note 72, § 16:14.

<sup>77</sup> *Planetary Motion*, 261 F.3d at 1198. The frequency and extent of trade sufficient to establish use is based on a particular industry’s customary practices. *Id.*

<sup>78</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 18 (AM. LAW INST. 2015).

<sup>79</sup> *Id.* For example, in industries with expensive goods, there may be only a few products sold per year. *Id.*

ment to establish use, a trademark must be displayed on goods or their containers or on displays or tags affixed to goods sold or transported in commerce.<sup>80</sup> For service marks, the mark must be displayed or used during the sale or advertising of services offered in commerce.<sup>81</sup>

## II. TRADEMARK LAW AND STREET ART

This Part explores the complex relationship between trademark law and street art by discussing the treatment of other visual art forms under trademark law.<sup>82</sup> Section A provides the framework for this discussion by providing an overview of potential trademark claims that could and have been brought by street artists.<sup>83</sup> Section B discusses how the courts have historically treated visual arts under § 43(a) of the Lanham Act and how this treatment affects the applicability of trademarks in street art.<sup>84</sup>

### A. An Overview of Potential Trademark Claims in Street Art

There are three potential marks that could qualify for protection in street art: the artist's pseudonym, the signature, and the artistic style.<sup>85</sup> An artist's pseudonym acts as a trade name.<sup>86</sup> These names are typically used to identify an artist in connection with his or her work.<sup>87</sup> Trade names and trademarks, though technically distinct, can both find protection under the Lanham Act.<sup>88</sup> In addi-

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<sup>80</sup> Lanham Act § 45. If this is not possible due to the nature of a good, then the mark must be found on associated documents. *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> See *infra* notes 85–125 and accompanying text.

<sup>83</sup> See *infra* notes 85–110 and accompanying text.

<sup>84</sup> See *infra* notes 111–125 and accompanying text.

<sup>85</sup> See *infra* notes 86–91 and accompanying text.

<sup>86</sup> See 1 MCCARTHY, *supra* note 72, § 4:13 (defining “trade name” and explaining that trade names can be registered under the Lanham Act if they meet the requirements for a valid trademark or services mark). A trade name is used to distinguish one business from another. *Id.*

<sup>87</sup> See, e.g., In Chambers Order, *supra* note 5, at 1 (identifying street artist “Rime” as Joseph Tierney); Sebastian Buck, *The 50 Greatest Street Artists Right Now*, COMPLEX (Mar. 22, 2011), <http://www.complex.com/style/2011/03/the-50-greatest-street-artists-right-now/> [<https://perma.cc/NX8Z-TAL9>] (identifying street artists by their street names, such as Space Invader, Banksy, and Os Gemeos); Janie Campbell, *Street Artist Sues American Eagle for Using His Work in . . . Just About Everything*, HUFFINGTON POST (July 29, 2014, 11:02 AM), [http://www.huffingtonpost.com/2014/07/29/aholsniffsglue-american-eagle-artist-lawsuit-copyright\\_n\\_5627862.html](http://www.huffingtonpost.com/2014/07/29/aholsniffsglue-american-eagle-artist-lawsuit-copyright_n_5627862.html) [<https://perma.cc/67J4-5ZY4>] (identifying the street artist “Ahol Sniffs Glue” as David Anasagasti).

<sup>88</sup> See *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1535 (9th Cir. 1989) (determining that the same confusion test factors apply in trademark and trade name infringement cases); 3 MCCARTHY § 19:118, *supra* note 72. Trade names signify the reputation of a business as a whole, whereas trademarks distinguish individual goods and services. 3 MCCARTHY § 19:118, *supra* note 72. A trade name often also functions as a trademark or service mark. *Accuride Int'l, Inc.*, 871 F.2d at 1534.

tion, there are artists who use signature artistic elements as a distinct mark.<sup>89</sup> These marks are clear identifiers of source, and therefore, could qualify for trademark protection.<sup>90</sup> Lastly, a street artist may claim that his or her artistic style either acts as a trademark when it is inherently distinct or when it has acquired secondary meaning and serves as an indicator of the source of goods or services.<sup>91</sup>

The commercial value of street art has increased as more companies look to use graffiti and a street artist's reputation to increase their brand's street cred.<sup>92</sup> Brands such as Gucci, Hennessy, Coach, Cavalli, American Eagle, and Moschino have all adopted this trend.<sup>93</sup> These retailers sometimes seek approval from an artist to use their mark or enter into collaborations, but there are times when these brands use a street artist's work without prior consent.<sup>94</sup> Given the popularity of these collaborations, the likelihood of confusion by con-

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<sup>89</sup> See Celia Lerman, *supra* note 43 (explaining that artists could be identified in the community based on their characteristic style); *Christie's Collecting Guide*, *supra* note 43 (providing examples of symbols that are synonymous with particular street artists).

<sup>90</sup> See LAFRANCE, *supra* note 11, at 15 (explaining that the purpose of trademarks is to identify the source of goods); *Christie's Collecting Guide*, *supra* note 43 (describing "recognizable trademarks" of popular street artists).

<sup>91</sup> See Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1) (2012) (stating the requirements for claiming a valid trademark in an unfair competition claim); LAFRANCE, *supra* note 11, at 136–37 (outlining the requirements in proving the validity of a trademark); Schwender, *supra* note 2, at 260–62 (stating tags act like brands); *infra* notes 111–125 and accompanying text (discussing trademark protection in art).

<sup>92</sup> Vankin, *supra* note 1 (discussing the changes in perception and commercialization of graffiti).  
<sup>93</sup> See *In Chambers Order*, *supra* note 5, at 1–2 (providing an example of fashion's intrigue with street art); *Another Season, Another Artist Claims Gucci Copied*, THE FASHION LAW (Feb. 24, 2016), <http://www.thefashionlaw.com/home/the-gucci-revamp-is-complete-others-try-to-bank-on-its-success> [<https://perma.cc/QEQ8-QWFK>] (stating that Gucci, for its 2016 runway collection, collaborated with "GucciGhost," an artist who has been tagging Gucci related products for the past ten years); Campbell, *supra* note 87 (describing a lawsuit regarding American Eagle's use of street art in its marketing campaign); *Coach Hit with Copyright Infringement Suit by Artist*, THE FASHION LAW (Aug. 21, 2014), <http://www.thefashionlaw.com/home/coach-slapped-with-copyright-infringement-suit-by-artist> [<https://perma.cc/BNA5-FS9H>] (describing a copyright infringement claim against the fashion brand Coach for the unapproved use of a street mural for the backdrop of an advertising campaign); Morwenna Ferrier, *From the Car Park to the Catwalk: How Fashion Embraced Street Art*, THE GUARDIAN (May 12, 2015, 7:23AM), <http://www.theguardian.com/fashion/2015/may/12/from-the-car-park-to-the-catwalk-how-fashion-embraced-street-art> [<https://perma.cc/FT2K-DLB7>] (describing the current collaboration trend between fashion brands and street artists); *Hennessy V.S Limited Edition by Shepard Fairey—The Deluxe Edition*, HENNESSY (June 9, 2014), <http://www.hennessy.com/us/news/hennessy-vs-limited-edition-shepard-fairey-deluxe-edition/> [<https://perma.cc/LCF2-GHYU>] (discussing Hennessy's collaboration with artist Shepard Fairey in 2014 as part of a series of collaborations with artists, including KAWS, Futura, and Os Gemeos).

<sup>94</sup> See *In Chambers Order*, *supra* note 5, at 1–2 (claiming Moschino used plaintiff's mural on a dress and the plaintiff's tag within advertising without permission); *Williams v. Cavalli*, No. CV 14-06659-AB, 2015 WL 1247065, at \*1 (C.D. Cal. Feb. 12, 2015) (claiming fashion brand Just Cavalli used artists' mural without permission on its clothing collection); Campbell, *supra* note 87 (describing American Eagle's unauthorized use of AholSniffsGlue's street art); *Coach Hit with Copyright Infringement Suit*, *supra* note 93 (describing Coach's unauthorized use of Maya Hayuk's work that was featured on the Bowery Walls).

sumers as to the sponsorship or association of these products is high, which creates a problem that should be addressed through trademark law.<sup>95</sup>

Street artists are turning to the courts to protect their intellectual property rights against infringing brands.<sup>96</sup> Many street artists today are working, at least partially, in the legal space, so although it was once impossible to bring a suit without legal consequences, artists can now pursue claims without the possibility of facing fines and possible jail time.<sup>97</sup> Street artists are bringing federal claims for copyright infringement and state law claims for unfair competition and misappropriation, as well as claims for trademark infringement and unfair competition under § 43(a) the Lanham Act.<sup>98</sup>

For example, in 2015, the street artist Chapa brought a trademark infringement claim against Cavalli, the producer and distributor of the clothing line Just Cavalli.<sup>99</sup> Chapa alleged that the company misappropriated his signature “revolution” imagery from a public mural the plaintiff painted with two other plain-

<sup>95</sup> See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), *abrogated by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (providing a non-exhaustive list of eight factors to consider in assessing likelihood of confusion, including likelihood of expansion into infringing product line); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (listing factors that should be considered when determining likelihood of confusion). The factors that the Second Circuit Court of Appeals established in 1961 in *Polaroid Corp v. Polarad Electronics Corp.* include the strength of the mark, degree of similarity, proximity of products, likelihood that plaintiff will enter defendant’s market, actual confusion, defendant’s intent, quality of defendant’s product, and sophistication of buyers. *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 391 (2d Cir. 1995) (articulating the *Polaroid* factors); *Polaroid Corp.*, 287 F.2d at 495.

<sup>96</sup> See *e.g.*, In Chambers Order, *supra* note 5, at 1–2 (claiming that the fashion brand Moschino designed clothing that incorporated a graffiti mural without permission); *Williams*, 2015 WL 1247065, at \*1 (claiming fashion brand Just Cavalli used portions of street artists’ mural as design on clothing); Anandashankar Mazumdar, ‘Malarky’ Is Latest Graffiti Artist to Sue Fashion Designer, BLOOMBERG BNA (Jan. 12, 2016), <http://www.bna.com/malarky-latest-graffiti-n57982066053/> [<https://perma.cc/GSQ7-NPNA>] (describing the street artist Malarky’s claim against the fashion athletic brand Bandier for unauthorized use of his name and artwork in a collection). Despite graffiti’s existence since the caveman era, street artists are only now beginning to turn to the judicial system to protect their potential intellectual property rights. See Elias, *supra* note 1, at 48 (discussing the rise of graffiti’s popularity and subsequent rise of conflicts regarding graffiti artists’ rights); Roundtree, *supra* note 5, at 966 (discussing the correlation between the increased commercial value of graffiti, appropriation of graffiti art, and intellectual property lawsuits).

<sup>97</sup> See Elias *supra* note 1, at 48 (discussing how graffiti used to be protected under intellectual property “negative space,” in other words, intellectual property was protected by forces outside formal intellectual property law); Roundtree, *supra* note 5, at 966 (discussing the increase in graffiti artists’ legal actions against appropriation).

<sup>98</sup> See, *e.g.*, Complaint for Damages and Injunctive Relief for Copyright Infringement, Violation of the Lanham Act, Violation of the Right of Publicity, Unfair Competition, and Negligence at 9–19, Tierney v. Moschino et al., No. 2:15-cv-05900 (C.D. Cal. Aug. 5, 2015), ECF No. 1; First Amended Complaint for Damages and Injunctive Relief for Copyright Infringement, Violation of the Lanham Act, Unfair Competition, and Negligence at 10–19, *Williams v. Cavalli*, No. 2:14-cv-06659 (C.D. Cal. Nov. 10, 2014), ECF No. 43.

<sup>99</sup> *Williams*, 2015 WL 1247065, at \*1.

tiffs.<sup>100</sup> In 2015, the U.S. District Court for the Central District of California denied the defendants' motion to dismiss plaintiffs' trademark claim.<sup>101</sup> The court held that the plaintiffs had a valid claim against defendant for misrepresenting to the public that its collection was being produced by or in association with the plaintiffs.<sup>102</sup>

Similarly, in 2016, the U.S. District Court of the Central District of California in *Tierney v. Moschino* denied the defendant's motion to dismiss the plaintiff's claim under § 43(a) of the Lanham Act.<sup>103</sup> Tierney is a street artist who works under the pseudonym RIME.<sup>104</sup> The defendants argued that the plaintiff failed to prove use of his mark in commerce.<sup>105</sup> The district court found that the plaintiff had previously used RIME in connection with collaborations with Adidas, Converse, and Disney, in addition to being featured in many museums, and therefore had a valid trademark that was used in commerce.<sup>106</sup>

Many street artists, however, cannot claim similar use.<sup>107</sup> For example, in 2003, prior to the current litigation trend, the Supreme Court, Appellate Division in New York, heard a state law trademark case brought by the graffiti artist "Wild Style" against the filmmakers of a documentary titled "Wild Style."<sup>108</sup> The court dismissed the plaintiff's trademark claim on summary judgment after determining that the plaintiff failed to prove he owned a valid trademark.<sup>109</sup> The plaintiff failed to prove the mark was not generic and that it was used in connection with any products or services in the marketplace.<sup>110</sup>

<sup>100</sup> *Id.* The imagery was featured in a collection for Just Cavalli. *Id.* Chapa originally claimed his signature elements had acquired secondary meaning and served as a source identifier for those in the art world. *Id.*; First Amended Complaint *supra* note 98, at 13–14.

<sup>101</sup> *Williams*, 2015 WL 1247065, at \*6.

<sup>102</sup> *Id.*

<sup>103</sup> In Chambers Order, *supra* note 5, at 1–2. Tierney brought this action against the international fashion house, Moschino and its creative director, Jeremy Scott. *Id.* at 1. Tierney painted a mural entitled "Vandal Eyes" on the side of a building in Detroit. *Id.* at 2. Moschino's Fall 2015 collection featured portions of Tierney's mural, as well as the artist's pseudonym "RIME" featured as a tag. *Id.* One piece, which featured "Vandal Eyes" but not "RIME," closed Moschino's Fall 2015 runway show and was worn by Katy Perry at the MET Gala. *Id.* Creative director Jeremy Scott accompanied Perry in a suit featuring the mural as well. *Id.*

<sup>104</sup> *Id.* at 1.

<sup>105</sup> *Id.* at 7.

<sup>106</sup> *Id.*

<sup>107</sup> See *Tracy v. Pow Wow Prod.*, 302 A.D.2d 211, 211 (N.Y. App. Div. 2003) (rejecting a graffiti writer's unfair competition claim); *supra* notes 53–59 and accompanying text (discussing graffiti artists and non-commercialization).

<sup>108</sup> *Tracy*, 302 A.D.2d at 211.

<sup>109</sup> *Id.* at 212.

<sup>110</sup> *Id.*

### B. The Treatment of Potential Trademarks in the Visual Arts

Courts have been wary to grant art trademark protection.<sup>111</sup> Art and intellectual property rights are usually discussed in the context of copyright and moral rights.<sup>112</sup> Courts do not want to circumvent copyright and moral rights laws by granting trademark protection.<sup>113</sup> The purpose of the Lanham Act is to prevent competitors from copying a source-identifying mark.<sup>114</sup> It is not intended to protect innovation, invention, or discovery.<sup>115</sup>

It is not sufficient that a viewer of a famous piece of artwork clearly identifies the work with a particular artist; under the law, they must identify it with a

<sup>111</sup> See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (stating that courts have been cautious to avoid extending trademark law into the territory reserved for copyright and patent law); *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371, 1380 (S.D.Ga. 1998) (explaining how style is better suited for copyright protection than trademark protection); ALEXANDRA DARRABY, ART, ARTIFACT, ARCHITECTURE AND MUSEUM LAW § 8:15 (2014) (drawing attention to the disagreement among jurisdictions regarding whether the Lanham Act is ever applicable to art).

<sup>112</sup> See DARRABY, *supra* note 111 (discussing the applicability of the Lanham Act in art). Copyrights are granted to “original works of authorship fixed in any tangible medium of expression . . . .” Copyright Act, 17 U.S.C. § 102(a) (2012). Such works include “pictorial, graphic, and sculptural works.” *Id.* § 102(a)(5). Congress granted copyrights in order to protect the artist or author’s commercial interest in his or her expressive works. *Bollea v. Gawker Media, LLC*, 913 F. Supp. 2d 1325, 1329 (M.D. Fla. 2012). By granting a limited monopoly, Congress is providing an incentive for artists to create works. *Id.* at 1329–30. Moral rights enable artists to preserve the integrity of their work. Rebecca Stuart, *A Work of Heart: A Proposal for a Revision of the Visual Artists Rights Act of 1990 to Bring the United States Closer to International Standards*, 47 SANTA CLARA L. REV. 645, 646 n.6 (2007). In 1990, the United States passed the Visual Artists Rights Act, granting moral rights to a limited range of artists. *Id.* at 652.

<sup>113</sup> See *Dastar Corp.*, 539 U.S. at 34 (cautioning that the intent of trademark law is not to reward innovation, discovery, or invention); *Leigh*, 10 F. Supp. 2d at 1380 (discussing the debate regarding whether trademark law should be used to protect artists’ visual styles or if protection should be reserved for copyright law); *Galerie Furstenberg v. Coffaro*, 697 F.Supp. 1282, 1290 (S.D.N.Y. 1988) (stating that protection of Dali’s distinctive expressive style should be brought under copyright law instead of trademark law). The Copyright Act does not protect ideas and concepts. 17 U.S.C. § 102(b). Artists are allowed to use other artists’ techniques and style, or their ideas and concepts. See William P. Fitzpatrick, *The Hazards of Extending Copyright or Trademark Protection to an Artist’s Visual Style*, 17 COLUM. VLA J.L. & ARTS 453, 453–54 (1993) (arguing that a grant of copyright protection over artistic styles would disrupt Congress’s balancing of present and future artists’ needs). By granting trademark protection over these techniques and styles, the court runs the risk of circumventing Congress’s intent to keep ideas and concepts in the public domain. See *Leigh*, 10 F.Supp. at 1380–82 (holding that copyright law does not grant monopolies over ideas, and therefore, trademark law cannot be used to circumvent copyright law and create such a monopoly); *Galerie Furstenberg*, 697 F.Supp. at 1290 (finding the plaintiff was attempting to protect artist, Dali as an author of the work’s “unique style and interpretation,” and therefore that claim was more proper under copyright, not trademark law). Likewise, since the Visual Artists Rights Act (VARA) only grants moral rights to fine arts covered under copyright law, granting trademark protection in street art could evade VARA’s limitations on moral rights protection. Stuart, *supra* note 112, at 654.

<sup>114</sup> *Dastar*, 539 U.S. at 34.

<sup>115</sup> *Id.*

product or service.<sup>116</sup> For example, in 1988, the District Court for the Southern District of New York held in *Hughes v. Design Look, Inc.* that the plaintiff could not, under trademark law, prevent a calendar producer from using an artist's works within a calendar.<sup>117</sup> This was despite the fact that the artist was identifiable based on the piece.<sup>118</sup> The court held that because the plaintiff could not prove that the images were ever used to identify goods or services as coming from the plaintiff, they were not protected under trademark law.<sup>119</sup> Additionally, it is not sufficient that the work is used as a descriptor.<sup>120</sup> In other words, an artist cannot use a photograph or picture as an example of his work; it must function as a trademark.<sup>121</sup>

A lot of the same concerns present themselves in the street art context.<sup>122</sup> A street artist may have a distinct style that identifies him as the artist of a piece, like in *Hughes*, but as in that case, this fact alone is not enough to warrant trade dress or trademark protection.<sup>123</sup> Additionally, trademark protection for art requires something more than being featured in a work that is sold in a gallery or a

<sup>116</sup> *Leigh*, 10 F. Supp. 2d at 1380 (noting the distinction between claims that seek to avoid confusion of artist identification and identification of the source of the goods or services); Fitzpatrick, *supra* note 113, at 463–64 (arguing that an artistic element in visual arts serves a functional role as the product itself and therefore not as a means of source identification); see *Hughes v. Design Look Inc.*, 693 F. Supp. 1500, 1505 (S.D.N.Y. 1988) (stressing the importance that a mark be used to identify a good or service). This rule applies even when the work represents an artist's unique style. *Leigh*, 10 F. Supp. 2d at 1380.

<sup>117</sup> *Hughes*, 693 F. Supp. at 1502, 1506–07. In *Hughes*, the estate of Andy Warhol attempted to prevent a production company from selling a calendar featuring art pieces that had entered the public domain and were no longer protected under copyright law. *Id.* at 1502–03.

<sup>118</sup> *Id.*

<sup>119</sup> *Id.*

<sup>120</sup> See *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1218 (11th Cir. 2000) (stating plaintiff's use of photograph as an example of her work on gallery websites, at auctions, advertisements, etc. was not "separate and distinct" use, but use "as the good itself" (citing *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 754 (6th Cir. 1998))).

<sup>121</sup> See *Leigh*, 212 F.3d at 1218 (holding a photographer did not have trademark rights over a photo used in advertising material).

<sup>122</sup> See *Dastar Corp.*, 539 U.S. at 34 (warning against the overextension of trademark law); *Leigh*, 10 F. Supp. 2d at 1380 (explaining how artistic style should be protected by copyright law, not trademark law); DARRABY, *supra* note 111 (discussing how the grant of trademark protection in art might circumvent copyright laws and moral rights protection); *Christie's Collecting Guide*, *supra* note 43 (describing how graffiti writers and street artists use themes and repeat imagery to create recognizable trademarks). These concerns are not present when claiming trademark protection over artist pseudonyms, since the pseudonyms act as trade names used in association with a separate good. See MCCARTHY, *supra* note 72, § 4:13 (discussing trade names); *Leigh*, 212 F.3d at 1218 (stressing that trademark protection is only granted to marks that are separate and distinct from the work itself).

<sup>123</sup> See *Galerie Furstenberg*, 697 F. Supp. at 1290 (holding that plaintiff did not have a valid trademark over Dali's uniquely stylized images and unique interpretation of subjects, which are more appropriately protected under copyright law); *Hughes*, 693 F. Supp. at 1507 (finding that, despite being recognizable as Warhol's work, none of the Warhol pieces in question were protected trademarks as plaintiff did not use them in association with any product or service).

museum or is seen on marketing materials or on an artist's website.<sup>124</sup> A mark must be used in connection with a good or service, not merely serve as a descriptor of the artist.<sup>125</sup>

### III. THE UNIQUE NATURE OF STREET ART JUSTIFIES A BROAD INTERPRETATION OF USE IN COMMERCE IN ORDER TO PROTECT AN ARTIST'S GOODWILL AND PROTECT CONSUMERS FROM POTENTIAL CONFUSION

The purpose of the Lanham Act is to protect an individual's rights in a mark and its associated goodwill in an effort to mitigate consumer confusion.<sup>126</sup> Not every mark used in street art should qualify for protection, but street artists should not be barred from protection merely because they confine their work to non-commercialized street murals.<sup>127</sup> In order to accomplish this, courts must be willing to apply a broad reading of the use in commerce requirement.<sup>128</sup> Denying a street artist access to trademark protection runs counter to the purpose of the Act.<sup>129</sup> Under current case law, graffiti writers and street artists who do not commercialize through the sale of merchandise featuring their mark as a source identifier or by participating in collaborations with commercial brands are left without trademark protection.<sup>130</sup> It seems counterintuitive that the court may

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<sup>124</sup> See *Leigh*, 212 F.3d at 1218 (stating it is not sufficient that a photograph was used in connection with marketing exhibits and the photographer's appearances).

<sup>125</sup> See *id.* (determining that photographs of art were used as examples of artist's work in advertising rather than as a trademark and consequently were not protected under trademark law).

<sup>126</sup> See LAFRANCE, *supra* note 11, at 2, 7 (discussing how trademark law has historical roots in the common law tort of passing off, which protected consumers from misrepresentations regarding the source of products, and how Congress created the Lanham Act with the policies of goodwill, consumer protection against misrepresentation, and deception in mind).

<sup>127</sup> See *id.* at 49 (discussing the distinctiveness standard for a valid trademark); Roundtree, *supra* note 5, at 964 (discussing authorized and accepted street art practices). A trademark owner must still establish first that a mark is inherently distinct or has acquired secondary meaning and second that an infringing use is likely to cause confusion as to the source of a good. See Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1) (2012) (stating the requirements for trademark infringement); LAFRANCE, *supra* note 11, at 49–61 (explaining the "spectrum of distinctiveness" and the ability of individual marks to identify source).

<sup>128</sup> See Lanham Act § 43(a) (stating use in commerce requirement for unfair competition claim); *United States v. Darby*, 312 U.S. 110, 118 (1941) (holding in-state activities are covered by the Commerce Clause if they substantially affect commerce); *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1194–95 (11th Cir. 2001) (holding that absence of economic motivation will not affect an analysis of use in commerce).

<sup>129</sup> See LAFRANCE, *supra* note 11, at 7 (quoting the House and Senate Reports regarding the public policy concerns addressed in the Lanham Act); *infra* notes 135–138 (discussing the need for trademark law to prevent consumer confusion).

<sup>130</sup> See Lanham Act § 45, 15 U.S.C. § 1127 (2012) (defining the use in commerce requirement under trademark law); *Leigh v. Warner Bros.*, 212 F.3d 1210, 1218 (11th Cir. 2000) (stating marks must be "separate and distinct" and not be used as the good itself (citing *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 754 (6th Cir. 1998)); *Hughes v. Design Look, Inc.*, 693 F.Supp. 1500, 1505 (S.D.N.Y. 1988) (finding none of Warhol's recognizable works were protected trademarks as they were not used in association with any product or service).

grant an artist protection for selling t-shirts featuring a mark online, but deny protection to an artist who is devoted to creating non-commercially, when both marks are synonymous with the artist's work.<sup>131</sup> Section A of this Part discusses the need to protect street artists against trademark infringement and contends that the court should broadly define the Commerce Clause, in order to find that a mark used in non-commercial street art qualifies as "use in commerce" and therefore protected under section 43(a) of the Lanham Act from unfair use.<sup>132</sup> Section B addresses the policy concerns in granting trademark rights to street artists.<sup>133</sup> Section C explains two alternative methods of granting street artists trademark protection: subsection 1 discusses allowing street art to be classified as an eleemosynary activity in order to qualify for protection, and subsection 2 suggests supplementing the "use in commerce" requirement with an alternative famous mark requirement similar to that found in section 2(a) of the Lanham Act.<sup>134</sup>

*A. Street Art and the Need for Trademark Protection: Why the Courts Should Find That Non-Commercialized Street Art Affects Interstate Commerce and Therefore Qualifies as "Use in Commerce" Under Section 43(a) of the Lanham Act*

As mentioned earlier, the popularity of graffiti and street art has led to numerous collaborations between retailers and street artists.<sup>135</sup> This popularity increases the likelihood that a consumer will assume that a retailer's use of a signature artistic element or an artist's pseudonym indicates a collaboration.<sup>136</sup> Without granting trademark protection, street artists would have no way to stop a

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<sup>131</sup> See Lanham Act § 45 (stating the use in commerce requirements); *Christie's Collecting Guide*, *supra* note 43 (discussing and providing examples of elements of an artist's work that are recognizable trademarks).

<sup>132</sup> See *infra* notes 135–176 and accompanying text.

<sup>133</sup> See *infra* notes 177–185 and accompanying text.

<sup>134</sup> See *infra* notes 187–205 and accompanying text.

<sup>135</sup> See Ferrier, *supra* note 93 (discussing the collaboration trend); *supra* notes 92–93 and accompanying text (discussing collaborations between retailers and street artists). Fashion designers have an interest in the graffiti aesthetic and are using street artists' work to achieve that aesthetic. See Mo Alabi, *When Street Art Meets Runway Style*, CNN (Nov. 26, 2013 8:18AM), <http://www.cnn.com/2013/09/07/living/high-fashion-street-art/> [<https://perma.cc/RGE7-AQB5>] (discussing the relationship between fashion and street art).

<sup>136</sup> See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (discussing the Ninth Circuit's likelihood of confusion factors); *Polaroid Corp. v. Polaroid Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (discussing the Second Circuit's likelihood of confusion analysis standard). This Note will not go into the likelihood of confusion analysis, since such analysis is heavily fact intensive. See *Sleekcraft Boats*, 599 F.2d at 348–54 (using the case specific facts to analyze the likelihood of confusion); *Polaroid Corp.*, 287 F.2d at 495 (considering how other factors may play into the court's likelihood of confusion analysis).

retailer from misrepresenting this association.<sup>137</sup> This would harm both street artists and the consumers who are deceived into thinking a product is in some way associated with that artist.<sup>138</sup>

Street art is distinguishable from other visual art forms because style and stylistic elements do not merely function as the work itself because they also serve as marketing tools.<sup>139</sup> As discussed earlier, street artists rely on the repetition of stylistic elements to build their brand and garner the respect and recognition of their community and beyond.<sup>140</sup> This respect and recognition translates into opportunities to create more works, both commercial and non-commercial.<sup>141</sup> In bringing a trademark claim, street artists are not merely trying to circumvent copyright law in an attempt to protect the subject matter of their work; they are trying to protect the goodwill associated with their mark and prevent the likelihood of confusion regarding the source of a product.<sup>142</sup>

Copyright law may protect a creative work, but it does not protect a street artist's right to control the goodwill surrounding that mark.<sup>143</sup> The purpose of § 43(a) of the Lanham Act is to prevent the false association of a good with an

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<sup>137</sup> See LAFRANCE, *supra* note 11 at 7–8 (describing the cause of action under the Lanham Act § 43(a)). Congress relies on trademark owners to prosecute infringers and prevent consumer confusion within commerce. See *id.* (explaining the purpose behind the enactment of the Lanham Act).

<sup>138</sup> See *id.* (stating purpose of trademark law is to protect consumer from confusion).

<sup>139</sup> See Roundtree, *supra* note 5, at 963–64 (explaining the development of unique pseudonyms and artistic styles); Schwender, *supra* note 2, at 260–62 (stating that tags act like brands); *Graffiti Q & A*, *supra* note 8 (comparing graffiti and advertising); *History Part One*, *supra* note 30 (explaining that graffiti writers distinguish themselves through unique tags).

<sup>140</sup> See Schwender, *supra* note 2, at 260–61 (stating tags are like brands); *supra* note 38–43 and accompanying text (discussing how tags function as branding tools and how competition between graffiti writers and artists led to unique tags and stylistic elements).

<sup>141</sup> *Houston Bowery Wall*, *supra* note 59 (describing a project that invites artists to create legal murals on NYC walls); *Pow! Wow!*, *supra* note 59 (describing Pow! Wow!, an organization that coordinates events and festivals for street artists and centers on a week long festival in Hawaii where hundreds of artists are invited to paint); *About Wynwood Walls*, *supra* note 59 (describing an organization that invites artists to come paint in the town center which has become like an outdoor museum).

<sup>142</sup> See *Craigslist Inc. v. 3Taps Inc.*, 942 F. Supp. 2d 962, 978–79 (N.D. Cal. 2013) (explaining how both trademark infringement and copyright infringement can exist simultaneously); LAFRANCE, *supra* note 11, at 7–8 (discussing how the purpose of trademark law is to prevent consumer confusion and protect the goodwill surrounding a mark); *supra* notes 99–110 and accompanying text (summarizing trademark cases that street artists have brought).

<sup>143</sup> See *Williams v. Cavalli*, No. CV 14-06659-AB, 2015 WL 1247065, at \*5–6 (C.D. Cal. Feb. 12, 2015) (finding street artist had valid claim under both copyright and trademark since imagery was used in a source identifying manner); *Craigslist Inc.*, 942 F. Supp. 2d at 978 (explaining that the plaintiff had two distinct claims that existed simultaneously: one for copyright infringement that involved the actual misappropriation of plaintiff's content and one for trademark infringement that involved the erroneous passing off of defendant's goods as plaintiff's or endorsed by plaintiff). In a claim under the Lanham Act, an alleged infringer is not being accused of using the street artists' content as its own content, but instead is being accused of using the street artist's content to suggest endorsement of defendant's own content. See *Craigslist Inc.*, 942 F. Supp. 2d at 978 (discussing the distinction between copyright and trademark claims). This is why copyright claims can exist simultaneously with trademark claims, even in the art context. *Id.*

artist and protect consumers from the cost of market confusion.<sup>144</sup> Copyright and trademark law create distinct rights that warrant simultaneous protection when the situation calls for it.<sup>145</sup> These distinct rights lead to distinct damage remedies, to which street artists should be entitled.<sup>146</sup> Additionally, copyright protection does not extend to certain tags and pseudonyms.<sup>147</sup> The only way these marks can be protected is through trademark law.<sup>148</sup>

A street artist should not have to prove commercialization in order to obtain trademark protection under § 43(a) of the Lanham Act.<sup>149</sup> Congress intended the use requirement under § 43(a) of the Lanham Act to be flexible in order to account for the individual characteristics of different industries.<sup>150</sup> Use can include the sale *or* transportation of goods or services.<sup>151</sup> Use in commerce does not require the commercial use of a mark.<sup>152</sup> Transportation is sufficient to establish use when an “appropriate segment of the public” may identify or distinguish the goods as originating from, or in association with, the alleged trademark owner.<sup>153</sup>

In 2001, in *Planetary Motion, Inc. v. Techsplosion, Inc.*, the U.S. Court of Appeals for the Eleventh Circuit held that a software developer established use by posting a free download of his program on an Internet website.<sup>154</sup> Based on

<sup>144</sup> See LAFRANCE, *supra* note 11, at 7–8 (discussing the purpose of trademark law).

<sup>145</sup> See *id.* at 980 (stating that violations regarding the use of a mark can arise in both the copyright and trademark contexts for distinct harms).

<sup>146</sup> See *Nintendo of Am., Inc. v. Dragon Pac. Int’l*, 40 F.3d 1007, 1011 (9th Cir. 1994) (determining plaintiffs who are victims of both copyright and trademark infringement are entitled to both types of damages).

<sup>147</sup> See Lerman, *supra* note 43, at 308–09 (recognizing that not all graffiti is copyrightable). Copyright protection is reserved for original works. *Id.* at 309. Words and short phrases are not original enough to qualify for protection, so pseudonyms would not be protected. *Id.* Likewise, typefaces are not copyrightable, making it impossible to grant copyright protection to tags. *Id.*

<sup>148</sup> See *id.* at 308–09 (explaining the limitations of copyright law in protecting graffiti); *infra* notes 170–176 and accompanying text (arguing for a broad interpretation of use in commerce requirement).

<sup>149</sup> GILSON ON TRADEMARKS, *supra* note 63, § 11.03(e)(iv); see *infra* notes 150–169 and accompanying text (summarizing why commercialization is an unnecessary requirement when claiming trademark protection).

<sup>150</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 18 (AM. LAW INST. 2015). Congress is including the market particularities surrounding the sale of expensive products or seasonal offerings in addition to other unique particularities that arise in a specific industry. *Id.*

<sup>151</sup> See *Planetary Motion, Inc.*, 261 F.3d at 1191, 1194 (pointing out that the statute is written “sale *or* transport”); *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 417–18 (1st Cir. 1951) (explaining that statutory interpretation supports the claim that transportation is enough to support use even without any sale of goods or services).

<sup>152</sup> GILSON ON TRADEMARKS, *supra* note 63, § 11.03(e)(iv). Use in commerce means the mark has been a part of interstate trade or “substantially affected interstate commerce,” whereas commercial use involves commercial transactions between an individual or company and a consumer of goods or services. *Id.*

<sup>153</sup> *New England Duplicating Co.*, 190 F.2d at 418.

<sup>154</sup> 261 F.3d at 1191, 1194–95.

the totality of circumstances, the court determined that the plaintiff's use was sufficiently public and widespread to establish trademark use.<sup>155</sup> The court held that the number of users was not de minimis, despite the fact that plaintiff's product appealed to a specific market.<sup>156</sup> It also determined that software competitors were sufficiently put on notice of the mark's prior use.<sup>157</sup> The court held the program had not been abandoned to the public domain through the owner's free distribution of the software through a GNU General Public License, since this practice was common to the industry.<sup>158</sup> Additionally, there was no attempt to warehouse the mark and the owner was a professional in the industry.<sup>159</sup>

Likewise, a street artist can be found to have established valid trademark use through a totality of the circumstances review.<sup>160</sup> Like *Planetary Motion*, street artists' marks have the potential for widespread presence and source identification.<sup>161</sup> Street art is publicly displayed and found on a multitude of online outlets allowing for widespread viewership.<sup>162</sup> The public nature of the work puts potential users, such as retailers and other artists, on notice.<sup>163</sup> Some may argue, like they did in *Planetary Motion*, that by writing on another person's wall or on a public wall, the graffiti writer or street artist abandoned his or her rights to the public domain.<sup>164</sup> As seen in *Planetary Motion*, however, a court should not find abandonment when a party is merely conforming to the norms of the industry; in this case, it is common practice for street artists to paint on public walls or walls owned by others.<sup>165</sup> Additionally, street artists are not attempting

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<sup>155</sup> *Id.* at 1195–96, 1200. The mark served as a source identifier. *Id.* at 1196–97.

<sup>156</sup> *Id.* at 1196–97. Visitors of the site were limited to a technologically sophisticated subsection of the public. *Id.*

<sup>157</sup> *Id.* at 1197.

<sup>158</sup> *Id.* at 1198.

<sup>159</sup> *Id.* at 1198–99.

<sup>160</sup> *See id.* at 1196, 1200 (basing its finding of valid use on a totality of the circumstances review).

<sup>161</sup> *See id.* at 1191, 1194–95 (holding that a software developer established use by posting a free download on the Internet); Elias, *supra* note 1, at 48 (discussing how graffiti has become a sought-after commodity); *Christie's Collecting Guide*, *supra* note 43 (discussing the growing popularity of street art and providing examples of elements of an artist's work that are recognizable trademarks).

<sup>162</sup> *See History Part Two*, *supra* note 44 (calling attention to the growth of street art's Internet presence); invaderwashere, *supra* note 46 (the Instagram account to Invader); SPACE INVADER, *supra* note 46 (the official website of Invader).

<sup>163</sup> *See Planetary Motion*, 261 F.3d at 1197 (discussing the importance of notice in establishing use); Lerman, *supra* note 43, at 305 (indicating that a graffiti artist whose works were appropriated could have been located within the community since his characteristic style and presence in the graffiti community made identification easy).

<sup>164</sup> *See Planetary Motion*, 261 F.3d at 1198 (determining free distribution is not considered abandonment); Peter N. Salib, *The Law of Banksy: Who Owns Street Art?*, 82 U. CHI. L. REV. 2293, 2298–300 (2015) (discussing the debate regarding whether graffiti should be deemed abandoned).

<sup>165</sup> *See Planetary Motion*, 261 F.3d at 1198 (determining free distribution is not considered abandonment when the practice is a common industry practice).

to warehouse marks.<sup>166</sup> There is no sporadic or token use.<sup>167</sup> Street artists are genuinely using their mark to identify their work, not to reserve the mark for potential future use.<sup>168</sup> Therefore, as the court held in *Planetary Motion*, use should be established through the creation of public works featuring artists' marks.<sup>169</sup>

Proving a street artist's pseudonym, signature, or signature style is used in commerce that Congress lawfully regulates under the Commerce Clause is challenging.<sup>170</sup> Street art, unlike other art forms, is not always created with a commercial purpose in mind.<sup>171</sup> Although the court does not require economic motivation to establish use in commerce, the court does require the activity to be one that Congress is able to regulate under the Commerce Clause.<sup>172</sup>

A narrow reading of the Commerce Clause requires non-commercial activity have a direct effect on the economy in order to be regulated by Congress.<sup>173</sup> It would be hard for non-commercial street art to qualify under this standard.<sup>174</sup> Congress can regulate the interstate sale of fine art; street artists, however, are not always in the practice of selling their work interstate, nor is it always possible.<sup>175</sup> Under a broad interpretation of the Commerce Clause, street art could qualify as use in commerce.<sup>176</sup>

<sup>166</sup> See Lanham Act § 45 (defining "use in commerce"); GINSBURG, *supra* note 62, at 137 (discussing token use).

<sup>167</sup> See Lanham Act § 45 (defining "use in commerce"); GINSBURG, *supra* note 62, at 137 (explaining token use).

<sup>168</sup> See Lanham Act § 45 (stating that "use in commerce" is not valid if used "merely to reserve a right in a mark"); GINSBURG, *supra* note 62, at 137 (explaining how companies have crafted bogus uses for a mark in order to reserve the mark for potential future use).

<sup>169</sup> See *Planetary Motion*, 261 F.3d at 1191, 1194–95 (holding the distribution of a free software program was use in commerce for trademark purposes).

<sup>170</sup> See *United States v. Morrison*, 529 U.S. 598, 617 (2000) (holding that non-economic intrastate activity that is traditionally a state concern must have a direct effect on the economy in order to qualify for regulation under the Commerce Clause); *United States v. Lopez*, 514 U.S. 549, 558, 567 (1995) (identifying three categories of activity that fall under the Commerce Clause).

<sup>171</sup> See *Roundtree*, *supra* note 5 (discussing how some street artists do not commercialize their work); Dwyer, *supra* note 29.

<sup>172</sup> See Lanham Act § 45 ("[T]he intent of this chapter is to regulate commerce within the control of Congress . . ."); *Planetary Motion*, 261 F.3d at 1191, 1194–95 (holding that the absence of economic motivation will not affect a finding that a mark is used in commerce); *Int'l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 363–64 (4th Cir. 2003) (holding that commerce means activity regulated under the Commerce Clause).

<sup>173</sup> See *Morrison*, 529 U.S. at 617 (refusing to find that Congress had power to regulate "noneconomic, violent criminal conduct" based solely on its "aggregate effect on interstate commerce"); *Lopez*, 514 U.S. at 558, 567–68 (reflecting Court's unwillingness to expand Congress's power to activities that are not directly related to interstate commerce).

<sup>174</sup> See *Morrison*, 529 U.S. at 617–18 (rejecting Congress's power to regulate noneconomic activities that merely have an "aggregate effect on interstate commerce"); *Lopez*, 514 U.S. at 558, 567–68 (unwilling to expand Congress's power under the Commerce Clause to regulate gun possession near schools because of its attenuated connection with interstate commerce).

<sup>175</sup> *Estate of Graham v. Sotheby's Inc.*, 860 F. Supp. 2d 1117, 1123 (C.D. Cal. 2012). Street artists would qualify for use in commerce under § 43(a) of the Lanham Act by selling legal art, taking commis-

### B. Addressing Policy Concerns Surrounding the Grant of Trademark Rights to Street Artists

Some may be concerned that a broad interpretation of use would lead to a burdensome limitation on the types of marks available for public use.<sup>177</sup> This argument overlooks the fact that there are legal measures in place to limit the breadth of inclusion, such as requiring a mark to be inherently distinctive or that it acquire secondary meaning, in addition to geographical limitations.<sup>178</sup> Additionally, an infringement claim must undergo a likelihood of confusion analysis before infringement is determined.<sup>179</sup>

Other critics claim that a grant of trademark protection in street art promotes illegal activity.<sup>180</sup> Not all street art, however, is illegal.<sup>181</sup> Street artists can

sions, or collaborating on merchandise that features their mark, because Congress regulates these activities under the Commerce Clause. *See* LAFRANCE, *supra* note 11, at 32–34 (explaining that a mark qualifies for trademark protection after “actual use. . . in the connection with the offering of goods or services to the public”). Such activities, however, must involve interstate or international commerce and feature the mark. *See id.* at 38 (explaining that in order to qualify for protection, the mark must be used in commerce in multiple States or with a foreign country).

<sup>176</sup> *See generally* Wickard v. Filburn, 317 U.S. 111 (1942) (holding that there was congressional power to regulate a farmer’s wheat production, even though most of the product was not intended to be sold and therefore only indirectly affected commerce, due to its aggregate effect on interstate commerce); *Darby*, 312 U.S. (holding that the Commerce Clause granted Congress power to regulate intrastate labor because of its effect on interstate commerce). An artist’s murals can be considered a commodity and there is an interstate market for such works. Elias, *supra* note 1, at 48 (discussing the increased value of street art in the art market). Owners of property have been known to remove the works from walls and sell them nationally at auctions. *See id.* (discussing a recent controversy regarding graffiti artist, Banksy, and the building owner’s unauthorized sale of one of his works). Additionally, many of these free walls are tourist attractions. *Id.* Touring companies have set up walking tours to view graffiti around cities. *See id.* (giving examples of cities that offer tours). It could also be argued that the creation of graffiti substantially affects the interstate commerce of spray paint and painting supplies, or alternatively, the market for collaboration with other artists affects interstate commerce of artistic services. *See Darby*, 312 U.S. at 118 (holding that the Commerce Clause covers intrastate activities if they substantially affect interstate commerce).

<sup>177</sup> *See* Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003) (expressing concerns against a broad interpretation of trademark law); *Leigh v. Warner Bros., Inc.*, 10 F. Supp. 2d 1371, 1380 (S.D.Ga. 1998) (determining that copyright law should be used over trademark law with regards to protecting artists’ visual styles); *Galerie Furstenberg v. Coffaro*, 697 F.Supp. 1282, 1290 (S.D.N.Y. 1988) (determining that a finding of trademark protection over an artist’s unique style would encroach upon copyright laws).

<sup>178</sup> *See* GINSBURG, *supra* note 62, at 279 (stating that trademarks are not available for generic terms); LAFRANCE, *supra* note 11, at 136–37 (outlining the requirements in proving the validity of a mark, including inherent distinctiveness or acquired secondary meaning and priority of use).

<sup>179</sup> *See Sleekcraft Boats*, 599 F.2d at 348–49 (stating the factors to determine likelihood of confusion); *Polaroid Corp.*, 287 F.2d at 495–96 (discussing likelihood of confusion analysis).

<sup>180</sup> *See* Lerman, *supra* note 43, at 316 (discussing how the grant of copyrights to illegal graffiti feels intuitively wrong); Elias, *supra* note 1, at 49 (discussing the debate regarding whether illegal graffiti should be entitled to copyright or moral rights protection).

<sup>181</sup> *See* Roundtree, *supra* note 5, at 964 (describing “free walls”); *supra* notes 48–52 and accompanying text (discussing the legal avenues available to street artists).

obtain permission from building owners and paint on free walls.<sup>182</sup> Nonetheless, some graffiti writers and street artists are building their trademarks through illegal methods.<sup>183</sup> Even many legitimate street artists started their careers by illegally tagging walls, and many continue to create illegal works throughout their careers in order to maintain their street cred.<sup>184</sup> Illegality is part of the culture.<sup>185</sup> Money, however, is not what motivates most graffiti writers; therefore, granting trademark protection will have no effect on the production of illegal graffiti.<sup>186</sup>

### *C. Alternative Proposals for Granting Street Artist's Protection Over Their Marks*

This Section proposes two alternative methods of granting trademark protection to street artists should courts be unwilling to find street artists have used their marks in commerce.<sup>187</sup> The first subsection promotes the classification of street art as a charitable activity to circumvent the “use in commerce” requirement.<sup>188</sup> The second urges Congress to adopt a “fame” standard for determining trademark eligibility.<sup>189</sup>

#### 1. Classifying Street Art as a Charitable Activity Entitled to Circumvent the Use in “Commerce” Requirement

One possible way to circumvent the challenge of use in commerce is by classifying street art as an eleemosynary activity.<sup>190</sup> In *Planetary Motion*, the

<sup>182</sup> See VEREL, *supra* note 8, at 32–35 (explaining how street artists approach building owners for permission to paint murals); Roundtree, *supra* note 5, at 964 (describing “free walls”); *supra* notes 58–59 and accompanying text (discussing free walls and permissive works).

<sup>183</sup> See Roundtree, *supra* note 5, at 965 (identifying Banksy and Shepard Fairey as artists who create graffiti); Felisbret, *supra* note 2 (discussing how “purists” feel that legal works stifle creativity and lack the excitement that develops from illegal works); *Graffiti Q & A*, *supra* note 8, (discussing how “hard core” graffiti artists are against any legalization of their work, especially when it leads to commercialization).

<sup>184</sup> See Felisbret, *supra* note 2 (explaining that status in the graffiti community cannot be achieved without artists taking some risks and breaking the law); Vankin, *supra* note 1 (discussing how many artists produce both legal and illegal works).

<sup>185</sup> See VEREL, *supra* note 8, at 25 (stating an artist is unlikely to stop painting due to any law or destruction of their work); *supra* notes 29–34 and accompanying text (discussing the illegal roots of graffiti).

<sup>186</sup> See VEREL, *supra* note 8 (noting that an artist is unlikely to stop painting due to any law or destruction of his or her work); Roundtree, *supra* note 5, at 963 (stating the core values of graffiti are “fame, artistic expression, power, and rebellion”); Dwyer, *supra* note 29 (mentioning that graffiti writers initially did not earn money from their work and were considered vandals with whom no one would associate due to the risk).

<sup>187</sup> See *infra* notes 190–205 and accompanying text.

<sup>188</sup> See *infra* notes 190–200 and accompanying text.

<sup>189</sup> See *infra* notes 201–205 and accompanying text.

<sup>190</sup> See *Here Comes the Neighborhood Episode 1: Introducing the Walls*, *supra* note 6 (documenting the creation and evolution of the Wyndwood Walls, a project that was aimed at revitalizing and

Eleventh Circuit held that common law trademark protection extends to not-for-profit organizations and individuals when such entities could prove they were in competition with other entities.<sup>191</sup> In 1975, in *DeCosta v. Columbia Broadcasting Systems, Inc.*, the U.S. Court of Appeals for the First Circuit was reluctant to extend this rule to individuals given the difficulties in drawing a line between individuals who are in commerce and those who are not.<sup>192</sup> The Eleventh Circuit in *Planetary Motion*, however, had no reservations in extending the rule to individuals as long as they were engaged in competition with other individuals or organizations.<sup>193</sup> The court held that if a plaintiff's charitable actions included an element of competition, they would be entitled to trademark protection despite their lack of financial motivation.<sup>194</sup>

A court may be hesitant to classify street art as a charitable activity, but many artists in fact are doing a service to the community and beautifying neighborhoods across the country.<sup>195</sup> A street artist, working legally, is not dissimilar to the trademark owner in *Planetary Motion* who distributed free software downloads.<sup>196</sup> Both are providing a free product to the community and both deserve protection of their marks.<sup>197</sup> Like the trademark owner in *Planetary Motion* who was driven by competition to establish a trademark, a street artist is driven by

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beautifying a depressed neighborhood); *supra* notes 6–7 and accompanying text (discussing how graffiti is being used to benefit society).

<sup>191</sup> *Planetary Motion*, 261 F.3d at 1199–1200; *see also* Lauren Behr, *Trademarks for the Cure: Why Nonprofits Need Their Own Set of Trademark Rules*, 54 B.C. L. REV. 243, 258 (2013) (explaining that there is no special statutory provision for trademarks in the nonprofit context).

<sup>192</sup> *Planetary Motion*, 261 F.3d at 1199; *DeCosta v. Columbia Broad. Sys., Inc.*, 520 F.2d 499, 513 (1st Cir. 1975).

<sup>193</sup> *Planetary Motion*, 261 F.3d at 1199. The *Planetary Motion* court stressed the fact that requiring case-by-case factual inquiry tempers granting access to trademark protection to eleemosynary individuals. *Id.*

<sup>194</sup> *Id.* at 1200. These competitive actions may include distributing products under a specific mark, distinguishing a product from that of other developers', attempting to retain ownership rights in a mark, and avoiding loss of mark to the public domain. *Id.*

<sup>195</sup> *See* Elias, *supra* note 1, at 48 (pointing out communities' acceptance of street art); Roundtree, *supra* note 5, at 963 (stating that many artists paint with the intent of urban beautification); Schwender, *supra* note 2, at 275 (explaining that not all graffiti is against public policy as many communities are sanctioning its creation, even when done illegally). Many organizations and community-supported projects have been organized to bring murals to community walls. *See, e.g., Houston Bowery Wall, supra* note 59 (describing the Houston Bowery Wall, a privately owned wall whose owners invite artists to create murals with the mission to inspire hope in the community); THE L.I.S.A. PROJECT, *supra* note 59 (describing a public art project in New York City that brings street artists to Little Italy); *About Wynwood Walls, supra* note 59 (describing The Wynwood Walls, a project developed by Tony Goldman in 2009 to bring street art to a community to create a pedestrian center in an attempt to revitalize the city of Wynwood).

<sup>196</sup> *See supra* notes 160–169 (analyzing street artists in the context of *Planetary Motion* decision).

<sup>197</sup> *See Planetary Motion*, 261 F.3d at 1191, 1194–95 (holding that the offer of a free software download through the Internet was use in commerce because the statute says “sale or transport” of goods). There have been other instances in which a mark was held to be used “in commerce” despite lacking financial motivation. *See* GILSON ON TRADEMARKS, *supra* note 65, § 11.03(2)(e)(iv) (providing examples of such cases).

competition.<sup>198</sup> Street artists create pseudonyms, tags, and signature styles to distinguish themselves from their competition.<sup>199</sup> The creation of street art should qualify for protection just like other not-for-profit individuals and organizations.<sup>200</sup>

## 2. Using Fame to Determine the Validity of Plaintiff's Trademark in Street Art by Borrowing a Rule from § 2(a) of the Lanham Act

Alternatively, Congress could create a rule similar to § 2(a) of the Lanham Act that would use fame instead of use in commerce as a benchmark to determine a plaintiff's ability to bring a trademark infringement action.<sup>201</sup> The purpose of § 2(a) of the Lanham Act is to protect a famous individual from having a mark registered by a third party that is falsely suggestive of a connection to that person.<sup>202</sup> Section 2(a) was intended to fill the gap in trademark law that fails to protect famous names that are not used in association with the sale or transport of a good or service.<sup>203</sup> If personalities are entitled to protection from registrations of this kind, then famous street artists should be able to protect their own names and marks within a § 43(a) unfair competition claim.<sup>204</sup> The trademark opposition requirements set out in § 2(a) of the Lanham Act could easily be adopted to the unfair competition context.<sup>205</sup>

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<sup>198</sup> *Planetary Motion*, 261 F.3d at 1200; see *supra* notes 39–43 and accompanying text (discussing how tags and artistic styles developed out of the competition between graffiti artists to establish their reputation). Writers developed unique styles to distinguish their work from others. Roundtree, *supra* note 5 at 963–64.

<sup>199</sup> Roundtree, *supra* note 5, at 963–64.

<sup>200</sup> See *Planetary Motion*, 261 F.3d at 1199–1200 (noting that not-for-profit activities were nonetheless used in commerce because they had “elements of competition”); *DeCosta*, 520 F.2d at 513 (stating that an individual who was not engaged in profit-driven activity was not barred from trademark protection); Roundtree, *supra* note 5, at 963–64 (explaining that tags and unique artistic styles developed because artists needed a way to differentiate themselves). The use must still be sufficient to establish trademark ownership. *Planetary Motion*, 261 F.3d at 1199.

<sup>201</sup> See Lanham Act § 2(a), 15 U.S.C. § 1052(a) (2012) (stating marks that suggest association with a living person may be refused registration); *Hornby v. TJX Cos.*, 87 U.S.P.Q. 2d 1411, 1427 (T.T.A.B. 2008) (explaining that the purpose behind § 2(a) is to protect those names that do not qualify as trademarks under the law).

<sup>202</sup> *Hornby*, 87 U.S.P.Q. 2d at 1427; see Lanham Act § 2(a) (preventing registration of marks that “falsely suggest a connection with persons”).

<sup>203</sup> *Hornby*, 87 U.S.P.Q. 2d at 1427; see Lanham Act § 2(a) (omitting any requirement that a name be used in commerce).

<sup>204</sup> See Lanham Act § 2(a) (preventing the registration of marks that “falsely suggest a connection with persons, living or dead, [or] institutions . . . or bring them into contempt, or disrepute”); *Hornby*, 87 U.S.P.Q. 2d at 1427 (stating that the purpose behind § 2(a) is to protect famous individuals against companies wishing to use their name to profit in commerce).

<sup>205</sup> See Lanham Act § 2(a) (barring the registration of marks that could be confused with famous names and institutions); *supra* notes 64–65 and accompanying text (explaining trademark opposition claims).

## CONCLUSION

Street artists should be entitled to trademark protection in spite of concerns that such protection would circumvent copyright law and the fact that most works are not commercialized. Street artists use stylistic elements to identify their work. The public has come to associate artists with certain stylistic elements. This association creates the risk of consumer confusion. As such, it is in the best interest of consumers to grant trademark rights to street artists. The Commerce Clause should be interpreted broadly to encompass street art as an activity that substantially affects commerce. If the court is not amenable to such an interpretation, they could consider classifying street art as a charitable activity since it is aimed at beautifying a city. This would afford artists trademark protection based on the standard discussed by the U.S. Court of Appeals for the Eleventh Circuit in 2001 in *Planetary Motion, Inc. v. Techsplosion, Inc.* Alternatively, Congress may consider stepping in and supplement the use in commerce requirement under § 43(a) of the Lanham Act with a fame requirement. Whatever path is taken it remains clear that fairness warrants a grant of protection over a street artist's marks.

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